

Andean Community
MANUAL FOR THE EXAMINATION OF TRADEMARKS
December, 2023

INTRODUCTION(extract)

This Andean Trademark Manual aims to contribute to the continuous improvement in the quality and efficiency with which the services are provided by the industrial property offices of the four CAN Member Countries (Bolivia, Colombia, Ecuador and Peru), through the formulation of a series of practical recommendations and guidelines, aimed at officials directly involved in the trademark registration procedure, to support and facilitate their analysis and decision-making processes.

(The rest is omitted.)

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CHAPTER 1 DISTINCTIVE SIGNS

Intellectual Property, in accordance with the nature of each right, is made up of three disciplines, which in the Andean regime have independent regulatory bodies: 1) copyright; 2) industrial property rights, which in turn comprise two categories of legal figures: new creations and **distinctive signs** and, 3) the protection of breeders of new plant varieties.

In relation to Industrial Property and in order to approach a definition of Distinctive Signs, we find, first of all, that the Royal Spanish Academy (RAE) defines a "sign" as: "object, phenomenon or material action that, by nature or convention, represents or substitutes another." In this sense, we must understand that this term, in essence, refers to any object or medium that can be used to represent or communicate a specific message.

On the other hand, the term "distinctive" is defined by the RAE itself, as something "that has the ability to distinguish" and "distinguish" corresponds to "make something different from another thing by means of some particularity, sign, motto, etc."

In this order of ideas, we could then, based on the meanings previously obtained, make the following proposal for the definition of "distinctive signs", as the means used to differentiate a product, a service, an activity or an establishment from another.

There are several concurrent definitions of distinctive signs. but, generally, it is agreed that they are all those words, letters, symbols, colors, designs, figures or other elements that serve to distinguish products, services or economic activities from other similar ones, allowing the consumer to identify their business origin. on trade.

The Common Regime on Industrial Property of the Andean Community Commission (DA 486) does not establish a definition of distinctive signs; However, it identifies, regulates and protects the following types of distinctive signs:

- Trademarks
- Commercial slogans

- Tradenames
- Commercial signs or banners
- Geographical indications / Designations of origin.

Below are defined some of the signs that are included in this concept, to understand their nature and their differences.

1. The Trademarks.

1.1. Concept.

In general terms, the legal definitions of trademark, point out that it is a sign suitable for distinguishing goods or services in the market. Along these lines, article 134 of DA 486 establishes the following:

"Article 134.- For the purposes of this regime, any sign that is suitable to distinguish goods or services in the market will constitute a trademark. Signs susceptible to graphic representation. The nature of the product or service to which a trademark is to be applied will in no case be an obstacle to its registration. (...)".

From the aforementioned legal precept, it is obtained, as a first point, that the trademark in the CAN must have distinctive capacity. In terms of the TJCA:

"[a)] Distinctiveness is the intrinsic capacity that the sign must have to identify a product or service by itself; and, the extrinsic capacity to distinguish some goods or services from others in the market. The distinctive character of the sign allows the consumer to make the choice of the goods and services they wish to purchase. In the same way, it allows its owner to differentiate its goods and services from other similar ones offered on the market." .

Additionally, the same provision makes registration subject to signs being able to be represented graphically, a requirement that refers, according to the TJCA, to the ability of a sign to be described or reproduced in words, images, formulas or other media, that is, , into something perceptible to be captured by the consuming public .

For sound marks, for example, the graphic representation can be fulfilled through the notes and spaces specified in a staff, if it

is a melody, or through the presentation of a sonogram or spectrogram in the case of other sounds, without prejudice that national offices may also require that the representation of this type of mark consist of an analog or digital recording. Later, in the section dedicated to the examination of form, the graphic representation of this and other types of trademark will be discussed in detail.

Finally, in the last part of the legal provision it is specified that the registration of trademarks does not depend on the nature of the product or service in question; the possibility of registration will depend in any case on compliance with the legal requirements *sine qua non*, that is, , that the sign must meet the requirements established by the standard, in addition to not incurring any of the causes of unregistrability provided for in DA 486.

Now, regarding the registrability requirements of a sign as a trademark, it is also worth mentioning perceptibility, which, although not expressly included in the terms of the cited article 134, is implicit in the notion of trademark. Regarding perceptibility, the TJCA has stated that this "refers to any element, sign or indication that can be captured by the senses so that, through them, the trademark penetrates the mind of the public, which assimilates it." easily". In other words, the trademark has to be perceptible by the senses so that it can be identified by the consumer through them.

1.2. Classification of types of marks.

Article 134, in addition to establishing the requirements that signs must meet to be registrable as a trademark, presents a non-exhaustive list of signs that can be considered as such, namely:

"(...)

The following signs, among others, may constitute trademarks: a) words or combinations of words;

b) images, figures, symbols, graphics, logos, monograms, portraits, labels, emblems and shields; c) sounds and smells;

d) letters and numbers;

e) a color delimited by a shape, or a combination of colors;

f) the shape of the products, their packaging or wrapping;

g) any combination of the signs or means indicated in the previous

sections."

As can be seen, in this non-exhaustive list there are signs that are perceived in different ways by the consumer, for example a word that is perceived by sight; or signs consisting of odors, which are captured by the sense of smell.

In order to define the different types of signs that can be protected as trademarks in the CAN, we will follow the classification of traditional and non-traditional trademarks.

1.2.1. Traditional trademarks.

In this type of trademarks we find word, figurative and combined trademarks, made up of words, letters, numbers, drawings and their combinations.

These trademarks have been called by doctrine worldwide as "traditional", since, on the one hand, they are the ones that are used to the greatest extent in commercial traffic to identify goods or services and, on the other hand, the majority of registrations of trademarks granted by industrial property offices correspond to this type of trademark. They are also characterized by the fact that in both word marks, figurative marks and combined marks, the requirement of graphic representation is easily met, as we will see below.

1.2.1.1. Wordmarks.

Word marks, also known as nominative or verbal, find their basis in paragraphs a) and d) of article 134, these marks being the ones

They consist exclusively of (i) words or combination of words, (ii) letters, (iii) numbers or (iv) the combination of the previous elements.

As a main characteristic, these trademarks can be read and pronounced, be remembered by the consumer public when heard and are probably the easiest trademarks to represent, as can be seen with the following examples:

Words

NIKE

Word Combination

HEAD & SHOULDERS

Letters	DHL
Numbers	747
Combination of the previous elements	212 BY CAROLINA HERRERA

Compound trademarks, which are made up of two or more words, with or without conceptual meaning, are also considered denominative. , For example:

SAINT ANA
INCA KOLA

For the CAN, word marks are usually considered to be those signs with Latin characters that correspond to those used in the usual or standard language in the country.

Note that the protection granted by the registration of the word mark generally does not concern how the word element is appreciated graphically, but rather how it is read, pronounced and the connotation, meaning or sense that it gives to the product or service to which it is used. applies.

The above allows us to formulate some general criteria that the graphic representation of a word mark should meet.

- The name must be indicated in the application, in accordance with the standard established by each office. .
- A black font must be used and not include any color, design or figures.
- The indication of the trade name must be clear and must not have erasures.
- The industrial property offices of Bolivia, Ecuador and Peru consider that the letters and typography of the word mark must be Latin characters, and may include punctuation marks or diacritics and, if it includes numbers, these must be Roman or Arabic. The Colombian office, for its part, admits that a sign that contains, in whole or in part, non-Latin characters or non-Arabic or Roman numerals can be registered as a word mark, provided that the applicant submits a transliteration or a translation of that content into Latin characters or Arabic numerals.

Examples of graphic representation of a word mark:

DOÑA LIKE

212

SOFÍA POULTRY

GÜITIG

POSTOBON

1.2.1.2. Figurative marks.

They are trademarks that are made up exclusively of images, figures, symbols, graphics, logos, monograms, portraits, labels, emblems and shields, without any type of legend, word, number or alphabetical element.

The figurative trademark has characters, stylization or special arrangement that exalt a graphic characteristic, designs, drawings or decorative elements.

As a main characteristic, these cannot be pronounced or read, although they can represent or conceptualize an idea, that is, something already existing in nature or created by man, or they can be made up of a series or set of lines, curves. , or doodles that do not represent any concept.

In Peru, for example, the National Institute for the Defense of Competition and the Protection of Intellectual Property (hereinafter INDECOPI) granted the following trademark:



The graphic representation of this type of trademark requires capturing the figurative element in the corresponding section of the application.

In general terms , it can be accepted photographs, drawings, caricatures, isotypes as graphic representation.

In Ecuador, the figurative trademark Diseho de Onda was granted, graphically represented as follows:



Additionally, in case the applicant wishes to claim colors within the figurative mark, it must be so indicated. As an example, in Colombia, Google LLC applied before the SIC for the registration of the following figurative mark, claiming the colors Red, Dark Blue, Light Blue, Yellow, Green:

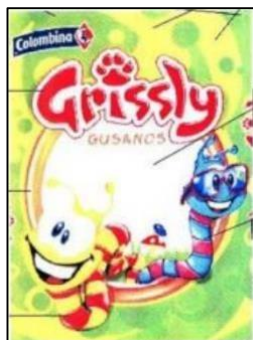


1.2.1.3. Combined mark.

They are trademarks that are composed of a combination of denominative and figurative elements. Combined trademarks have pronounceable elements, as long as they integrate nominative elements together with colors, designs and/or graphics.

This is what the TJCA has recognized: "Combined trademarks are made up of a word element (one or more words) and a graphic element (one or more images). The combination of these elements, when appreciated as a whole, produces in the consumer an idea about the trademark that allows them to differentiate it from the others on the market."

For example, we find the combined trademark Grissly (and design), which was granted by the Ecuadorian Institute of Intellectual Property (today the National Intellectual Rights Service - SENADI) :



SENADI granted registration of the Netlife combined trademark:



For its part, the following Alicorp combined trademark was renewed in Peru by INDECOPI:



For the purposes of determining how the graphic representation requirement must be met in this type of trademark, it is important to take into account the scope of protection granted by the registration of a combined trademark. In the words of the TJCA, "The combined mark is a unit, in which the registration of the nominative element as well as the graphic element has been requested as one.

When the registration of the mixed mark is granted, it is protected in its entirety and not its separate elements" (emphasis outside the original text)..

In this understanding, the application for registration of the combined trademark must be accompanied by its reproduction, so that both the word elements and the graphics that make it up are appreciated. In addition, as indicated for figurative marks, if the applicant wishes to claim colors within the combined mark, they must indicate so, and likewise, the graphic element of the combined mark may be composed of photographs, drawings, caricatures. or isotypes as a graphic representation.

As an example, we have the following combined trademark, registered

by the SIC in favor of Mercado Libre, INC, in which the applicant did not present a color claim:



For its part, in Peru, INDECOPI granted registration of the combined trademark Mercado Libre in which the applicant did claim colors. :



1.2.2. Non-traditional trademarks.

The specific tastes and needs of the consumer change over time, therefore, manufacturers, merchants and providers of goods and services use ways to be noticed and preferred by the consumer public in a different way than usual, evolving their marketing strategies, branding, positioning, etc., and for this, trademarks have become the necessary vehicle that allows establishing this link between provider and consumer.

Thus, a new range or type of trademarks emerges that, through disruptive and non-traditional forms, seek to attract the attention of the consumer public, and obtain their preference, but also their permanence and loyalty, in the face of the universe of possibilities against which they compete today in the market and which are called non-traditional trademarks.

DA 486 does not specifically contemplate the classification of traditional and non-traditional trademarks, but article 134 expressly indicates that sounds and smells may constitute trademarks, and leaves open a window of possibilities, indicating that, "they may constitute trademarks, **among others** , the following signs... " Along these lines, it is clear that within the CAN protection system there are the so-called non-traditional trademarks that, although some cannot be appreciated by the sense of sight, can be perceptible by the other senses (smell, touch, taste and

hearing); and, therefore, they are susceptible to identification and differentiation.

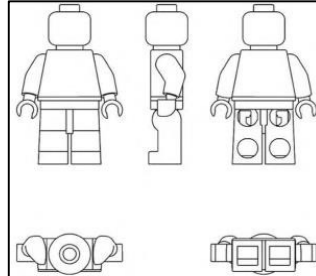
1.2.2.1. Three-dimensional marks.

Subparagraph f) of article 134 of DA 486 expressly establishes the possibility that " the shape of the products, their packaging or wrapping" may constitute a trademark;

The TJCA has established that " A three-dimensional sign is one that occupies the three dimensions of space: it is a body provided with volume. Within this class are the shapes of the products, as well as their packaging, wrapping and engravings.

The three-dimensional sign constitutes a class of signs with such peculiar characteristics that they merit its classification as independent of denominative, figurative and combined signs . .

For example, we find the following three-dimensional mark granted by INDECOPI, to identify products of class 28:

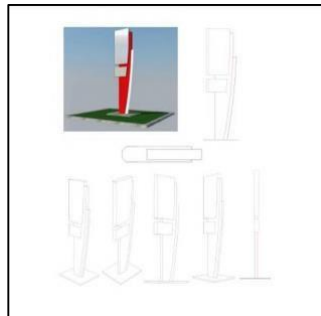


For its part, SENADI, in Ecuador, granted this three-dimensional mark to identify class 3 products:



Likewise, there are three-dimensional marks that do not necessarily constitute the shape of the product or its packaging, such as the

Mercedes-Benz brand logo that can be seen on the front of its vehicles, as well as three-dimensional marks that are not intended to distinguish products but services, as occurred with the shape of the buildings of the Pizza Hut restaurants or with other elements that can be used to identify the provision of the service, such as the particular shape of the following structure that identifies the Terpel service stations and that was granted by the SIC to identify products of classes 1 and 4 and services of classes 35 and 37:



However, if the three-dimensional mark contains figurative or word elements as an integral part of the sign, it will be classified as a combined three-dimensional mark. In these cases, protection is subject to the distinctiveness of the trademark set in its entirety; In fact, it is possible that the three-dimensional shape by itself does not have distinctiveness, but the figurative and/or denominative elements that accompany it give distinctiveness to the combined sign, for example, this combined three-dimensional mark granted by the SIC to identify products of class 30:



The reason why three-dimensional trademarks continue to be considered non-traditional, despite the fact that they are used in the market with increasing frequency since there are currently many applications and registrations of these trademarks in industrial property offices, is because of their graphic representation, since

each office has established the way in which, according to its understanding, said representation allows the particularities of the trademark to be clearly defined.

For example, offices may require the presentation of images, either through drawings or photographs, that allow the details of the mark to be sufficiently appreciated, such as the one corresponding to the previous example, or the applicant may also be required to provide images of different views or planes of the three-dimensional shape, as in the following case:



In any case, it is also possible for the office to request a description of the trademark in words and/or a sample of the shape that is the subject of the registration application in order to know the details of the sign.

1.2.2.2. Color markings.

They are marks that are made up of a color delimited by a shape or a combination of colors. In this sense, the TJCA has established that: *"The community standard, specifically literal e) of article 134 of Decision 486, provides for the registration of a color delimited by a shape or a combination of colors, that is, when the "The same is included in a silhouette or line can access registration as a trademark, as long as it does not fall into any other cause of unregistrability." .*

The graphic representation of this type of marks could be carried out through a pictorial representation of the color, delimited by a shape that is precise and unequivocal.

Additionally, the offices may also request a description of the color, as well as the internationally recognized identification

code, which makes it possible to clearly establish, that is, determine precisely the color that is the subject of the registration application. For this purpose, classifications such as Pantone, Focoltone or RGB may be used.

Now, in relation to the way in which the color requested for registration should be delimited, it is important to point out that in accordance with what the TJCA has recognized, this should be understood as an additional requirement, if you will special, that must be comply with applications for color trademarks and that the way in which the color is presented delimited does not need to be distinctive, since, due to the very nature of this trademark, its registration is requested precisely on one or more specific colors, without exclusive rights are claimed over the way in which these are presented within the application.

In this regard, the TJCA indicated:

"It should be clarified that the particular feature of this type of trademark is the color itself, although the legislator has required as an additional requirement that it be delimited by a shape, the analysis of distinctiveness cannot be carried out independently with respect to the elements members of the requested sign, thus demanding a requirement not contemplated in the Andean Standard consisting of the distinctiveness of the shape that delimits the color, because if the above were required it would denature the essence of the color mark .

Specifically, in relation to the issue of graphic representation in the case of isolated colors, this does not pose a problem, if we understand that, for their inclusion in the request and corresponding representation, it is required that it be delimited in some way.

Below are some examples of how color or color combinations can be represented graphically in your application:

The following is a color mark granted by the SIC, to identify products of classes 5 and 29. The following description was included in the application:

"PANTONE 136C, LA THE PURPOSE OF THE DOTATED LINE IS TO DELIMIT THE COLOR. NO EXCLUSIVITY IS CLAIMED ABOUT THE WAY IN WHICH THE COLOR

APPEARS, WHICH MAY BE APPLIED TO OTHER WAYS” .



In this other example, the mark granted by the SIC, to identify products of classes 9 and 42, consists of the gradient and combination of the colors claimed in the application, delimited by the shape of a square that has curved edges: C :78; M:67; Y:0; K:0 R:5;G:10; B:230 # 405de6, - C:75; M:72; Y:0; K:0 R:88;G:81; B:216 #5851d8, -C:61; M:85; Y:0; K:0 R:131;G:58; B:180 #833ab4, - C:23; M:93; Y:14 K:0 R:193;G:53; B:132 # C13584 - C:6; M:95; Y:36; K:0 R:225;G:48; B:108 # E130 - C:1; M:87; Y:69; K:0 R:236G:72; B:76 # fd1d1d - C:75; M:72; Y:0; K:0 R:88;G:81; B:216 # f56040 - C:0; M:67; Y:86; K:0 R:247;G:119; B:55 # f77737 - C:0; M:36; Y:83; K:0 R:252;G:175; B:69 #fc4f45 -C:1; M:12; Y:59; K:0 R:225;G:220; B:128 #ffdc80.



1.2.2.3. Position marks.

Although this type of sign is not expressly included in the list of article 134, the position mark falls within the generality of said article, which establishes that a trademark is “any sign capable of distinguishing goods or services in the market.”

This trademark is constituted by a sign that is placed in the same place on a product consistently. In the terms set forth by the WIPO SCT “These marks are defined by the position in which they appear on a certain product or are attached to it .”

In practice, it has been observed that this type of trademark is used mostly in the clothing and footwear industry, as well as accessories such as bags, wallets and belts, although it is worth clarifying that the protection does not concern the products but rather the position. of a sign within the product.

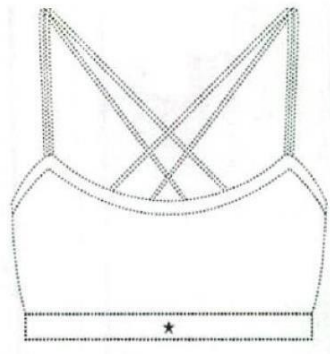
In relation to the graphic representation of this type of non-traditional marks, the SCT has indicated that " Position marks are generally treated as figurative marks and only a representation with a single image of the sign is required ." "

For its part, the "Common Communication on the Representation of New Types of Marks", issued by the European Union Intellectual Property Network (hereinafter EUIPN), established that for the position mark must comply with the "presentation of a reproduction that adequately identifies the position of the sign and its size or proportion in relation to the goods in question. The elements that are not part of the subject matter of the registration must be visually excluded, preferably by broken or dotted lines. The representation may be accompanied by a description detailing the manner in which the sign is placed on the goods".

This is how the graphic representation of the position mark must consist of an image with a single view of the mark in which the position and proportion of the sign within the surface on which it will be applied is adequately appreciated.

In order to ensure absolute clarity as to the scope of the right claimed, it is recommended that the image indicate, with dotted lines, the surface on which the object of protection does not fall, and indicate with continuous lines the shapes or figures that constitute the object of protection.

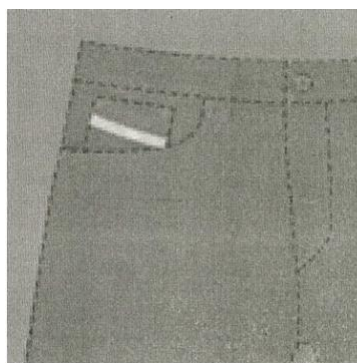
Here are some examples of how a position mark has been represented graphically :



In this process, the following description was submitted by the applicant:

THE TRADEMARK CONSISTS OF THE POSITION OF A BRAND STAR CONSISTS OF THE POSITION OF A MATTALIZED COLOR STAR (sicsic), LOCATED IN THE LOWER CENTRAL FRONT PART OF THE UNDERWEAR. THE DOTATED LINE IT IS NOT A CHARACTERISTIC FEATURE OF THE TRADEMARK AND IS PURPOSE TO ESTABLISH THE LOCATION OF THE STAR ON THE UNDERWEAR. NO EXCLUSIVITY IS CLAIMED ABOUT THE SHAPE OF THE GARMENT OR THE COLOR OF THE STAR."

In another more recent procedure, the SIC granted the registration of a position mark for products in class 25, with the following graphic representation:



For this purpose, the applicant presented the following description: "The mark consists of the position of a narrow band of fabric, located diagonally on the front of the fifth pocket of a pair of pants."

INDECOPI granted the registration of the following position mark, described as *"The red stripe located on the lower part of the sole of a footwear article, where the dotted line indicates the position*

of the mark and is not part of the mark, according to the model". :



In Ecuador, registration of the following sign was granted, which was described in the application: " The trademark consists of the combination of orange (RAL 2010) and gray (RAL 7035) colors applied to the products. The orange color is applied to the top of the merchandise shell and the gray color is applied to the bottom of the merchandise shell. The orange color is also applied to the protector. The dotted outline of the products is intended to show the position of the trademark and is not part of the trademark. :



1.2.2.4. Animated or motion marks.

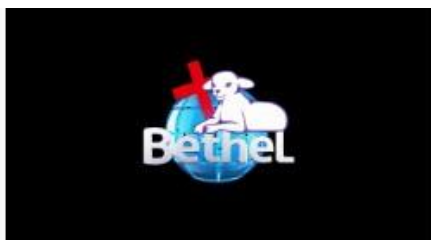
According to what is stated by the WIPO SCT, this type of mark is constituted by "the movement of a certain object (for example, a combination of the object and the visually perceptible movement) ", in other words, the sign that distinguishes the product or service corresponds to a sequence of movements.

There are more complex movement marks, such as multimedia marks, defined by the SCT as "a mark that consists of, or includes, a combination of images and sound", therefore, having sound, the representation does not necessarily have to be graph .

For the purposes of covering the requirement of graphic representation that is required in accordance with DA 486, an application can be submitted with a series of fixed sequential images (be it photographs, drawings, among others) that show

movement. It is also necessary to specify the chronological order of the images, for which images and sounds can be numbered, including that sequence in the written description. Some offices limit the number of frames that can be submitted; Other elements of the description may be duration, direction and frequency of movement.

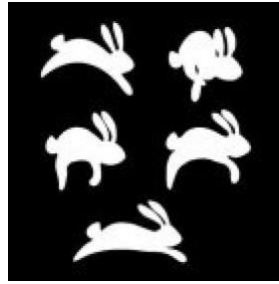
As an example, we can cite the following trademarks that have been registered as animated; First of all, we have the Bethel trademark, granted by INDECOPI to identify services of classes 38 and 41 :



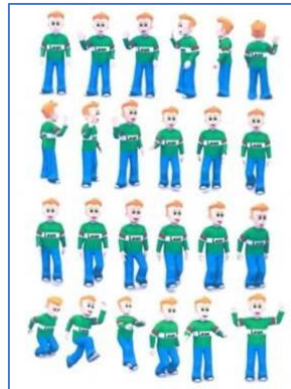
INDECOPI also granted registration of the Mertz trademark, to identify services in class 45. :



Additionally, according to the requirements of each office, the request may be accompanied by a description that details the sequence of the movement; As an example, the application for the following animated trademark, which was granted by the SIC to identify products in classes 9 and 11, included as a description: " Animated trademark consisting of the moving image of a running bunny, five positions of which are shown in the drawing. The black square represents the background and/or transparent areas and is not a feature of the trademark. Color is not claimed as a characteristic of the trademark ".



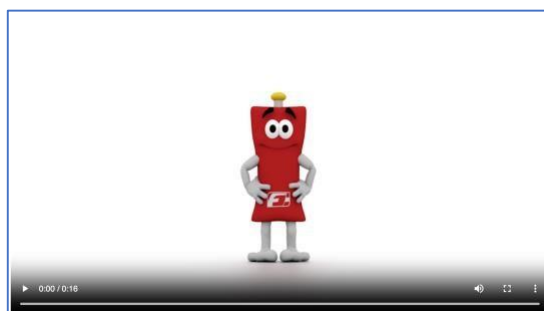
The description can also be very useful to more appropriately understand the sequence of movements, like this one, which explains it like this: "Start: the character in a resting position; the character greets with a raised hand; With your hand still up, you begin a 360-degree turn around; the turn continues; the turn ends and the character lowers his hand; starts walking; take 12 steps; As he walks, the camera begins to rotate to observe the character; continue the walk; it stops; he crouches to push himself up; is compressed for jumping; jump; land; he straightens up after the jump; raise both arms; "Finish with the victory position with your fingers, and with both arms up." The description corresponds to an animated trademark that was graphically represented with the following image :



On the other hand, and taking into consideration that animated trademarks must comply, in addition to graphic representation, with the requirement of distinctiveness, we must point out that this is acquired as long as the movement is not common in the category of goods or services in question. Habitual movement is understood as movement that the target audience perceives as movements due to technical or functional characteristics of the product. .

Now, it should be noted at this point that, in accordance with the European Union Trademark Regulation, signs must be "represented in the European Union Trademark Registry in a way that allows the competent authorities and the general public to determine the clear and precise object of the protection granted to its owner." . As can be seen, the Regulation does not refer to graphic representation, but only to the sign being represented in the registration, which explains the position of the SCT in the sense that the multimedia trademark does not necessarily have to have graphic representation.

Thus, for example, the EUIPO considered that the requirement of representation, through video or digital support, was met in cases like this :



On the other hand, within this category of animated or movement marks, there are also gestural signs to which, consequently, the same criteria for compliance with the graphic representation that have been mentioned apply.

Notwithstanding the foregoing, some industrial property offices, as is the case of the SIC, have considered them as a type of trademark different from animated trademarks. Thus, this office, for example, has stated that the gestural mark consists of a distinctive body gesture that can be linked to a product or service and to a business origin, and that its graphic representation can be made by means of a drawing or an image and a description that must consist of an explanation of the gesture.

In Colombia, the sign described as follows was registered as a gestural mark in favor of the renowned soccer player Carlos "El Pibe" Valderrama: *"it consists of the gesture "all good" accompanied by the extended thumb, as a sign of approval" and whose application,*

additionally, was accompanied by the following images”:



For its part, in Ecuador, SENADI granted registration of the MANUAL GESTURE trademark described as follows: *"The requested mark is made up of the manual gesture which consists of inserting the index finger into the creamy center of a ring-shaped cookie, as shown in the accompanying graphics."*



1.2.2.5. Sound marks.

They are trademarks that are made up of sounds, whether those created by a composer, those found in nature or sounds that derive from an activity or particular situation.

Some examples are the sound of Windows created by a composer, the roar of the Metro Goldwyn Mayer lion that is derived from nature, the noise derived from the acceleration of a car or engine, and the sound produced when rain hits A window.

The general description of "sound" includes both a single one and a combination of these, in addition the SCT, in its nineteenth session, in point 42 of its document called " The representation and description of non-traditional trademarks, possible areas of convergence ", indicates what types of sounds are those that are accepted as sound marks:

"Sound trademarks may consist of musical sounds, either pre-existing or created especially for the purposes of trademark registration. Likewise, they may consist of musical sounds, existing in nature (for example, sounds of animals or corresponding to meteorological or geographical phenomena) or produced by machines or other devices created by humans."

For the purposes of complying with the graphic representation required by the industrial property offices of the CAN, a staff with musical notes is generally accepted, as well as other technical means such as oscillograms, spectrograms or sonograms to represent sound signs. Similarly, offices may require an audio file and/or sound recording; However, the example of the Metro Goldwyn Mayer lion's roar is known, which cannot be represented on a staff, which is why, in some jurisdictions outside the CAN, the description of the sound using words is allowed.

Some examples of sound trademarks registered in the CAN Member Countries are the following:

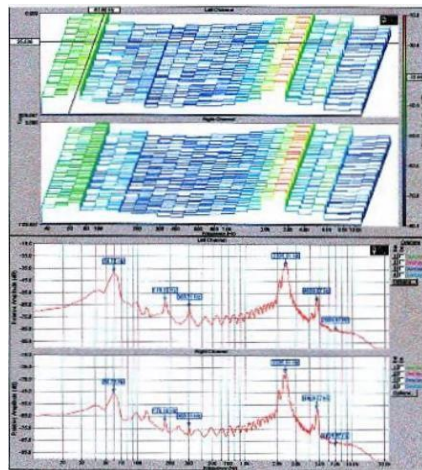
First of all, we find the registration by the SIC of a sound mark to identify products of classes 29, 30 and 32, and whose graphic representation was made through (i) staff and (ii) digital audio file.



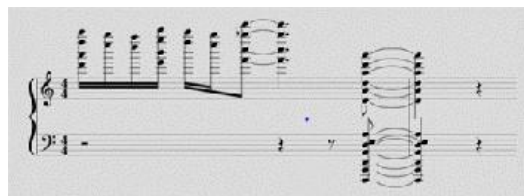
Likewise, in Ecuador, the sound sign NOKIA BOOT-UP TUNE was registered with SENADI, to identify products of class 9, whose graphic representation was the staff :



On the other hand, we have the registration that the SIC granted to identify class 41 services , in the application for which used a sonogram to graphically represent its trademark, additionally displayed a file containing the sound reproduction :



In Peru In , the staff and an audio with the reproduction of the sound were presented, as shown below.



1.2.2.6. Olfactory marks.

Distinguishing a product or service through a smell is the objective of this type of trademark. They are not common in the market, but they do have a presence in commerce, since one of the most important factors for a consumer to identify goods and services is memory, and this does not necessarily have to be visual.

Olfactory trademarks find their basis in literal c) of article 134 of DA 486, which deals with trademarks that are composed of odors.

The SCT, in its nineteenth session, held in Geneva, establishes in point 48 of its document called "The representation and description

of non-traditional trademarks possible areas of convergence” , the following :

“In some countries, olfactory trademarks have been registered. Although the registration of this type of sign remains exceptional, it appears that its representation may consist of a written of the smell. This representation will be made in such a way that description the information necessary to properly identify the trademark is transmitted to an ordinary person.”

The treatment given to this type of trademarks in the different offices can vary depending on the way in which the representation of the trademark must be presented, in addition to the question of whether the aroma is really distinctive based on the diverse perception that we may have. in relation to a scent.

In summary, the problem that has been identified in some offices regarding the representation of an olfactory sign for registration as a trademark is presented in the following points:

- If the representation is made through a formula, it does not represent the smell itself.
- A written description may not be clear and precise.
- The physical sample does not constitute a representation in itself and the stability of the fragrance or essence cannot be guaranteed.

However, it is also possible that one or more of the aforementioned criteria, for some offices, may be sufficient to adequately represent an olfactory sign, allowing office examiners, authorities and the general public to determine clearly and accurately the precise object of the protection granted to the applicant .

Although the CAN does not yet have a registered olfactory trademark, in international practice there are some current registrations for this type of trademark, for example, in Argentina we find the antecedent of the olfactory trademark that has the following description: “ the trademark includes “a cherry fragrance applied to hair product packaging that is achieved by applying the substance *Prunus dulcis* to the packaging.” .

In Mexico, on the other hand, the olfactory mark of a scented toy

modeling paste was described as follows, to identify products in class 8: "an unmistakable odor formed by a sweet, somewhat mossy combination of a fragrance with tones of vanilla, with small cherry accents and the natural smell of a salty wheat-based dough."

1.2.2.7. Tactile marks.

The tactile mark also falls within the generality of article 134 and is constituted by the texture or structure of the surface of a product, container or its wrapping. This means that the distinctiveness of the sign lies in the way of feeling the product to determine that it is different from another of the same species.

DA 486 does not specifically refer to tactile marks, however, to understand the purpose of their protection, we can use the concepts provided by the WIPO SCT, in its nineteenth session, held in Geneva, which establishes in the point 51 of its document called "The representation and description of non-traditional trademarks possible areas of convergence" that:

"In the case of texture marks, it is the surface of the product that can lead to its recognition, for example, thanks to a specific and recognizable structure or texture. Although the registration of texture or tactile marks remains exceptional, some ways of representing these signs have become evident."

For its part, the TJCA, in the Preliminary Interpretation issued on the occasion of a consultation submitted by the Directorate of Distinctive Signs of the SIC , pointed out that:

"Tactile or texture trademarks are those new types of trademarks that precisely allow the consumer to identify the texture of a product, its container, wrapper or packaging with a specific business origin.

In so-called tactile marks, it is the surface that gives rise to their recognition and protection, for example, because it is a particular and recognizable texture. To be susceptible to protection by trademark registration, said texture must serve to inform about the business origin of the product that is intended to be distinguished. A specific texture may be protected as a distinctive sign if it is arbitrary and particular in relation to the product it distinguishes; criterion that includes non-functionality, or if it

has acquired distinctiveness through constant use in the market."

Regarding the graphic representation of tactile marks, the TJCA indicated that, according to a broad interpretation, two requirements must meet:

- "i) the clear, precise and complete **description** of the sign, including a three-dimensional drawing or photograph; and,*
- ii) **physical sample of the tactile mark** .*

Both requirements aim to sufficiently represent the sign, taking into special consideration the principle of precision developed in this paper.

Therefore, the Competent National Office must follow the following criteria:

First of all, there must be a clear, precise and complete description of the texture, including a three-dimensional drawing or photograph.

Secondly, a physical sample of the object containing the texture must be presented. The Competent National Offices must allow access to said objects when requested." (bold outside original text)."

There are definitely not many cases that exist in the world regarding this type of signs, the trademark object of the application, which gave rise to the aforementioned consultation by the SIC to the TJCA, was first granted in Ecuador, through Resolution No. 35499-04 dated April 27, 2024 with registration title No. 29597 and subsequently in Colombia in accordance with Resolution No. 34530 of 2016, issued by the Directorate of Distinctive Signs of the SIC, under file 15-045738.

"THE "OLD PARR SURFACE TEXTURE" CONSISTS OF AN EMBOSSED TEXTURE (SURFACE) WITH A CRACKED, CRACKED, OR CRACKED APPEARANCE CREATED FROM CRACKLED, CRACKED OR CRACKED APPEARANCE, CREATED FROM THE AGGLOMERATION OF IRREGULAR GEOMETRIC SHAPES INCLUDING MOSTLY PENTAGONS, RHOMBOIDS AND HEXAGONS, WHOSE SIDES OR LINE SEGMENTS MEASURE BETWEEN 3 AND 6 MILLIMETERS IN LENGTH, BETWEEN 0.08 AND 0.5 MILLIMETERS IN HEIGHT AND BETWEEN 0.1 AND 1 MILLIMETER IN THICKNESS. THE SIDES/LINE SEGMENTS AND THE AREAS CONTAINED WITHIN THESE LINE

SEGMENTS ARE WITHIN THESE LINE SEGMENTS ARE SMOOTH. THE MATERIAL ON WHICH THIS TEXTURE IS USED SHALL BE AMBER COLORED GLASS AND SHALL BE USED IN A VARIETY OF SIZES. DIFFERENT SIZES".

Additionally, in this case, both the physical sample of the bottle and the image reproduced below:



1.2.3. Collective Trademarks.

Article 180 of DA 486 establishes that:

"Collective trademark shall be understood as any sign that serves to distinguish the origin or any other common characteristic of goods or services belonging to different companies and that use it under the control of an owner."

These are trademarks that fulfill the same functions as trademarks, the difference is that the collective trademark distinguishes the origin or any other common characteristic of goods or services belonging to different companies that use it under the control of an owner; The trademark serves to distinguish the goods or services offered by that community that owns the trademark and they are responsible for ensuring that the goods or services comply with the standards established in the regulations that govern them, guaranteeing their quality and characteristics.

This type of trademark traditionally cannot be licensed to third parties and its use is reserved for the members of the association that owns the trademark rights; However, Andean regulations do provide for the licensing of the trademark subject to the internal rules of the association, the same occurs in relation to the transfer rights, which is permitted under the same parameter. For its of recognition before third parties, some countries require its registration with the competent authority.

The essential element regarding collective trademarks refers to the indication of the conditions and characteristics of how they should be used in goods or services, an element that is known as the regulation of use and provided as a sine qua non requirement to be able to register the trademark.

As it is not prohibited in DA 486, it is understood that the use of individual trademarks accompanied by the collective trademark is permitted, unless the indication of the conditions and the way in which the collective trademark must be used on the goods or services establishes otherwise.

The collective trademark can be registered by legally established associations of producers, manufacturers, service providers, organizations or groups of people.

The requirements that must be submitted for registration under DA 486 are:

"Article 182.- The registration application must indicate that it is a collective trademark and be accompanied by:

- a) copy of the statutes of the association, organization or group of people requesting registration of the collective mark;
- b) the list of members; and,
- c) the indication of the conditions and the way in which the collective mark must be used on the goods or services.

Once the collective trademark registration has been obtained, the association, organization or group of people must inform the competent national office of any change that occurs in any of the documents referred to in this article.

The analysis of these documents is carried out in section 1.5.6.1. of chapter 2 of this Manual. Below are some examples of collective trademarks.

First of all, we find the collective trademark Kemito Ene, granted by INDECOPI to distinguish the following products in class 30: Cocoa, roasted cocoa, cocoa powder, cocoa paste, cocoa milk, cocoa-

based drinks, coffee, ground coffee, roasted and unroasted coffee, coffee-based drinks . This trademark has around 450 families of indigenous Asháninka producers and is controlled by the Kemito-Ene Producers Association, based in the province of Satipo, department of Junín.



In Colombia, for its part, the SIC granted registration of the collective trademark Bocatello to the Association of Sandwich Entrepreneurs of the province of Vélez and Ricaurte (ASOVELEÑOS), to distinguish the following products of class 30: combined veleño sandwich, veleño red guava sandwich, tume veleño stuffed with arequipe, pieces of red guava combined with arequipe, market or bars of red or combined guava, market of red guava for industrial use .



In Ecuador, we found that the Association of Producers and Marketers of Salcedo Ice Cream requested registration of the collective trademark Los Helados de Salcedo in Ecuador to identify products of class 30.



In Bolivia, through the National Intellectual Property Service

(hereinafter SENAPI), the registration of the collective trademark ASOCAFÉ Taipiplaya was granted in favor of the Association of Coffee Growers of Taipiplaya of the province of Caranavi - Town of Taipiplaya, to distinguish the following products from class 30: coffee .



1.2.4. Certification Marks.

The certification mark is a distinctive sign that is applied to goods or services, as long as they have a certain quality or other characteristics whose control, verification and certification are the responsibility of the owner of the mark.

Through this legal figure, it is guaranteed that the goods or services that are distinguished with that mark comply with the standards determined by its holder and that must be included in the corresponding Regulations for use, and the user of the certification mark legitimately benefits from the prestige that has been generated by the holder of that mark.

This type of trademark, in some cases, allows the establishment of a technique and automation in the production and elaboration processes, either through technology or by using the knowledge that the trademark holder can provide to the consumer.

Certification marks may not be used in connection with goods or services produced, rendered or marketed by the trademark holder itself. However, in relation to use by third parties, licenses for use of the certification mark are subject to the users complying with the rules of use established by the owner of the mark, who sets and implements the quality control and verification measures of the licensed mark.

The requirements that must be submitted for registration under DA 486 are:

"Article 187.- The application for registration of a certification mark shall be accompanied by the rules for use of the mark, which shall specify the goods or services that may be covered by the owner's certification, define the characteristics guaranteed by the presence of the mark and describe the manner in which control over such characteristics shall be exercised before and after use of the mark has been authorized."

Below are some examples of certification marks.



The Ministry of Environment and Sustainable Development of Colombia registered this certification mark to distinguish certification services applied to any product or service that can reduce adverse environmental effects.



The Ministry of Women and Vulnerable Populations (MIMP) of Peru registered this trademark certification to distinguish goods and services from the 45 classes of the Classification from Nice, which come from companies and entities that show efforts to prevent non-violence against women, as well as gender equality, within their organizations and the surrounding community.



The company Sinba Sura SAC registered this certification mark in Peru to distinguish restaurant (food) and lodging services provided by companies that follow a comprehensive solid waste management program.



In Ecuador, the registration of the certification mark MABIO MATADERO UNDER OFFICIAL INSPECTION AGROCALIDAD was granted to the Phyto and Zoosanitary Regulation and Control Agency, to identify services of class 42 :



The Departmental Autonomous Government of Tarija in Bolivia registered the certification mark to distinguish products of class 29, with the objective of positioning the identity of quality products produced in said department, for the benefit of its region.

2. Distinctive appearances.

In response to the broad interpretation of article 134 of DA 486, Ecuador expressly regulates in its national regulations the figure of distinctive appearance, known in other jurisdictions as " trade dress ", that is, a type of trademark. The Organic Code of the Social Economy of Knowledge, Creativity and Innovation (COESCCI) of Ecuador provides us with the following definition for this sign.

"Article 426.- Definition. - Distinctive appearance will be understood as any set of colors, shapes, presentations, structures and designs characteristic and particular of a commercial establishment or a product in the market, provided that they are suitable to distinguish it in the presentation of services or sale of products."

The only condition that gives rise to the existence of the distinctive appearance is that the sign combines the elements that give it distinctiveness in Ecuador and indicates that these acquire and generate protectable and enforceable rights, to the same extent that the trademarks, that is, they deserve protection and conservation, as established in article 427 of the COESCCI:

"Article 427.- Acquisition and exercise of distinctive appearances.
- Distinctive appearances will be acquired and rights will be exercised in an identical manner to trademarks, as long as they have acquired a distinctive aptitude in the Ecuadorian market, in accordance with the respective regulations, or are inherently distinctive.

In Ecuador, to obtain the protection of a distinctive appearance to identify products, services or establishments, it is necessary to submit an application, which will follow the registration process of a distinctive sign and for cases in which the applicant invokes acquired distinctive ability, it must present a sworn declaration and demonstrate use in the Ecuadorian market, in accordance with its internal regulations.

Ecuador granted registration as a distinctive appearance of the OKIDOKI sign, for supermarkets.



Distinctive appearances or commercial image, as it is known in other latitudes, should not be confused with the corporate image or corporate identity, since each and every one of them has a diverse application and objectives.

- The commercial image is applied to the set of elements that make up the appearance with which a product or an establishment is presented to the public, in short, how the product or the commercial premises looks.
- The corporate image is what the company wants to convey about itself, the expression of your personality, for which you can use the commercial image of their products or their physical establishments.
- Corporate identity is, for its part, the way in which the public perceives the trademark, that is, the point reached having made use of the two previous concepts.

For an adequate representation of the trade dress, photographs, drawings, images, isotypes, etc. may be accepted.

3. Commercial Slogans.

Commercial slogans, known as slogans or commercial notices in other jurisdictions, find their legal reference in articles 175 to 179 of DA 486. The first of these legal precepts states:

"Article 175.- Member Countries may register commercial slogans as trademarks, in accordance with their respective national legislation. A commercial slogan is understood to be the word, phrase or legend used as a complement to a Trademark."

The preceding legal provision not only constitutes the legal reference of the concept, but also defines it and indicates what should be understood by a commercial slogan: a word, phrase or legend used as a complement to a trademark, up to this point there is no prohibition in relation to it. with which it is accepted as as long as it is used as a trademark complement and, furthermore, it is a motto, inferred from its reading that commercial mottos can only be registered as nominative signs.

The commercial slogan in the CAN is governed by the rules that govern trademarks and does not have an autonomous and independent life, since it only subsists as long as the brand to which it is linked also does so.

The TJCA has expressed itself regarding the nature of the commercial slogan, and in Prejudicial Interpretation 377-IP-2018 takes up the following criterion already mentioned in other resolutions by the same Court:

"It is therefore a sign that is added to the brand to complete its distinctive force and to provide commercial advertising of the product or service that constitutes its object. This Court has referred to the commercial slogan as a distinctive sign that seeks to protect the consumer, in order to prevent the consumer from being misled or confused. It is a complement to the trademark that is intended to reinforce its distinctiveness, therefore, when the registration of a commercial slogan is intended, the trademark with which it will be used must always be specified."

Also in view of the accessory nature of the commercial slogan with respect to the trademark, the TJCA pointed out the following :

- When requesting the registration of a commercial slogan, the requested or registered trademark that will be advertised must be indicated (article 176 of DA 486).
- The commercial slogan must be distinctive and, therefore, cannot mislead the consuming public in the market. Therefore, the commercial slogan must be completely differentiated from the other protected distinctive signs, taking into account the covered and related products (article 177 of DA 486).

Some examples of registered commercial slogans:

- Commercial slogan "Lo nuestro nos hace latir" for products in class 32, granted by the SIC for the associated trademark "COLOMBIANA, LA NUESTRA" .
- Commercial slogan "No Lay's no game", associated with the "LAY'S" trademark, granted in Ecuador .
- Commercial slogan "Te llama la llama" (What is ours makes us beat) granted by INDECOPI to identify trade fair organization services, associated to the trademark "FERIA INTERNACIONAL DEL PACIFICO".
- Commercial slogan "the taste of Christmas", which accompanies the main trademark "D'ONOFRIO", awarded by SENAPI.

4. Trade Names.

Trade names find their legal reference in articles 190 to 200 of DA 486. The first of these legal precepts states:

"Article 190.- A trade name shall be understood as any sign that identifies an economic activity, a company, or a commercial establishment.

A company or establishment may have more than one trade name. It may constitute the commercial name of a company or establishment, among others, its corporate name, company name or other designation registered in a registry of persons or commercial companies.

Trade names are independent of the names or corporate names of the legal entities, and both can coexist."

In essence, the difference between this legal figure and the trademarks that are used to distinguish in commerce the goods or services to which they are applied is that the commercial name is intended to distinguish the manufacturer or seller of the product or, in its case, to the service provider.

This figure is known as " trade name " in common law, and is used to refer to the name of a business.

"It should be noted that although Decision 486 does not contain a definition of commercial ensign, this concept is closely linked to that of the trade name, the definition of which is found in Article 190 of said Decision, as explained above.

While the trade name constitutes a global notion that is used to

identify the entrepreneur in the market, the economic activity of the entrepreneur or the establishment of the entrepreneur, the trade ensign identifies only the establishment, consisting of the distinctive expression contained in the sign or signboard that is perceptible to the eye of the consumers".

In some CAN Member Countries, a distinction between commercial name and commercial logo is emphasized. Regarding the difference in the object of protection of these two figures, the TJCA clarified the following:

"It should be noted that although Decision 486 does not contain a definition of a commercial trademark, this concept is closely linked to that of the commercial name, whose definition is found in Article 190 of the aforementioned Decision, as explained above. While the commercial name constitutes a global notion that is used to identify the entrepreneur in the market, the economic activity of the entrepreneur or the establishment of the entrepreneur, the commercial flag identifies only the establishment, consisting of the distinctive expression contained in the label or sign. that is visible to consumers ".

As can be seen, the specific difference would be that the commercial name identifies the businessman or merchant as such, in the development of a commercial activity, and the commercial trademark would identify the commercial establishment.

Therefore, the denomination may coincide in its denomination the ensign, the trade name and even the trademark, making it possible for the businessman or trader to choose a trade name to identify himself, with a different ensign to identify his business establishment and a different trademark to identify the goods or services he markets.

It should be noted that the exclusive right over a trade name is acquired through its first use in commerce and ends when the use of the name ceases or the activities of the company or establishment that uses it cease.

In accordance with the internal legislation of each Member Country, the owner of a commercial name may register or deposit it with the competent national office. The registration or deposit will have a declarative nature.

CHAPTER 2 TRADEMARK REGISTRATION PROCEDURE

The trademark registration procedure includes five stages: formal examination, publication, opposition, substantive examination and resolution.

1. FORM EXAMINATION.

At this stage of the procedure, the trademark examiners of the offices verify that the applications for trademark registration meet the requirements contemplated in articles 138 and 139 of DA 486, namely:

" Article 138.- The application for registration of a trademark will be submitted to the competent national office and must include a single class of goods or services and comply with the following requirements:

- to) the petition;*
- b) the reproduction of the mark, when it is a word mark with graphics, shape or color, or a figurative, combined or three-dimensional mark with or without color;*
- c) the powers that were necessary;*
- d) proof of payment of the established fees;*
- e) the authorizations required in the cases provided for in articles 135 and 136, when applicable; and*
- f) if applicable, the certificate of registration in the country of origin issued by the authority that granted it and, if provided for in domestic legislation, proof of payment of the established fee, when the applicant wishes to avail himself of the right provided for. in Article 6quinquies of the Paris Convention.*

Article 139.- *The request for trademark registration will be contained in a form and will include the following:*

- a) the trademark registration requirement;*
- b) the name and address of the applicant;*
- c) the nationality or domicile of the applicant. When this is a legal entity, the place of incorporation must be indicated;*
- d) if applicable, the name and address of the applicant's legal representative;*
- e) the indication of the trademark that is intended to be registered, when it is a purely word trademark, without writing, shape or color;*

- f) the express indication of the goods or services for which trademark registration is requested;
- g) the indication of the class to which the products correspond or services; and,
- h) the signature of the applicant or his legal representative."

It is very important that both the information and documents provided with the application be reviewed in detail to verify compliance with these requirements, as well as those provided, if applicable, in national legislation. This review will allow the office to have absolute clarity about the scope of the requested right.

1.1. Application submission form.

As established in article 138 of DA 486, the application for registration of a trademark must be submitted through a petition.

For this purpose, and in accordance with local legislation, each office has prepared forms in accordance with its domestic practice, as can be seen in the following table:

Office .	Form name	Types of request
SENAPI	PI100. Sign Request Distinctive .	Product trademark registration application, of services, collective , certification and law , preferential and others .
	PI101. Application commercial name, label commercial or teaching . .	Trade name application . .
	PI102. Commercial slogan registration application	Application commercial slogan.
SENADI	Distinctive signs registration form .	Application for registration of trademarks for products, services, collectives, certification, commercial slogans, commercial names and labels or emblems, distinctive appearances, geographical indications,

		designations of origin.
SIC	PI01F01. Registration of trademarks and commercial slogans .	Application for registration of trademarks for products, services, collectives, certification, commercial slogans and preferential right.
	PI01F02. Application for deposit of trademarks and trade names.	Application for deposit of trademarks and trade names.
INDECOPI	Application for registration of a product/service and/or multiclass trademark.	Application for trademark registration of products and/or services.
	Application for registration of commercial slogan.	Application for registration of commercial slogan.
	Collective trademark registration application.	Collective trademark registration application.
	Certification trademark registration application.	Certification trademark registration application.
	Commercial name registration application.	Commercial name registration application.
	Registration application for distinctive signs online	Application for registration of a product trademark, Application for registration of a service mark, Application for registration of multiclass product and/or service marks, Application for registration of a commercial slogan, Application for a collective trademark, Certification mark application, Trade name application

The examiner must verify that the type of application has been correctly indicated, since, as has been seen, each distinctive sign is different and has particular aspects of study.

1.2. Presentation date assignment.

The assignment of the date of filing the application is a fundamental element in the trademark registration system, since it corresponds to the specific date (year, month, day and exact time) from which the applicant has a right priority to obtain the registration compared to other applications that are subsequently submitted in the same office and that, additionally, determines the beginning of the period that the applicant has to exercise the right of priority for the registration of that trademark in any of the other CAN Member Countries, or in another jurisdiction where it has that right under international agreements.

DA 486 establishes, in its article 140, that in order for the submission date to be assigned, the application must meet the following minimum requirements:

- Indicate that the registration of a trademark is requested.
- Include identification data of the applicant or the person submitting the application, or that allow the competent national office to contact that person. At this point, the full name of the applicant and an address to receive notifications must be indicated.
- Indicate the trademark whose registration is requested, or a reproduction of the trademark in the case of word marks with special spelling, shape or color, or figurative, combined or three-dimensional marks with or without color;
- Expressly indicate the goods or services for which you wish to protect the trademark; and,
- Proof of payment of the established fees.

In accordance with what is indicated in the aforementioned standard, if the application does not meet any of these minimum requirements, the office will not accept it for processing and, consequently, no filing date will be assigned.

Now, Decision 689 of the CAN empowered the Member Countries to establish through their internal regulations deadlines for correcting

the minimum requirements of article 140 of DA 486, which have been defined as follows:

Office	Deadline to correct minimum requirements.
Bolivia	Sixty (60) business days
Colombia	One (1) month
Ecuador	Sixty (60) business days If the applicant answers with defects, it is requested again and a period of ten (10) days is granted. .
Peru	Sixty (60) business days.

Therefore, if the application does not comply with any of the requirements established in article 140, the office will have to require the applicant to complete them within the corresponding period and, once the response is received and the requirement has been satisfactorily fulfilled, it will be will have the date of the response as the date of submission of the application . If the applicant does not provide a satisfactory and timely response to the request made by the office, the application will be considered not accepted and no submission date will be assigned.

1.3. Deadline for Form Examination.

The offices are obliged to carry out the formal examination within a period of fifteen (15) days, counted from the date of submission of the application, in accordance with the provisions of article 144 of DA 486.

Examiners must exhaustively review the information and documents provided by the applicant, to verify if the requirements established in articles 138 and 139 of the DA 486 or, if it is the case, in the national legislation, are complied with. If from the formal examination it appears that the application does not comply with the requirements, the office will request the applicant to comply with the aforementioned formal requirements within sixty (60) working days.

The request must clearly explain the inconsistency, inaccuracy or non-compliance that was identified by the office, so that the applicant is certain about the information and/or documents that must be provided to complete or clarify the request.

If the applicant does not comply satisfactorily and in a timely manner with the requirement made by the office, the application will be considered abandoned and, consequently, priority will be lost.

1.4. Examination of the requirements of the trademark registration application form.

In relation to the petition or application form for trademark registration, the offices must verify the following aspects, indicated in article 139 of DA 486:

1.4.1. The trademark registration requirement (literal a) of article 139 DA 486) .

As mentioned, the examiner must verify that the applicant has correctly indicated that the application refers to the registration of a trademark, since, as has been seen, each distinctive sign is different and has particular aspects of study.

In the event that it is noted that more than one request was indicated in the request , for example, if the applicant selected the commercial slogan and product trademark boxes on the form , the office should require clarification of what type of distinctive sign it wishes to protect, or, if it is clearly a commercial slogan, it should require that the product trademark indication be excluded.

1.4.2. Identification and contact data of the applicant and his legal representative, if applicable (literals b), c) and d) of article 139 DA 486) .

At this point, the office must verify that the applicant's identification data has been included, as well as contact information that allows the office to communicate with the applicant.

If the applicant is a natural person, the examiner, at this stage of the procedure, must verify that the applicant has entered his or her full name, identification number, nationality, domicile and address in the form. .

If the applicant is a legal entity, the examiner must verify, in addition to these identification and contact data, the place of its incorporation and the existence of the legal entity, as well as that the person submitting the application or has granted power to a third party, if It is the case, whoever holds his legal representation. Additionally, the request must include the identification and contact information of the legal representative of the legal entity.

1.4.3. The indication of the trademark that is intended to be registered (literal e) of article 139 DA 486) .

This requirement is satisfied when the applicant indicates the type of mark for which registration is sought. Thus, in the application form the applicant may indicate that the mark applied for is a word mark without graphics, shape or color, in which case it will not be required to attach or detail the reproduction of the mark additionally, or may indicate that the mark corresponds to another typology and shall attach the reproduction of the mark to the application (See 2.1.5.1. on reproduction of the mark).

Therefore, an injunction must be issued if the office considers that the nature of the sign that is the object of the application is not consistent with the scope of the marks, for example, the form indicates that the registration of a combined mark is requested, but as a graphic representation a figure in its three dimensions is provided, without a denomination.

1.4.4. The express indication of the goods or services for which the registration of the trademark is requested (literal f) of article 139 DA 486) .

Offices must be clear about the description of goods or services that an application seeks to identify, as this is one of the key elements to determine the scope of trademark protection. Therefore, the applicant must avoid ambiguous, vague or imprecise descriptions. In the event that the examiner identifies that there are contradictions or inconsistencies at this point, he or she must require the trademark applicant to clarify their application.

Now, in accordance with article 143 of DA 486, the goods or services may not be increased or expanded once the application is submitted, it being understood

"increase" as in including new goods or services and "expand" as making more general the goods or services that were indicated in a limited way

1.4.4.1. Descriptions of goods or services that are not acceptable in the application.

Below, some situations are identified that generate a requirement by the office in order to have complete clarity about the goods or services that the requested trademark intends to identify:

A. Ambiguous descriptions of goods or services.

- Descriptions that do not identify the product or service

Class 11 "System composed of plastic covers"

In this case, it is not known which product the trademark intends to distinguish, and, therefore, there will be no way to classify it.

- Broad descriptions that do not give rise to determining the scope of protection

Class 9 "All products included in this class"

Class 9 is one of those that includes the most dissimilar products, so accepting this description generates ambiguity. The Nice Classification is dynamic and some goods or services are reclassified in some edition change, so indicating all the goods or services that are contained in a particular class does not provide certainty about the scope of protection.

- Indicate products that correspond to a different class

Class 25 "General clothing and protective suits"

Although both products are clothing, depending on their use, material or destination, they are classified in different classes: while clothing in general corresponds to class 25, protective clothing is classified in class 9.

- General concept of a product that in particular belongs to different classes

Class 16 "Storage bags"

The description is ambiguous because there are many other bags for storing something that are found in various classes, such as:

"Bags for sleeping bags", in class 24.

"Hot water bottles", in class 11.

"Vacuum cleaner bag", in class 7.

In these cases, it is suggested to review the alphabetical list to look for already accepted descriptions, or some description that serves as an analogy, for example, "paper or plastic packaging bags."

B. Words and other terms not permitted in the description of goods or services.

The offices will not allow the description of the goods or services to contain terms that may violate the rights of third parties, since by indicating them in the description of the goods or services they vulgarize a term that may have acquired rights, whether individual or collective, as explained below. continuation:

- Trademarks

It is the case that due to constant use in the market, certain registered trademarks are identified as a term in general use to mainly identify certain types of products.

For example:

Class 9: "Apparatus for reproducing music and images, including BLURAY and other image playback devices"

BLURAY is a registered trademark with all its effects and if the offices accept it as a term in their product description they will be promoting the popularization of a registered trademark, which has acquired rights.

In this case, there are exceptions such as registered trademarks composed of the name of a product that have no relationship with the products they cover. For example, if a TAMARINDO mark existed to distinguish "furniture" from class 21 and an applicant files an application in class 31 for "unprocessed tamarinds", in these cases, there would be no impediment.

In the event that the application includes a registered trademark within the description of the goods or services that it seeks to identify, the office must require the applicant to eliminate that term from its description and, where appropriate, indicate the name of the product and You can optionally give options on how to write it.

- Geographical indications / designations of origin.

In some cases, the description of goods or services includes terms

that constitute a geographical indication / designation of origin with the intention of specifying in more detail what is intended to be protected.

For examples:

Class 30: "Villa Rica Coffee, Colombian Coffee, roasted coffee in general"

Class 33: "Alcoholic beverages, namely, wines, vodka, pisco, rum, spirits, tequila, sherry"

Class 41: "Recreational services related to hiking on the cacao route above"

Café Villa Rica, Café de Colombia, Tequila, Pisco and Cacao Arriba are protected designations of origin. This prohibition is not only restricted to geographical indications / designations of origin protected by the CAN Member Countries, it also includes those protected by other countries.

In cases like these, the offices will require the applicant to remove those terms from their description and, where appropriate, indicate the name of the product and may optionally give options on how to word them.

In the case of Colombia, the office may accept the designation of origin as long as the legend "product protected by the designation of origin" is indicated, and if it is not indicated, without request the office will include that legend in its description.

- Fantasy goods or services

Fantasy goods or services are understood to be those names that the applicant has invented to identify a particular product or service, because they do not have a definition in a dictionary.

For example:

Class 15: "churuco de dios; wind musical instruments

Churuco de dios does not have a meaning in the dictionary, it is a simple name that the applicant gave to a musical instrument.

The offices, in these cases, will require the applicant to clarify what is meant by that term and thus determine if the product or service is properly classified.

- Phrases that generate ambiguity

Phrases that attempt to more clearly identify a description of goods or services but that actually generate ambiguity are not permitted, since they only indicate certain goods or services without exhausting the description, for example:

"But not limited to"

"Including, but not limited to"

The following will also not be accepted:

"Among others" "etc."

"and else"

"similar to the previous ones"

The above descriptions are intended to replace or continue a description, but do not indicate or specify the goods or services.

1.4.4.2. Words and other terms permitted in the description of goods or services.

Offices may accept the following terms that are not in the Nice Classification, but are in everyday business practice.

A. Regionalisms.

There is terminology for goods or services that are known only in the CAN region or within some of the Member Countries and although they are not part of the alphabetical list of the Nice Classification, they are acceptable in the description of products and/or services. . For example:

Class 31: "Unprocessed avocado".

Palta is known as "avocado" in the Nice Classification.

B. Foreign words.

There is terminology for goods or services that originally come from a language other than Spanish, but due to their uses and customs in commerce, they are already known and officially accepted in the local language with an equivalent common meaning. For example:

"laptop"

"mouse"

"coaching"

C. Terms that include or specify goods or services.

The following terms will be accepted, always accompanied by a description of goods or services that does not cause confusion with other classes than those indicated in the application and it will be understood that, in addition to said generality, the sign distinguishes the particular product or service, which clarifies that the description includes the product or service:

"mostly"

"particularly"

"especially"

"such as"

"including" "namely"

When the expression "namely" is used, it will be understood that what is to be distinguished is described in a limiting manner.

Examples of accepted use of these terms are:

Class 4: Fuels, **including** gasoline.

Class 25: Clothing, **particularly** pants.

Class 35: Advertising services, **namely** , preparation of advertising campaigns through social networks.

Class 42: Architectural service, **especially** landscape architecture.

Class 41: Educational services , **such as** teaching French classes.

Class 9: Software, **including** accounting software

Class 7: Machine tools , **namely** milling machines.

1.4.5. The indication of the class to which the goods or services correspond (literal g) (article 139 DA 486).

Trademarks are governed by a principle of specialty; That is, these distinctive signs are registered in relation to certain goods or services and, therefore, the exclusivity right that the owner has is limited, as a general rule, to the goods or services for which it was registered.

DA 486 establishes that the administrative tool to classify products and/or services will be the International Classification of Goods and services for the Registration of Trademarks (Nice Classification) , established by the Nice Agreement, as established in article 151:

"Article 151. To classify the goods and services to which the trademarks are applied, the Member Countries will use the Nice Classification of Goods and services for the Registration of Trademarks, established by the Nice Agreement of June 15, 1957. , with its current modifications."

The classes of the Nice Classification referred to in the previous paragraph will not determine the similarity or dissimilarity of the goods or services expressly indicated.

The Classifier is divided into 45 classes, from number 1 to 34 are for products, from 35 to 45 are for services. To classify the product or service that you want to distinguish with a trademark it is necessary to know the following concepts:

- Products are goods or items that will be identified by the trademark such as clothing, cosmetics, computers, etc.
- Services are benefits that are performed for someone's benefit, such as a real estate rental service, advertising services, or educational services.

The Nice Classification is structured as follows:

- Each class has a title and an explanatory note that help determine if the product or service is well classified.
- Contains a non-exclusive/comprehensive list, in alphabetical order, of goods and services identified by a "base number" that helps manage said list so that both the applicant and the examiner can classify correctly.
- If the product or service is not specified or referenced in the alphabetical list, nor in the titles, nor in the explanatory notes of each class, the classifier has General Observations that serve as an interpretive guide to classify goods and services.
- It also has a user guide that includes some specific rules for effective classification using certain tools (use of brackets, parentheses and asterisks).

Although the Nice Classification is the obligatory resource for classification, the offices consult and accept other descriptions of goods and services not included in the Nice nomenclature, but which are in accordance with said classification.

In the case of Colombia, the SIC also accepts descriptions of goods

and services indicated in the Madrid Goods and services Manager ("MGS"). and in the List of Harmonized Terms and Regionalisms of Goods and services of the Pacific Alliance ("Pacific Alliance List") .

In the case of Peru, INDECOPI has a national tool called Classifier of Peruvianized Goods and services ("Peruanizado") that collects descriptions of goods and services that have previously been accepted by that office. Additionally, it also accepts the descriptions included in the Pacific Alliance List.

Given the constant evolution of new goods and services, many offices have developed their own bases of goods and services derived from the application of the Nice Classification and in some cases have cooperated with each other to accept previously harmonized terms. It is important to note that most of the classification tools used by offices are based on the general principles governed by the Nice Classification.

Here is a list of some classification tools:

Sorting Tool	Origin	Location	Binding/Context only
Nice classification	WIPO	https://www.wipo.int/classification/s/nice	For Bolivia, Colombia, Ecuador and Peru.
M.G.S.	WIPO	https://webaccess.wipo.int/mgs/?lang=es	For Colombia Only Context for Peru
List of Pacific Alliance.	Chile, Colombia, Mexico and Peru	https://www.sic.gov.co/sites/default/files/files	For Colombia and Peru

Peruvianized	Peru	https://servicio.indecopi.gob.pe/ap_pNIZAWeb/	For Peru
TMclass	European Union	https://euipo.europa.eu/ec2/	Context Only
Manual ID	USA	https://idmtmng.uspto.gov	Context only
Clasniza	Mexico	https://clasniza.impi.gob.mx/	Context only
TM5	China, Union Europe an, Korea, Japan, USA.	http://euipo.europa.eu/ec2/tm5/?lang=en	Context only

For the proper classification of trademark registration applications, the examiner must review the description of products and/or services and determine if the classification is correct. In the event that the classification is not correct, either due to ambiguous terms or because it does not adhere to the established criteria, the examiner will require the applicant with precision or clarification.

It is important that examiners keep in mind that the Nice Classification is not static and generally every five years it changes its edition and each year it changes its version, so offices are obliged to apply the updated version, given that article 151 of DA 486 establishes that it will be used with its "current modifications ."

Below, some situations are identified that may generate a requirement by the office in order to have complete clarity about the type of goods or services for which the trademark is requested.

- The offices may require the applicant when the class is incorrect, for example, due to an editing change:

Class 25: "Electrothermal clothing, shirts, socks."

The electrothermal socks in the tenth edition of Nice were in class 25 but in the eleventh edition they changed to class 11.

- The offices may require clarification or clarification when the goods or services may belong to different classes, due to their purpose or for another reason. The Nice Classification indicates with an asterisk when a product or service is

It is classified into several classes due to its purpose or other characteristics.

1.4.5.1. Single-class system.

In accordance with the provisions of article 138 of DA 486:

"Article 138. The Application for registration of a trademark will be submitted to the competent national office and must include a single class of goods or services and meet the following requirements: ..."

The above means that the applicant must indicate in their request only one class of goods or services, that is, one application per class is required, even when the trademark is the same.

Bolivia and Ecuador apply the one-class system, so that in case an applicant files an application indicating several classes, these offices must request the applicant to exclude the additional classes, and, if the applicant so desires, to file separately, with the respective payment of the respective fees, an application for each class.

Colombia and Peru, although they apply the multiclass system, also receive trademark applications by class if the applicant so wishes.

In case of application of the single-class system, the examiner must be attentive to the following situations that will imply the need to make a request to the applicant in order to clarify which class the application under examination refers to:

A. Requirements for indicating the class number.

When in the request the applicant indicates two classes including goods or services in various classes, the offices must request that

it be clarified and, in any case, eliminate one class and present it separately. Example:

Class 37: "Maintenance of real estate".

Class 42: "Interior design services".

Only one class must be defined with the corresponding service and the second class must be presented in another separate request.

B. Applications with goods or services in various classes.

When an application is submitted with goods or services that belong to various classes, for example:

Class 3: "Cosmetics, perfumes, makeup brushes . "

Makeup brushes are classified in class 21.

Class 41: "Educational services; school uniforms ; provision of educational or downloadable material."

Uniforms, being clothing items, are classified in class 25.

In these cases, the applicant must be required to remove such products from the description, because the system is single-class and goods or services that belong to different classes cannot exist in the same application. In the case of Peru, goods or services that do not correspond to the indicated class are ex officio excluded.

C. Description that is confusing or lacks specificity.

Another case of greater complexity may exist when the description of a product is confusing and from its analysis it appears that it could go to another class. As there is no certainty, the applicant is required to clarify the product or service to be distinguished.

Class 9: "Electronic files that contain music, devices that "They do music production", digital music."

The clarification has to specify what type of device it is, because, for example, a guitar produces music and is in another class (class 15), or if it is a "player" of music that is in class 9.

In some cases, for clarity, offices will propose suggestions on how to better word the goods or services. Depending on the applicant's response, it will be determined whether to exclude or specify, with

the intention of remaining in a single class.

1.4.5.2. Multiclass system.

Currently, the multiclass system is only applied in Colombia and Peru, in accordance with the Trademark Law Treaty (TLT), to which they are a Party.

This system allows a trademark to be requested to distinguish products and/or services independently that may belong to various classes of the Nice Classification.

The great advantage of the application of the multiclass system consists of the practicality and efficiency of the administrative process in granting records, and that the offices can issue a single administrative act, just as the applicant will be able to monitor a single file, and will have the possibility of carry out a single procedure for the renewal of the trademark.

The offices, considering that the sign is registrable in the requested classes, will issue only a registration certificate. In the event that there is an impediment to registration with respect to certain goods or services, the applicant will have the option of dividing the application and will be able to avoid delays in the registration of the trademark for those goods or services in which there is no impediment. (See the following section A. Division of a multiclass application.)

On the other hand, if a request for multi-class trademark registration is issued regarding some of the products and/or services that the trademark is intended to identify and the applicant does not comply with the request or does so unsatisfactorily, the application will be deemed abandoned only regarding the class about which the office made the request. In the case of Peru, when the requirement regarding some products and/or services is not met, the office will proceed - ex officio - to exclude them or adapt them, as appropriate.

In the Colombian case, if a commercial slogan is requested before the SIC through the multiclass system, the classes and goods or services included in the application must coincide with those of the associated trademark, although the commercial slogan may contain

fewer classes of goods or services or fewer of these within a particular class, you cannot add classes, goods or services that are not identified by the associated trademark.

Finally, To facilitate the study of the application, the products and/or services must be indicated in progressive order of the classes of the Nice Classification.

In the case of Peru, when the examiner observes that some goods or services are not in the correct class but the correct class was claimed for other goods or services, without a requirement, he may transfer the goods or services to the correct class,

For example:

Original classification:

Class 29: "Meats, dairy products, cakes", Class 30: "Coffee, tea".

Corrected ex officio classification:

Class 29: "Meats, dairy products", Class 30: "Coffee, tea, cakes."

This migration of products and/or services from the incorrect class to the correct one can occur in the formal exam, or even after publication, in the substantive exam.

A. Division of a multiclass request.

For Colombia and Peru, when applying for a trademark in the multiclass system, the applicant will have the option of dividing the application only in the case of products and/or services.

In accordance with the TLT, when the application is divided, the submission date must be respected, that is, the new files derived from the initial application will retain their priority before third parties, for which one of the conditions is that the products and/or Services that become independent should only be those that were initially requested.

One of the most common reasons for requesting division is because the office found an impediment to registration only for some products and/or services or there is an opposition and the applicant wants to question the decision or contradict what was alleged by the opponent and avoid hindering the registration for other products and/or services.

The applicant may divide the application at any time during the procedure until before the final resolution. The main requirements for offices to accept the division are:

- Petition
- Make the payment of the corresponding fee, according to the classes that are going to be divided.
- Specifically indicate the classes and products and/or services that will be the subject of the divisional request.

Once the divisional application is accepted, the office must assign a new file number to each application. Each of the independent files will have a copy of the initial request.

The office may issue a requirement to the divisional applicant when the products and/or services in the divisional application match those still in the initial application or in other divisional applications.

In addition to the particular requirements of the division, applicants must meet the requirements as if it were a separate application.

If the applicant does not respond to the office's request regarding any irregularity in this process, the divisional application will be considered not submitted and the products and/or services will remain in the initial application.

1.4.5.3. General classification criteria.

The Nice Classification is extensive and detailed regarding the listings of goods and services; However, the dynamism in trade is unstoppable and new goods and services are constantly offered on the market, so it is likely that many terms are not found in the Nice Classification. As it is not always easy to determine which classes they should be placed in due to their novelty, there are criteria established in the Nice Classification that are used to classify services and products that have not yet been included in the lists.

The criteria set out below are of a general nature because each particular matter must have a detailed study in order to make the

appropriate classification, but they can help the examiner shed light on where they can be properly classified.

A. The generality of class titles.

The Nice Classification contains class titles intended to give guidance for classification according to the nature of the goods or services.

Class titles are made up of "general statements," each of which describes the types of goods and services contained in the class. Precisely because many goods or services are general indications, although they are in that class, they are not necessarily contained in the title of the class. The above is of vital importance because the fact that the trademark registration contains the title of the class, when using the title to describe goods or services, does not necessarily cover all the goods or services that can be classified in that class.

For example, the applicant presents a trademark indicating in the description of products the title of class 12 " Vehicles; devices for land, air or water locomotion" and the applicant's intention is to cover " tires for land vehicles" . In this case, since these products are not contained in the title of class 12, they are not protected.

On the other hand, it is important to mention that the mere fact that goods or services may be included in the same class of the Nice Classification does not necessarily make them similar. Likewise, goods or services will not be considered different just because they belong to different classes.

B. General Observations of the Nice Classification.

The General Observations are criteria that also allow trademark examiners to make a correct application of the Nice Classification in the event that the goods or services indicated by the applicants are not found in the alphabetical list, or cannot be separated of the title of the class or the explanatory notes thereof.

- The classification of products by function or purpose

A finished product is classified, in principle, by its function or

purpose. If a description of a product cannot be found in the alphabetical list of the Nice Classification or in the lists that offices use as alternative tools (MGS, PeruAnizado, etc.), it is important to analyze what its function or purpose is and determine the correct class. For example:

"oven grills"

The Nice Classification does not have an entry for this product. Class 11 includes in its alphabetical list "grills [cooking appliances]" and class 21 includes "grills [cooking utensils]". For classification purposes, specific attention must be paid to the function or purpose of the product.

Considering that a grill is an iron utensil in the shape of a grid to put on the fire what is to be roasted or toasted, its function is to be an appliance that is part of a cooking installation, resulting in it being classified in class 11.

Analogy is used to classify when the function or purpose is not mentioned in the class titles or in their explanatory note. For example:

The following description of products is presented in class 9:
"Non-fungible tokens (NFT) in the form of sportswear."

In the Nice Classification the following entries are found in class 9: "downloadable image files", "downloadable music files", the description of NFTs must be classified by analogy in class 9 because they are electronic files as products.

- The classification of finished products with multiple uses

A finished product with multiple uses can be classified in all classes corresponding to each of its functions or uses. It will depend on how the description is written to define in which particular class it is classified. The practice is to base the classification on the first function or destination or product specified in the description. Example:

Clock radio including mobile phone charger and clock. Class 9	Clock including clock radio and cell phone charger. Class 14
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- The classification of products as raw or raw materials

Raw or semi-finished materials are classified mainly by the material of which they are made, that is, products that are identified as raw materials must not have gone through a modification process, if only harvesting or collection. Example:

Semi-manufactured glass Class 21	Optical glass Class 9
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Glass without graduation is considered a semi-finished product. Once it has graduation, or some anti-reflective liquid, it becomes a class 9 finished product.

The above confirms that the correct use of good wording of products helps with proper classification.

- The classification of products intended to be part of another product

When a product is made to be contained as part of another, it will not, in principle, be classified in the same class as the latter; It will only be in cases where products of this type cannot normally have other applications. Example:

Tractor Class 12	Plows Class 7	tractor chassis Class 12
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The tractor chassis is a product that is made and adapted especially to work on a tractor and not on another object, which is why it is classified in class 12, unlike the plow, tool which, although it can be used with a tractor, can also be used by other types of vehicles and is classified in class 7, different from the class where the tractor is located.

- The classification of products by predominant material

If a product, finished or not, must be classified according to the material and is made up of different materials, it is classified according to the predominant one.

Burgers without bread Class 29	Burgers with bread Class 30
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In this example, it is understood that hamburgers, because they are meat, are classified in class 29; However, when it refers to the hamburger dish, that is, to the preparation that contains ground meat, bread and, perhaps, other foods, it will be classified in class 30.

Here is a more complex example: "flexible steel tube with plastic cover."

In class 6 there are "steel pipes", but class 17 includes "non-metallic flexible pipes". As this product can have various purposes, it cannot be classified according to its function. If it is a finished product that is not part of another, it must be classified by its predominant material, which is identified by the form of the description. But as you can see, the material is in exactly the same quantity.

In this case the classification will be determined by the preponderance of the material of the product, in this case being class 6, given that the tube is metallic and only has a plastic cover.

This example works when viewing the product, but since trademark applications mostly contain descriptions and not images, the examiner will need to be guided by what material is predominant in the description.

- The classification of cases as a product

The cases are classified in the same class as the products they will contain.

Example:

pencil case Class 16	Pedicure case Class 8	Charger case Class 9
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There are bags, briefcases, toiletry bags and similar products that can contain various products, making it confusing to classify them because the purpose of these products is to contain "something." However, the difference lies in the special adaptations they may have so that one or more products of the same type are the only ones for those bags, briefcases, toiletry bags and other products that serve to contain something.

In the illustrated examples it can be seen that the pencil case can be a simple class 18 briefcase, however, it has certain elastics adapted exclusively for pencils that ensure that they do not move, in which case they will belong to class 16. The same happens with the other two examples, that is, they are specially adapted for certain products, hence their classification is the same as the product they contain.

- The classification of services according to the branches of activity

The description of the services must follow certain more specific rules to determine a correct classification. One of these rules, established by the General Observations of the Nice Classification, is determined by the branch of activity indicated in the titles of the classes or the explanatory notes.

For example, the title of class 37 states: "construction services; installation and repair services; mining extraction, gas and oil drilling"

If an application describes the services as "Mining equipment cleaning services", they would clearly be classified in class 37 because they are part of the mining extraction branch.

This criterion does not apply to certain descriptions of services since some are classified by their nature, for example, in class 36 in the "financial services" industry, in the alphabetical list are "customs agency financial services." ; However, "import-export

agency services," although they may be similar to customs services, are classified in class 35 because they are administrative services.

- The classification of rental services

In application of this criterion, rental services will be classified in the same classes as the services provided with the help of rented objects. Examples:

car rental Class 39	Tool rental Class 37	Rental of plates, tablecloths, chairs Class 43
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However, there are descriptions of services that must have further analysis for classification, for example, "surveillance camera rental" ; In principle we can think that since these are devices used to provide telecommunications services, the service should be classified in class 38, but since the service is surveillance, then it should be classified in class 45.

- The classification of advisory or consultancy services

In this criterion, the classification logic applies in the same class as the services on which the advice, information or consultation relates. Examples:

Technological information services Class 42	Consulting services on face beautifying treatments Class 44	Banquet consulting services Class 43	Training consulting services bodybuilding Class 41
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The examiner must study in great detail the descriptions that may have a double interpretation about what the information, consulting or advice is about, for example: "advisory services on the use of an electronic platform for the implementation of a personnel recruitment system."

In this case it can be thought that since the purpose is to recruit personnel it can be classified in class 35; However, the advice is about a technical/technological service so it must be classified in class 42.

In these cases, if the advice is also for personnel recruitment procedures, it must be described differently so that it can be classified in class 35, for example, "advisory services on personnel recruitment procedures through an electronic platform."

- The classification of franchise services

The figure of the franchise contemplates diverse services that can be classified in different classes, and the logic to classify them will be on the services provided by the franchisor. Example:

Preparation of franchise agreement Class 45	Commercial information about franchised establishments Class 35	Preparation of financial models for a franchise Class 36
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C. Explanatory notes to the Nice Classification.

The explanatory notes corresponding to a class describe in greater detail the types of goods or services included in said class, that is, they are intended to provide guidance on which goods or services can be classified based on the title of the class and which goods or services cannot be classified. belong to him. Example:

Class title 32

"Beers; drinks without alcohol; mineral and carbonated waters; fruit drinks and fruit juices; syrups and other preparations to make non-alcoholic beverages."

The explanatory note of class 32 indicates:

"Class 32 mainly includes non-alcoholic beverages, as well as beers.

This class includes in particular:

- alcohol-free drinks;
- non-alcoholic soft drinks;
- beverages based on rice and soy, which are not milk substitutes;
- energy drinks, isotonic drinks, protein-enriched drinks for athletes;
- non-alcoholic fruit essences and extracts to make drinks

This class does not include in particular:

- flavorings for beverages as essential oils (cl. 3) or that are not essential oils (cl. 30);
- diet drinks for medical use (cl. 5);
- dairy drinks in which milk predominates, milk shakes (cl. 29);
- milk substitutes, for example: almond milk, coconut milk, peanut milk, rice milk, soy milk (cl. 29);
- lemon juice for culinary use, tomato juice for culinary use (cl. 29);
- drinks based on coffee, cocoa, chocolate or tea (cl. 30);
- beverages for pets (cl. 31);
- alcoholic beverages, except beers (cl. 33)."

As can be seen, the title of class 32 includes "non-alcoholic beverages", however, not all non-alcoholic beverages are in that class and the explanatory notes must be followed to analyze what type of beverages are within that class. and which ones are excluded.

For example: "coffee-based drinks " , the explanatory note for class 32 It clearly says that said class does not include beverages based on coffee, cocoa, chocolate or tea, which are included in class 30.

1.5. Additional requirements that the registration application must meet.

In addition to the exhaustive analysis of the trademark registration application form, which, as noted, must comply with the requirements indicated in article 139 of DA 486, the examiner must verify that said request is accompanied by the information and the documents that have been established in article 138 of DA 486, as formal requirements.

1.5.1. The reproduction of the trademark, when it is a word trademark with graphics, shape or color, or a figurative, combined or three-dimensional trademark with or without color; (literal b) of article 138 DA 486) .

As mentioned in section 1.4.3. of chapter 2 of this Manual, one of the formal requirements of the trademark registration application is that the type of trademark whose registration is requested is indicated. If it is a word mark without graphics, shape or color, a

reproduction of the sign will not be necessary. If it is any other type of trademark, it will be essential that a reproduction of the trademark be provided, in such a way that it allows complete clarity to the examiner about the scope of the application.

The work of the examiner in the face of these requirements is of utmost importance, since he must contrast the indication of the type of trademark that is the subject of the application with the reproduction provided, in order to establish if there is coherence in the application and the scope is clearly understood. of that, or if, on the contrary, inconsistencies are perceived in this point and then, it will be appropriate to issue the request for the applicant to clarify his request.

The following are some examples of inconsistencies that may be noted in this analysis:

- The form indicated that a "nominative" trademark is requested and a reproduction consisting of a set that has figurative and denominative elements was attached.
- The form indicated that a "figurative" trademark is requested and a reproduction was provided where the graphic element is accompanied by word elements or no reproduction was provided.
- The form indicated that a "combined" trademark is requested, or a "three-dimensional" trademark, but no reproduction of the trademark was provided.
- The applicant indicated that it is requesting the registration of a non-traditional trademark (for example, a sound mark or a position mark) but sufficient elements were not provided to prove that the requirement of graphic representation is met.

In the event of any inconsistency noted by the examiner when carrying out this analysis, the respective request will be issued for the applicant to clarify the scope of their request.

1.5.2. The necessary powers (literal c) of article 138 DA 486).

DA 486 provides that when a legal representative is appointed, the respective power of attorney or documents that prove the representation must be presented.

Without prejudice to the above, it should be noted that DA 486 does

not establish the obligation to act through a representative or lawyer before the national offices, for the purposes of submitting applications for registration of industrial property rights. Now, in the event that the applicant, a natural person or legal entity, decides to act through an agent, the power conferred must be attached to the application with compliance with the formalities that apply to this power document, in accordance with the provisions by national standards.

If the applicant is a legal entity and decides to act directly, i.e. through its representative and not through an agent, the identification and contact information of the applicant legal entity and its place of incorporation must be included in the application form, as indicated in section 1.4.2. of chapter 2 of this Manual.

In the latter case, the examiner must verify that the person submitting the application on behalf of the legal entity is the one who holds its legal representation.

1.5.2.1. Formalities of power in Bolivia.

According to the provisions of article 42 of the SENAPI Internal Procedure Regulations for Industrial Property, any natural or legal person acting through a representative or agent must present a mandate or power contract in accordance with civil, notarial and legal legislation. Regulation.

The examiner in charge of the formal examination must verify that the Power of Attorney Testimony has been granted by a Public Notary, and that it has been presented in original or legalized copy. Additionally, the power must confer an express mandate for the procedure or action.

If it is a power granted abroad, it must be verified that it has been legalized and approved by the corresponding Directorate of the Ministry of Foreign Affairs, so that it is suitable and has full legal validity.

In accordance with the provisions of article 43 of the aforementioned Regulation, at the time of submitting the first application for registration of a distinctive sign, the applicant may expressly request the deposit of the original Testimony or,

where appropriate, the legalized copy, so that it can be entered into the SENAPI database. It is important to note that SENAPI does not deposit power ex officio.

The applicant who makes use of the deposit of a Power of Attorney, in subsequent registration requests, must attach a simple copy of the same. The examiner must verify that the applicant has indicated:

- Number of the power of attorney deposited.
- Code of the procedure where the deposited testimony is located.

1.5.2.2. Formalities of power in Colombia.

In accordance with the provisions of section 1.2.1.3 of Chapter One of Title or legalization. Additionally, powers may be granted for one or more existing or future proceedings. At this point, the examiner must verify that the representative is a qualified lawyer duly registered in Colombia.

However, the power to withdraw the request or renounce a right must be expressly enshrined in the power of attorney. For this purpose, the document by which the right is waived or the application is withdrawn must contain the diligence of personal presentation before the SIC or before a Notary public.

On the other hand, if the applicant is a natural or legal person not domiciled in Colombia, the application must be presented through a representative duly registered in Colombia. Therefore, in this case the examiner must check that the corresponding power is provided. . In relation to the formalities, if it is a resignation or withdrawal document created abroad, the examiner will proceed to verify that it has been legalized by apostille or before the Colombian Consul or that of a friendly Nation, as the case may be.

1.5.2.3. Formalities of power in Ecuador.

Article 98 of COESCCI establishes that applicants who are not domiciled in Ecuador must be represented by an attorney-in-fact.

In the case of national applicants, whether a natural person or legal entity, it will be optional to submit the trademark registration application through a representative. If this is the case, the examiner must verify that the original document of the power of attorney elevated to a public deed has been presented to

SENADI to register it in the book of powers or, failing that, together with the application for registration of the sign in process, at the request of the petitioner

In the case of foreign applicants, be they a natural or legal person, the examiner will check that the power of attorney document has been presented, duly legalized or apostilled, as the case may be.

1.5.2.4. Formalities of power in Peru.

In accordance with the provisions of article 15 of Legislative Decree No. 1075, the powers granted by trademark registration applicants to act before INDECOPI may be recorded in a private instrument that does not require legalization. In the case of national legal entities, it is enough to indicate the registration number in which the representation is recorded. . In the case of foreign legal entities, a power of attorney is required in a private instrument, indicating only the quality with which the principal acts.

In the case of renunciation of a registration, the signature of the principal must be legalized by a notary. Additionally, if the power of attorney has been granted abroad, the examiner must verify that it has been legalized by a Peruvian consular official, or that it has been apostilled in accordance with the Hague Convention.

The power of attorney may be granted and exhibited subsequent to the filing of the application, it is only required that the previous acts be expressly ratified.

1.5.3. Proof of payment of the established fees (literal d) of article 138 DA 486) .

The payment of fees corresponding to any of the concepts that correspond to industrial property matters will be determined by each of the states of the Member Country in its internal national regulations or legislation. .

In compliance with the provisions of literal d) of article 138 of DA 486, in the case of a trademark application, and particularly, in systems in which the application and annexes must be submitted in physical form, or in the event that the office does not have an

electronic payment system for the fees, the applicant must attach proof of payment proving that it has covered the amount provided for in the national legislation of each office, or also, in the case of Peru , it is possible to indicate the operation number and the payment day. In the case of electronic application submission systems that incorporate a payment platform, it will not be necessary for the applicant to attach a separate document proving payment, since payment and its verification are part of the electronic procedure and, in practice, Until the payment is verified, the system will not be able to assign the date and submission number to the application.

It is important to remember that, in accordance with article 140 of DA 486, proof of payment of fees is one of the minimum requirements that must be verified by the offices, in order to be able to assign a presentation date to application.

If payment of the fee is not proven, the office will require the applicant to correct said requirement.

Particularly for offices that apply multi-class systems for trademark registration, examiners must verify that a fee has been paid for each class included in the application. Offices that have this system may offer a discount on the applicable application fee from the second class onwards.

Another aspect that has implications for the value of the application fee is the discounts that offices can establish in favor of certain categories of applicants, for example, for the benefit of micro, small and medium-sized enterprises, young entrepreneurs, artisans, among others . When an application is submitted, in which the applicant intends to benefit from a discount offered by the office, it must be verified that the applicant has provided the documents that prove that he is eligible to enjoy the benefit and that he has paid the correct amount for the rate.

1.5.4. The authorizations required to avoid incurring any cause of unregistrability (literal e) of article 138 DA 486) .

The applicant must display the corresponding authorization in the event that they apply for a trademark and need permission from the owner of certain rights.

1.5.5. Documentation required in case the recognition of a priority right is requested (literal f) of article 138 DA 486) .

When an applicant has filed an application for trademark registration in a country that is a contracting party to the Paris Convention, he or she may request that the same filing date be recognized and applied in an application subsequently filed at any trademark office anywhere. contracting country of said international treaty, this privilege is known as the right of priority.

The countries that make up the CAN are part of the Paris Convention, therefore, they are obliged to recognize the right asserted by any applicant, provided they comply with the following:

- The new application must be submitted within a period of no more than six months from the date of submission of the first application.
- The trademark must be the same.
- The products and/or services must be the same.
- The owner must be the same.
- Pay the fee that each National Office requires in accordance with its national legislation .

In accordance with the provisions of articles 9 and 10 of DA 486, if the applicant wishes to assert the right of priority, in relation to an application previously submitted in another CAN Member Country, or before another national, regional or international with which the country is bound by a treaty that establishes a right of priority analogous to that of DA 486, must submit a declaration invoking priority indicating the date of submission, the national office before which it submitted that application and , the file number.

The examiner must verify that the declaration exists and that it is accompanied by the documents required by DA 486, namely:

- A copy of the application whose priority is invoked, certified by the national office to which it was submitted.
- A certificate of the date of submission of the application, issued by the corresponding national office.
- Proof of payment of the fee for invoking priority, if the office has established it.

As permitted by DA 486, priority can be invoked and accredited with the aforementioned documentation, either together with the application for registration of the trademark or after it, but in any case within a maximum period of nine months counted from the date of submission of the application whose priority is invoked.

Priority may apply to all or some of the goods or services contained in the previous application or priority application.

1.5.6. Other mandatory documents.

In addition to the requirements established in articles 138 and 139 of DA 486, the applicant must provide, in the case of applications for registration of collective and certification marks, the documents that prove the nature and purpose of said marks.

1.5.6.1. Documentation to request a collective trademark.

A. Document to prove the legal interest to apply for a collective trademark.

This document consists of the formalization of the community, through the corresponding statutes of the organization.

When conducting the formal examination, the offices will review the application and ensure that this document accompanies the application for a collective trademark.

If it has not been provided with the application, a request will be sent to the applicant.

B. List of members.

This document consists of the identification of each of the natural and/or legal persons that make up the organization that will be the owner of the collective trademark.

When conducting the formal examination, the offices will review the application and ensure that this document accompanies the application for a collective trademark.

In the event that it is not provided with the application, a request will be sent to the applicant.

C. Rules on use.

This document consists of the set of provisions (internal rules) that aim to unify or standardize the use of the trademark, by the associates or members, in relation to the goods or services in question, based on the elements of quality, homogeneity, stability

or any other particular characteristics that the trademark is intended to encompass or announce to the consumer or client, being as such a control mechanism.

When conducting the formal examination, the offices will review the application and ensure that this document accompanies the application for a collective trademark.

In the event that it is not provided, a request will be sent to the applicant.

1.5.6.2. Documentation to request a certification mark.

Given the nature of a certification mark, it is necessary that the rules on what and how a product or service is to be certified be established and made known. For this you need a document that DA 486 calls the Regulations of Use.

When conducting the formal examination, the offices will review the application and ensure that this document accompanies the application for a certification mark.

In the event that it is not provided, a request will be sent to the applicant.

Likewise, any modification must be submitted for registration at the national offices.

1.6. Modifications to the application.

In accordance with the provisions of article 143 of DA 486, the trademark registration application may be modified at any time during the registration procedure as long as it does not involve changing substantive aspects of the sign or expanding the indicated goods or services. initially in the application.

The applicant may also request that a material error be corrected. Substantial material errors include, but are not limited to, incorrect information in the applicant's address.

2. PUBLICATION OF THE APPLICATION.

Article 145 of DA 486 establishes that if the registration application meets the formal requirements, the competent national office will order publication.

Hence the importance of the formal examination stage, in which the examiner must have thoroughly reviewed the application and its attached documentation, to verify whether the formal requirements are complete or, if not, issue the requirements that allow the applicant to correct errors, gaps or contradictions, thus avoid the declaration of abandonment and continue with the registration procedure.

Once the office is certain that all the formal requirements established in DA 486 are met, it must order the publication of the application through the means that, where appropriate, its national legislation has established.

This phase seeks to publicize to third parties the applicant's intention to obtain registration of a specific trademark, thus, third parties will be able to learn about that application and, if they consider that they have a legitimate interest, file an opposition with the purpose of preventing the sign is registered as a trademark.

3. OPPOSITION.

Any natural or legal person who has a legitimate interest may formulate a reasoned opposition on a single occasion, with the purpose of preventing a sign from being registered as a trademark. The possibility of presenting oppositions helps the authority in defending the rights of individuals, preventing a third party from violating them.

With the presentation of the oppositions and the responses to them presented by the applicants, there is more information aimed at strengthening the examiner's arguments to grant or deny a trademark registration.

The legal basis of the opposition lies in article 146 of DA 486, which establishes:

"Article 146.- Within a period of 30 days following the date of publication, any person having a legitimate interest may file one reasoned opposition with a view to discrediting the registration of the mark.

At the request of a party, the competent national office shall grant one further period of 30 days for the submission of evidence in support of the opposition. Reckless oppositions may be penalized if national legislation so provides.

Oppositions to an application that are filed within the six months following the expiry of the period of grace referred to in Article 153 shall not be entertained where they are based on marks that have coexisted with the registration applied for."

As noted in this article, there are two essential elements that those interested in opposing must consider: having a legitimate interest and that their reasons are duly substantiated, this to avoid oppositions without arguments that delay the registrability examination.

The requirements that the opponent must meet when submitting an opposition are the following:

- Identification of the file of the application you are opposing.
- Identification and contact data of the opponent, particularly their name and address.
- Cover the payment of the corresponding fee according to each national office.
- Document that certifies the powers of representation, if presented by an attorney-in-fact. . In this case, the mandate must have the power to oppose third-party registrations.
- The document that establishes the grounds on which the opposition is based.
- The evidence that supports the opponent's arguments, if applicable.
- In the case of an Andean opposition, a copy of the registration certificate of the current registered trademark or of the registration application pending in the Member Country on which you base your legitimate interest , as well as proving the real interest, through proof of the application for registration or

a registered trademark, in the country where the opposition was filed. .

- Any other requirement indicated by internal regulations.

General considerations to take into account when presenting, answering or evaluating an opposition:

- The opposition is not an independent procedure, it is part of the trademark registration procedure; However, in the case of Colombia and Peru, when an opposition is made with respect to a multiclass application, the applicant may divide the application, separating into independent procedures, the applications corresponding to those classes in which no opposition has been formulated, to thus continue with the registrability exam for those classes.
- In the case of Colombia and Peru, which have a multiclass system, the opponent must indicate the class or classes to which he or she opposes and pay the corresponding fee for each of them.
- The applicant, if he considers it pertinent, may present as a means of defense a cancellation due to lack of use of the trademark registration on which the opponent bases his opposition. .
- For Peru, the arguments on which an opposition is based cannot be used - later - in an action for annulment of the registration, so it is important that the grounds of the opposition be clearly defined, since if the final resolution of the procedure of the trademark registration is not favorable to the opponent, he will not be able to initiate an annulment action with the same grounds.
- DA 486 does not contemplate an agreement or settlement stage between the opponent and the applicant within the registration procedure. However, in Colombia a procedure called facilitation hearing is contemplated. and in Peru,

At any stage of the procedure, the parties may be summoned to a conciliation hearing. .

3.1. Opposition deadlines.

The deadlines for the opposition are the following:

3.1.1. Opponent.

Once the application is published in the official bulletin of each Member Country, the opponent will have thirty business days to formally present the opposition, counting from the day following

publication.

If this is the case, if the opponent did not present the necessary evidence to prove his arguments, at his request, the national office will grant, on a one-time basis, a period of thirty business days to present the documentation that it considers relevant. . It is important to mention that this deadline does not mean that the term to present the opposition or expand the arguments is extended, it is only for the presentation of evidence.

3.1.2. Applicant.

Once the office informs the applicant that an opposition has been filed against the registration of the requested sign, the applicant will have a period of thirty business days counted from the day following the notification made by the office, so that he can respond to the arguments of the opponent and present the necessary evidence, if applicable.

If the applicant did not present the necessary evidence to prove his arguments, at his request, the office will grant, on a one-time basis, an additional period of thirty business days to present the documentation that it considers relevant to prove what was said. .

If the applicant did not submit a response to the opposition within the thirty-day period, the registration process will continue and the office will carry out the registrability examination in accordance with its usual procedure, considering the arguments of the opponent and those that correspond ex officio.

3.2. Legitimate interest of the opponent.

Although any natural or legal person can file an opposition, it must meet the essential requirement of having a legitimate interest.

To prove the legitimate interest, the opponent must substantiate the damage that would eventually be caused to his right by granting the registration to which he opposes, providing all the evidence he considers relevant to prove it, since the offices must evaluate or qualify, in the exam. background, if in fact the opponent has proven to have a legitimate interest .

Whoever has a subjective right, that is, a prior trademark

registration or application, has a legitimate interest. For example, a company opposes a registration of the TOBATOBA mark to distinguish financial services because it is the owner of a registration of the TOBA mark to distinguish credit granting services and considers that there is a risk of confusion or association. In this hypothetical case, the opponent has a legitimate interest because if the request is granted, it would have obvious harm because consumers could be confused. In this case, the way to prove legitimate interest would be through the registration number or certificate.

Whoever has a legitimate interest does not necessarily have a subjective right. Thus, for example, an association of businessmen dedicated to the dairy industry opposes the application for registration of the trademark PASTEURIZADA TWICE to distinguish milk, because if exclusivity is granted, the applicant will be able to prevent other competitors from using it in the market. a sign that is clearly descriptive and that everyone who is dedicated to that industry should use as an informative element of their products.

3.3. Opposition assumptions.

DA 486 does not specifically establish what the opposition cases are; However, the TJCA, as a general rule, considers as opposition cases those included in the causes of unregistrability contemplated in articles 135, 136 and 137 of the DA 486 , that is, when the intention is to register a trademark that should not be granted because it is an absolute prohibition, or because its registration would violate prior rights of third parties. , as well as when there are reasonable indications that allow the national office to infer that a registration had been requested to perpetrate, facilitate or consolidate an act of unfair competition.

On the other hand, an opposition may also be founded in the case contemplated in article 15 of Decision 876 Common Regime on Country Trademarks of the Commission.

of the Andean Community ("DA 876") , according to which a sign that is identical or similar to a country trademark protected in accordance with this Andean regulation cannot be registered as a trademark. .

In this understanding, there may be various assumptions, including the following:

- The quintessential case is the opposition to a trademark that may cause a risk of confusion or a risk of association with another registered trademark or a previous trademark application. (Cause for unregistrability established in literal a) of article 136).
- A mark that includes the name of an indigenous, African American or local community without its consent. (Cause for unregistrability established in literal g) of article 135).
- A trademark that imitates or contains a protected designation of origin. (Cause for unregistrability indicated in literal j) of article 135).

There is the possibility that an opposition invokes various assumptions as a basis, be they absolute and/or relative prohibitions, the assumption of article 137 of DA 486 or that contemplated in article 15 of DA 876. For example, a floriculture company objects to a trademark composed of two words because one of those words is the reproduction of a plant variety (ground for unregistrability indicated in literal o) of article 135) and also because the other element that makes up the trademark can cause a risk of confusion or association with a trademark of which the opponent is the owner (ground for unregistrability indicated in literal a) of article 136).

There will also be cases in which an application is subject to several oppositions presented by different people, either for the same or different arguments. For example, in Colombia the BIMBO trademark was requested to identify clothing and three oppositions were presented. The owner of the class 25 BOMBI trademark and the owner of the class 25 BIMBI trademark invoked as grounds that the trademark proposed for registration caused a risk of confusion with their respective trademarks. Additionally, the owner of the BIMBO trademark based its opposition by requesting that the notability of its trademark be recognized. In this case, the national office resolved that in relation to the first two there was a likelihood of confusion and it also recognized the notoriety of the BIMBO mark and therefore refused the mark.

In conclusion, the assumptions of opposition are based on the

legitimate interest that the opponents can prove.

3.4. Reasons for inadmissibility.

The reasons for inadmissibility of an opposition are the following :

- Failure to indicate essential and sufficient data to identify the opponent and/or the registration application to which they oppose.

In this case, the essential data are the name of the objector and their address, and in the case of the application, the trademark data, the file number.

- That it is submitted after the deadline.

The opponent must not exceed the period of thirty business days following the publication of the application to present the opposition.

- Due to non-payment

The opponent must cover the payment of the fee determined by the national office .

- That the opponent has not complied with specifying the arguments of the opposition, despite the expiration of the legal period granted to make this indication. .
- The lack of presentation of power, in the case of Bolivia, Colombia and Peru .
- In the case of Bolivia, the opposition must be based on agreements or treaties that are not in force in the Plurinational State of Bolivia at the date of filing the opposition.

3.5. Office decision on opposition arguments.

The office will proceed to carry out the registrability examination of the trademark that is the subject of the application and will rule on the arguments put forward by the opponent and, if applicable, those of the applicant and will decide on the viability of the registration. .

When there are several oppositions regarding a trademark, they will all be resolved in a single resolution.

3.6. Reckless oppositions.

In order to stop oppositions that have no greater purpose than to hinder the trademark registration procedure in bad faith and create harm to the applicant for a trademark without having arguments based on law or facts, DA 486 allows the offices National authorities sanction opponents who present reckless opposition.

The TJCA has mentioned some acts that can be considered to determine that there is reckless opposition:

"In an enunciative way, there will be reckless opposition:

- a) When it is manifestly evident that the opposition lacks legal basis;
- b) When the opposition is raised knowing that it lacks legal basis, that is, it is formulated with bad faith or intention;
- c) When the opposition arises in the abusive exercise of a right; either,
- d) When the opposition is raised for an illegal or fraudulent purpose."

An example that could be considered a reckless opposition is when the opposition is based on a trademark registration that was canceled before filing the opposition, since knowing that the registration is no longer effective, the office has indications that said opposition is formulated to cause an unnecessary obstacle to the applicant for trademark registration.

Peru is the only Member Country that has regulated a sanction in this regard, as can be seen in article 23 of Legislative Decree No. 1075, which literally establishes:

"Article 23.- Reckless oppositions (Legislative Decree No. 1075)
Reckless oppositions formulated against applications for any element of industrial property may be sanctioned with a fine of up to fifty (50) UIT."

3.7. Andean opposition.

The Andean opposition allows holders of registered trademarks, or previous applications processed by a Member Country, to have the possibility of preventing the registration of a trademark applied

for in one of the other Member Countries.

This legal figure is very particular because it qualifies the principle of territoriality, that is, a trademark right has effects outside its own territory, so we have that, for example, the owner of a trademark registration in Ecuador may exercise that exclusivity, through an opposition to the registration of a trademark identical or similar to yours in Bolivia, if you consider that it violates your prior right.

The legal basis that allows this opposition is found in article 147 of DA 486:

"Article 147.- For the purposes of the provisions of the previous article, it will be understood that both the owner of an identical or similar trademark for goods or services, with respect to which the use of the trademark may mislead the public, as the person who first requested registration of that trademark in any of the Member Countries. In both cases, the opponent must prove his or her real interest in the market of the Member Country where the opposition is filed, and must, for this purpose, request registration of the trademark at the time of filing it.

The filing of an opposition based on a trademark previously registered in any of the Member Countries in accordance with the provisions of this article will entitle the competent National Office to deny registration of the second trademark.

The filing of an opposition based on an application for trademark registration previously submitted in any of the Member Countries in accordance with the provisions of this article, will result in the suspension of the registration of the second trademark, until the registration of the first is granted. . In such event, the provisions of the preceding paragraph will apply."

As you can see, if a trademark owner from a Member Country wants to oppose the registration of another trademark in one of the other Member Countries, he or she must comply, in addition to what is established in Article 146, with two essential requirements:

3.7.1. Previously have an acquired trademark right or an expectation of right.

The opponent must prove that he is the owner or applicant for an identical or similar trademark for goods or services with respect to which its use could mislead the public.

If at the time of filing the opposition, the opponent does not present the registration certificate or the prior registration application, the national offices may require him or her.

3.7.2. Have a real interest in the market of the Member Country where you intend to oppose.

The opponent must prove that he has a real interest in the market of the Member Country where the opposition is presented. In accordance with article 147 of DA 486, the way to do this is by requesting a registration of the opposing trademark at the same time of filing the opposition. .

However, the sign requested does not necessarily have to be identical to the one that the opponent has registered as a trademark or in the process of registration in another Member Country, but it must

contain the essential and distinctive characteristics of that ; On the other hand, the real interest will only be accredited with respect to the goods or services that the trademark that the opponent requests (or has previously registered) seeks to identify, which are identical to those indicated by the trademark that is registered or that is in process. registration in the other Member Country.

3.7.3. General considerations to take into account when presenting an Andean opposition.

- Even if the opponent's trademark is registered in a Member Country, it does not mean that it can be registered in the Member Country where an opposition has been filed. The national office is obliged to carry out the corresponding registrability examination.

- Likewise, the trademark application submitted by the opponent to prove real interest in the market will suffer the same fate as any other application submitted in that Member Country, that is, the registrability test will be applied and when carry out the trademark comparison may be denied for a trademark different from the one they

opposed, either because it incurs some other prohibition or assumptions provided for in articles 135, 136 and 137 of DA 486 or because it corresponds to the provisions of article 15 of DA 876.

- If the basis of the Andean opposition is a prior trademark application, the registration process of the trademark for which an opposition has been filed will be suspended until the national office of the Member Country does not definitively resolve the granting or denial of said prior application. .

In the event that the prior application is denied, the registration procedure to which an opposition was submitted will continue with the registrability examination and the office will declare the Andean opposition unfounded or inadmissible without considering the arguments it presented. Finally, the office will issue its decision on whether or not the requested sign is registrable.

- The Andean opposition is a tool to prevent registration before the national office of the Member Country, however, it does not grant authorization for the use of the sign in the market, which is why protection of the trademark must be obtained as the basis for the Andean opposition. in the other CAN Member Country for this purpose.

4. SUBSTANTIVE EXAMINATION (REGISTRABILITY EXAMINATION) .

Once the formal examination has been carried out and the deadline to file an opposition has expired , the registrability examination is carried out. This examination consists of determining whether the requested sign can be registered, verifying whether or not it incurs any legal impediment.

DA 486 contemplates various registration prohibitions for certain signs, which are divided into absolute prohibitions (article 135 of DA 486), relative prohibitions (article 136) and the case of denial established in article 137 of DA 486.

4.1. Absolute prohibitions.

Thaimy Márquez defines absolute prohibitions as:

"Absolute or intrinsic prohibitions are understood to be those that are based on the sign itself, whose characteristics make it incapable of functioning as a trademark, at all or in relation to the goods or services for which it is intended. These prohibitions will always prevent the registration of the sign as a trademark."

Although DA 486 does not provide a definition of absolute prohibitions, these are known as those whose purpose is to protect the competitive system, that is, to prevent the granting of exclusivity of signs that must remain available to all those who participate in the market. .

Below is an analysis of each of them.

4.1.1. Signs that cannot be constituted as trademarks because they do not comply with the fundamental elements (literal a) article 135 DA 486) .

"Article 135.- Signs that:

a) cannot constitute a trademark in accordance with the first paragraph of the previous article;"

The TJCA, in the Preliminary Interpretation ruling through which it declared that articles 134, 135 (literal a and b), 136 (literal a) and 150 of DA 486 constitute a clarified act, reiterated the following in relation to this cause of absolute unregistrability:

"For a sign to be registered as a trademark, it must be distinctive

and capable of being represented graphically, in accordance with the provisions of Article 134 of Decision 486. Likewise, it must be perceptible, since, as mentioned, said requirement is implicit in the trademark concept.

It is important to note that literal a) of article 135 of Decision 486 elevates the lack of any of the requirements arising from article 134 of the same regulations to an absolute cause of unregistrability; That is to say, a sign is absolutely unregistrable if it lacks distinctiveness, susceptibility to graphic representation or perceptibility."

In relation to distinctiveness, as a fundamental requirement for a sign to constitute a trademark, the TJCA indicated that:

"[a)] Distinctiveness is the intrinsic capacity that the sign must have to identify a product or service by itself; and, the extrinsic capacity to distinguish some goods or services from others in the market. The distinctive character of the sign allows the consumer to make the choice of the goods and services they wish to purchase. "In the same way, it allows its owner to differentiate its goods and services from other similar ones offered on the market." .

The second requirement that a sign must meet to be registered as a trademark, in accordance with what is expressly established in article 134 of DA 486, is graphic representation. Regarding this requirement, the TJCA stated the following:

[b)] The susceptibility of graphic representation is the possibility that the sign requested for registration as a trademark is described by words, graphics, signs, colors, figures, etc., in such a way that its components can be perceived by whoever appreciates it. This feature is important for the publication of registration requests in official media.

Now, this Court has broadly interpreted what is meant by graphic representation, which must be clear, precise, complete in itself, intelligible, durable and objective. The requirement of Graphic representation allows a precise definition of the sign, in such a way that the trademark owner, consumers and competitors can verify the scope of the protection granted to the trademark through

its registration, or the scope of the protection requested, through its registration publication" .

As mentioned in the section on the formal examination, DA 486 does not prohibit an applicant from attaching other types of representations, in addition to a graphic representation of its trademark. Therefore, it will be necessary to consider whether a graphic representation with other representation(s) serves to meet the purposes of providing legal certainty and publicity granted by the public registration of trademarks.

The above can be achieved with diverse representations that serve to clarify the object of protection, which requires adapting the graphic representation criteria for certain non-traditional trademarks, to allow more appropriate representations to identify them, such as a clear, precise and complete description of the sign, including a three-dimensional drawing or photograph and a physical sample (in the case of tactile marks, for example)

Finally, in relation to perceptibility, it is important to reiterate that, although this is not expressly included in the terms of article 134 of DA 486, it is implicit in the notion of trademark. On this matter, the TJCA recalled that:

"Perceptibility, precisely, refers to any element, sign or indication that can be captured by the senses so that, through them, the trademark generates greater influence in the mind of the public, who assimilates it easily. Since the sense of sight is consumer generally used for the sensory or external perception of signs, those elements related to a name, a set of words, a figure, a drawing or a set of drawings have been preferably characterized." .

4.1.2. Signs lacking distinctiveness (literal b) article 135 DA 486) .

Subparagraph b) of article 135 of DA 486 provides:

"Article 135.- Signs that:

(...)

b) lack distinctiveness;"

In the Andean regime, the lack of distinctiveness is independently established as a cause of absolute unregistrability. Now, at this point it is important to remember that distinctiveness has a double

aspect, like this:

"[a)] **Intrinsic or abstract distinctiveness** , through which the capacity that the sign must have to distinguish goods or services in the market is determined.

"[b)] **Extrinsic or concrete distinctiveness** , through which the ability of the sign to differentiate itself from other signs in the market is determined" .

The cause of literal b) corresponds to the lack of intrinsic distinctiveness presented by the sign that is the subject of the registration application.

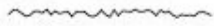
In this regard, Carlos Fernández-Nóvoa points out that "a sign lacking distinctive character in relation to the corresponding goods or services cannot perform the basic function of the trademark, namely, denoting business origin."

It is by relating the sign to the goods or services that it aims to distinguish, consequently, that its distinctive ability or inability to differentiate some goods or services from others will be revealed.

By way of reference, it can be seen in the following examples how the national offices of the Member Countries have denied trademark registrations in application of this prohibition:

In the case of Bolivia, SENAPI denied registration of the DRINK'S trademark, considering that the requested sign does not have elements that give it distinctiveness, nor does it have sufficient capacity to distinguish the "beverage" products, intended in class 32 ("Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations for making non-alcoholic beverages."), so in the particular case, the office considered that the requested sign incurred the prohibition. provided for by literal b) of article 135 of the DA 486 .

For its part, in Colombia, the SIC, when analyzing the registrability of the following sign, applied for to identify products in class 3, considered that it lacks intrinsic distinctive force, since the consumer, upon encountering the sign, would not identify a specific product or service or associate it with a specific business origin:



SENADI in Ecuador denied the registration of the sign SUPER CALCIO TRIPLE FÓRMULA plus logo, requested to identify products of class 5, specifically "vitamin preparations", considering that the name SUPER CALCIO TRIPLE FORMULA does not carry any type of distinctiveness and could in no way be appropriated by the applicant, since the registration of this sign would result in the exclusive use by a single person of a set of words that imply a gender and would thus deprive many others of using it.



In Peru, INDECOPI denied registration of the following figurative trademark, requested to identify products of class 3 such as non-medicated toiletry preparations, as well as cleaning preparations for use in the home and other environments. The office considered that a cylindrical representation and the lines parallel to the base do not represent any particular characteristic that could be susceptible, in itself, to awakening in the consumer public an association with respect to a specific business origin, since the figurative elements indicated do not have any relevant peculiarity

for purposes of identifying the products in question.



4.1.3. Signs that consist exclusively of the usual shape of the goods or their packaging, or of shapes or characteristics imposed by the particular nature or function of the goods or services concerned; (literal c) article 135 DA 486).

Literal c) of article 135 of DA 486 establishes:

"Article 135.- Those signs may not be registered as marks that:
(...)

c) consist consist exclusively of the usual shape of the goods or their packaging, or of shapes or characteristics imposed by the particular nature or function of the goods or services concerned;"

This prohibition contemplates two cases of unregistrability:

-The ways that are usual or widely used to identify the goods covered by the trademark and, -The forms imposed by the nature or function of the goods.

4.1.3.1. Signs that consist exclusively of usual shapes of the products or their packaging.

Signs that consist exclusively of shapes in common use, that is, the shape of the products or their packaging that are used by some of the existing competitors, are not registrable.

On this point, the TJCA has indicated that:

"1.6.1. Forms of common use must be identified and excluded from the analysis, with forms of common use being understood as the shape of the products or their packaging that are used by some of the existing competitors. It is not necessary that they be in common use by all competitors, but it is enough that they be in common use by a group or percentage of them. Thus, for example, if a group of beer-making competitors uses a bottle shape to package the product, said shape cannot be considered a three-dimensional trademark, since there are already competitors that use it in the market, which makes

it a form of common use.

1.6.2. Those shapes that are essential or necessary in relation to the products or their packaging must also be identified and excluded. These are those shapes that have a functionality in relation to the product or its packaging. Thus, for example, in the case of beer bottles, these must necessarily have a lid or plate that secures the contents."

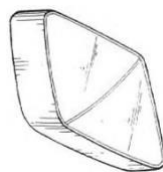
For example, the following three-dimensional shape would not be registrable to identify sweets and candies, products included in class 30:



In this case, it will be enough to search for the word candy in any search engine on the Internet to show that it is usual or common for a candy to be shaped like a cane.

This means that the three-dimensional shape cannot be separated from the product because it is the way it is used in the market.

Likewise, the following way to identify medications (class 5) could not be registered as a trademark:



At first glance it can be determined that this is the usual form of a medication in its pill version; Therefore, it meets the prohibition hypothesis.

Finally, as mentioned, the prohibition also applies to the registration as a trademark of the usual shapes of the packaging of the products that are intended to identify the requested sign. For example, the following form of product packaging includes in class 3

(cosmetics, cleaning preparations, refreshing lotions), corresponds to a usual form of packaging for this type of product:



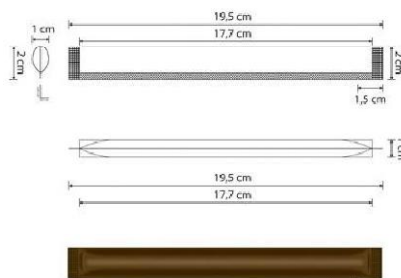
If these trademarks are granted, exclusivity would be granted over a form that is used by various competitors in the market. .

Considerations to determine if the sign overcomes this prohibition:

- Is the three-dimensional shape of the product the one commonly used in commerce by various competitors?
- Is the three-dimensional shape of the container or wrapper the one commonly used in commerce by various competitors?
- From an internet search, is the sign a usual way to identify the products you want to distinguish?
- Is the usual form strictly that of the products? Here it is important to indicate that the usual shape must be strictly related to the products to be distinguished, for example, if a shape of an apple is proposed for registration to distinguish a tool wrapper, this prohibition would not apply. .

Below are some examples of decisions adopted by the national offices of the Member Countries, in relation to this cause of unregistrability:

SENAPI, in Bolivia, denied registration as a three-dimensional trademark of the following sign requested to identify products in



class 30 (chocolate; chocolate-based spreads, chocolate mousse) :
As arguments for the denial, the office indicated that rectangular containers in their different lengths are common and usual in

commerce, for products such as chocolates and other products included in class 30.

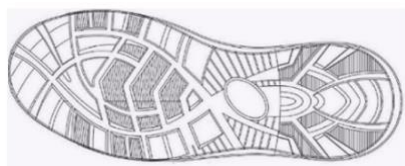
In this understanding, the three-dimensional design does not have "intrinsic" distinctiveness to obtain the registration, since its shape does not have arbitrary or special characteristics and/or elements that are out of the ordinary in the class of goods sought to be registered, and that may be considered as differentiating from those already existing in this class of goods. Indeed, the consumer will associate the three-dimensional shape to the generality of products in the market and will not be able to individualize it to a business origin.

In Colombia, the SIC denied the registration of the following three-dimensional sign, requested to identify class 12 products, including motor vehicles .



According to what was stated by the SIC, The 3D representation shows that this consists of the usual way in which this type is presented of products on the market, which entails that it cannot be associated with a specific business origin, since the The consumer would not relate the brand under analysis with the products of a specific competitor, since in his mind it would evoke the idea of a kind of goods and not a species determined .

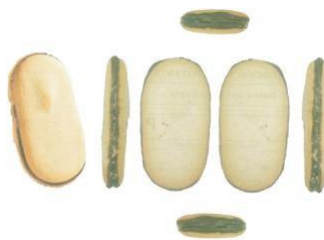
For its part, SENADI, by virtue of this cause, denied the registration of the sign DESIGN (SOLE) , to identify products in class 25 (soles, footwear)



SENADI considered that, after analyzing the application for

registration of DESIGN (OF SOLE), it is evident that it consists of a common shape of the products that the sign intends to identify and also does not have additional elements that could provide distinctiveness, which could not be exclusively appropriated by the applicant as it is necessarily required by other entrepreneurs.

In Peru, INDECOPI, based on this cause of unregistrability, denied the registration of the following three-dimensional trademark, to identify cookies, biscuits and biscuits, products included in class 30:



In this regard, INDECOPI pointed out that the requested sign made up of the three-dimensional shape (with color claims) represents the usual shape of some products that it intends to distinguish (biscuits), the inclusion of a protuberance in the upper part of the biscuit being not sufficient. , nor the chocolate filling in the middle of them to give it distinctiveness .

4.1.3.2. Signs that consist exclusively of shapes or characteristics imposed by the nature or function of the product or service to be distinguished.

The TJCA, in relation to this type of forms, indicated:

"Other types of forms are necessary in relation to the products, their containers or packaging, that is, they must inevitably be used in the market. This need is given because the nature of the product imposes it or because the function of the product does not allow it to have another form. In accordance with Andean regulations, they are classified into: 1) forms imposed by nature, and 2) forms imposed by the function of the product.

The forms imposed by nature are those that arise from the essential elements of the goods. They are forms that, by their configuration and essence, are necessarily linked to the products, their containers or packaging. Let us think of the forms of agricultural products; fruits and vegetables have these forms because their very nature determines them. A guava has that form because its structural

elements impose its form; it could not be otherwise except for certain mutation or external manipulation.

The forms imposed by the function of the product are those that are determined by the purpose of the product. It would be necessary to ask what the product is for?, and in this way identify its functional form. Let's think about the figure of a tire, a hook for hanging clothes, pliers, or a pencil. The ordinary forms of such products are supported in relation to their function; "No one could imagine a pencil without that thin, long, cylindrical, and characteristic shape of the pencil, whose main objective is manual writing."

In fact, there are products on the market whose shapes cannot be registered as a trademark since they fulfill a specific functionality, or because it is the shape that naturally gives the product existence. .

For example, the registration of the shape of nuts to identify metal nuts (class 6) should be denied, since the internal grooves serve to hold a screw and firmly join larger pieces, just as the hexagonal shape has the functionality of fitting with a wrench so that the screw can be adjusted to the nut. Thus, forms with a functional nature are not registrable as a trademark.

Considerations to determine if the sign overcomes this prohibition:

- What is the form for?
- From a regular internet search, is the sign a form that is utilitarian?, or is it the natural form of the product?

4.1.4. Signs that consist solely of shapes or other elements that afford a functional or technical advantage to the product or service to which they are applied (literal d) article 135 DA 486) .

Subparagraph d) of article 135 of DA 486 provides:

"Article 135.- Signs that: (...) may not be registered as marks that:

d) Signs that consist solely of shapes or other elements that afford a functional or technical advantage to the product or service to which they are applied;"

In relation to the assumption to which this cause of unregistrability refers, the TJCA indicated that:

"The technical or functional advantages that are inserted into the products are regulated by the figure of the utility model. In this sense, for a trader as a trademark to appropriate shapes or elements that offer a technical or functional advantage to a product is not consistent with the protection that the aforementioned figure offers for the same objects.

The utility model falls on an already existing object, providing it with an advantage, benefit or utility that it did not have. Article 81 of Decision 486 defines the utility model as follows:

'Any new shape, configuration or arrangement of components of any device, tool, implement, mechanism or other object, or any part thereof, that makes for improved or different operation, use or manufacture of the object incorporating it, or which endows it with any usefulness, advantage or technical effect that it did not have previously, shall be considered a utility model.'

The utility model patent is granted for a period of 10 years. Once this term has expired, the protected object enters the public domain and, for this reason, no one can be given an exclusive right over it.

When the standard speaks of a technical or functional advantage of the product, it is not referring to merely aesthetic elements, but to a technical improvement, which translates into a practical improvement or a beneficial effect, in terms of the object's ability to satisfy "a human need" .

There are signs with a three-dimensional shape that at first glance are different from other shapes to identify products of the same species; However, that shape has a specific function in its use, giving it a functional advantage.

Let's look at the following example, in a way that identifies a disinfectant detergent, a product included in class 3:



This container has a curvature in its neck that, in principle, could be thought to be different from any other container that identifies disinfectant detergents; However, this curvature allows the disinfectant to be applied more easily to the inner edges of a toilet and, therefore, has a functional advantage and is not registrable as a trademark.

To analyze which signs have a functional advantage, it is necessary to ask what the purpose of the product is and the answer can identify whether or not the shape offers a functional advantage. .

Considerations to determine if the sign overcomes this prohibition:

- What is the purpose of the form?
- From a regular internet search, is the sign a shape that offers a functional advantage?
- If you have a functional advantage, is this advantage related to the goods or services you want to distinguish?

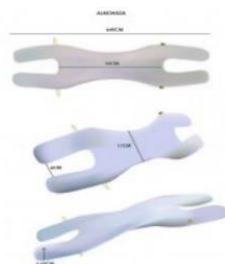
The following are some examples of decisions denying applications for three-dimensional trademark registration, in which the national offices of the Member Countries considered that it was appropriate to apply the cause of unregistrability contained in literal d) of article 135 of DA 486.

The SIC denied the registration of the following sign requested as an animated trademark to identify the products included in class 18, particularly: Leather and imitation leather, products of these materials not included in other classes; animal skins; trunks and suitcases; umbrellas and parasols; Canes; riding crops and saddlery items:



I consider the office that this sign results in a functional benefit per se, since the movement translated into folds of a surface that contains numerous pocket-type compartments, which culminate in a useful object (suitcase), precisely to identify suitcases (class 18), it differs from the characters that it must have a sign for its effective registration.

SENADI, on the other hand, considered that the following three-dimensional sign, described by the applicant as "Pillow with irregular shape that adapts to your favorite position when sleeping and whose main function is to protect your face from marks and wrinkles since its design prevents friction of the face", incurs in the analyzed cause of irreregistrability, since the design provides a functional and/or technical advantage to the product:



In Peru, INDECOPI refused the registration of the following sign composed of the three-dimensional shape of a soap dispenser, applied



for to identify goods in class 3, on the grounds that it has characteristics that give it functionality:

4.1.5. Exclusively descriptive signs (literal e) article 135 DA 486.

Literal e) of article 135 of DA 486 establishes:

"Article 135.- Signs that:

(...)

e) consist solely of a sign or statement that may serve in business to describe the quality, quantity, purpose, value, place of origin or time of production of, or to impart other data, characteristics or information concerning, the goods or services for which the sign or statement is to be used, including expressions extolling the said goods or services;"

According to the TJCA:

"Descriptive signs are those that exclusively inform about the characteristics or properties of the products, such as their quality, quantity, functions, ingredients, size, value, destination, etc. The descriptive name responds to the formulation of the question: what is it like? in relation to the product or service for which it is being inquired, and said question is answered with the expression appropriate to its characteristics, qualities or properties, as applicable."

These signs are not subject to registration because describing the product or service that is to be distinguished would affect the right of competitors to use a sign that is intrinsically related to the goods or services.

It must be taken into consideration that the cause of unregistrability applies to exclusively descriptive signs. In this regard, the TJCA has indicated the following:

"...a sign made up exclusively of designations or descriptive indications is not registrable. However, composite signs made up of one or more descriptive words have the possibility of being registered as long as they form a sufficiently distinctive group. The owner of a sign with these characteristics cannot prevent the use of the descriptive element and, therefore, his trademark would be considered weak."

The above means that, if a sign is made up of descriptive terms, but these are accompanied by other distinctive elements, the sign could

be registrable.

On the other hand, there is a fine line between descriptive marks and evocative marks. Evocative marks are registrable because they give the idea or suggest some quality or characteristic of the goods or services, but they do not include it directly in the sign. In relation to evocative signs, the TJCA has indicated that:

"A sign has evocative capacity if it has the ability to indirectly suggest in the consumer a certain relationship with the product or service it covers, without this occurring in an obvious manner; That is, evocative trademarks do not directly refer to a special characteristic or quality of the product or service, since it is necessary for the consumer to use their imagination to relate it to it through a deductive process.

Evocative signs fulfill the distinctive function of the trademark and, therefore, are registrable. However, the greater the proximity of the evocative sign to the product or service that is intended to be registered, it may be considered a markedly weak sign and, consequently, its owner would have to support the registration of signs that to some degree resemble its distinctive sign. This occurs in the case of evocative signs that contain generic, descriptive or commonly used elements, since their owner cannot prevent third parties from using said elements."

For example, the expression "FIRST HAND" to identify services for the provision of television news programs (class 41). Although it can be thought that the news program obtains the information from the first person who generated the news and provides a superior quality of information by having the information from an immediate source, it does not describe the service as such.

Finally, it should be noted that examiners are frequently faced with requests for registration of signs that are made up of denominations in foreign languages. In relation to these and the analysis that the offices must carry out on their registrability, the TJCA has indicated that:

"2.2. Words that are not part of common knowledge are considered fantasy signs and, consequently, it is appropriate to register them

as trademarks.

2.3. On the contrary, if the conceptual meaning of the words in a foreign language has been made known to the majority of the consumer or user public and, in addition, they are exclusively words in common use in relation to the goods or services to be identified, such signs shall not be registrable.

2.4. Now, in the event that a name that makes up a trademark is expressed in a foreign language that serves as an equivalent root in the Spanish language, the degree of common use must be measured as if it were a local expression. Thus, they will not be able to access registration those denominations that, despite belonging to the foreign language are in common use in the countries of the Andean Community or are understandable to the average consumer of the country in which it has been applied for the trademark because of its common root or because of its phonetic similarity with the corresponding translation into Spanish .

2.5. There are words in other languages that are frequently used by Spanish speakers (foreign words) and, obviously, are understood by them, so the confusion analysis must take into account the ideological or conceptual element. What's more, certain words that at one time were foreign words later become part of the Spanish language when they are collected by the RAE, with the rules specific to this language.

2.6. It is important to keep in mind that industrial property law takes into consideration what really happens in the market, so the so-called principle of primacy of reality is applicable to this legal discipline. In this sense, in the case of words in a foreign language, the competent national authority must examine whether the average consumers, recipients of the intended product or service be distinguished by the requested sign whether or not those words comprise. If such consumers fully understand the meaning of such In other words, the treatment will be similar to that given to the Spanish language . (underlined outside the original text).

4.1.5.1. Signs that describe the quality of the goods or services to be distinguished.

Signs that indicate some property of the goods or services that

distinguishes the sign are not registrable, because they would be giving a commercial advantage over other competitors. Example:

HANDMADE TEXTILES FAIR

Class 35. Commercial exhibition of artisan products

If this name were registered as a trademark, it would be ratifying that an individual had the exclusive use of the enunciation of a quality that is applicable to an entire class of services.

Considerations to determine if the sign overcomes this prohibition:

- What are the goods or services like?

If the answer directly indicates the requested sign, it describes the goods or services.

If the answer leads one to think that they "may" be that way without directly indicating it to me, the mark is evocative.

- If the sign is made up of descriptive terms, but these are accompanied by other distinctive elements, the sign could be registrable.

INDECOPI, for example, denied registration of the FLEX TAPE trademark, to distinguish adhesive tapes for industrial or commercial use to stick solid surfaces, from class 17. The office considered that the translation of the phrase FLEX TAPE, as 'flexible tape', will be known by consumers due to its wide use in commerce and its basic training in the English language in our environment. In that sense, said phrase in relation to the products in question will be perceived as a direct reference to flexible tapes, a characteristic characteristic of adhesive tapes, so that the expression in question, being descriptive, cannot be appropriated exclusively.

4.1.5.2. Signs that describe the destination or purpose of the goods or services to be distinguished.

The signs to which this cause of unregistrability applies are those that directly inform the consumer when or where to consume the products or contract the services that are intended to distinguish or what the purpose of the goods or services is. For example:

METAVEVERSE

Class 36. Financial services

Metaverses are virtual spaces where people interact socially and economically through avatars. In the specific case, the name METAVERSO to identify financial services, directly informs that the services will be provided in the virtual environment. Due to the above, the aforementioned expression cannot be granted exclusively to a specific owner, since the term is descriptive of the destination of the services that are intended to be protected.

Considerations to determine if the sign overcomes this prohibition:

- Where can the goods or services be used?
- For what purpose will the product be used or the service provided?

If the answer directly indicates the requested sign, it describes the goods or services.

If the answer leads one to think that it "may" be in a certain place, at a certain time, or for a certain purpose, the sign will be evocative and, therefore, would not be subject to this cause of unregistrability.

- If it has additional distinctive elements, it may be registrable.

In Peru, for example, INDECOPI, in application of this prohibition, refused the registration of the sign YES ENERGIZE YOU, to distinguish beers; mineral waters and other non-alcoholic beverages; fruit drinks and fruit juices; syrups and other preparations for making beverages in class 32, considering that the mentioned denomination will be understood by consumers as a denomination that is limited to highlight one of the purposes of the products to be distinguished, namely, that the products when consumed produce the effect of providing energy to those who consume them, a characteristic that is common to find in the commercial sector of these products and therefore such denomination will not be perceived as an indicator of a specific business origin.

4.1.5.3. Signs that describe the value of the goods or services to be distinguished.

In relation to the signs that indicate the value of the goods or services to be distinguished, their registration is prohibited whenever they describe a characteristic of the product or service, which must be freely used by all actors in the market. For example:

\$99 BURGER

Class 29: processed meat-based foods

The sign indicates the value of the hamburger, therefore it is not registrable.

Signs that express the value of goods or services in a more general way, such as CHEAP MEALS to distinguish sandwiches or EXPENSIVE ALCOHOL to distinguish wines, are also prohibited from registration as trademarks because they are descriptive.

Considerations to determine if the sign overcomes this prohibition:

- Does the sign as a whole indicate the cost of the goods or services to be distinguished?
- Does the sign express the value in a concrete way of the goods or services to be distinguished?
- If it has additional distinctive elements, it may be registrable.

For example, in application of this prohibition, in Bolivia, the SENAPI denied the registration of the TODO BARATO sign, requested to identify class 35 services., since it was considered that the sign describes a characteristic of the products that will be marketed through the wholesale and retail service, indicating that the value of the products that it will make available to consumers has a better price than those of the competition, this term will be used for advertising purposes and as an advantage over its competitors, which is not correct.

4.1.5.4. Signs that describe the geographical origin of the goods or services to be distinguished.

These signs are those that directly indicate or inform the geographical origin of the goods or services to be distinguished. For example:

COCHABAMBA BEAN

Class 29: canned legumes

This sign cannot be registered as a trademark because it is indicative of the place of origin and therefore describes the geographical origin of the products to be distinguished.

There are signs that may suggest that the goods come from a geographical area but clearly do not describe them, for example, in the previous case, to distinguish those legumes, EL COCHABAMBINO

LOCO, may be a suggestive expression of the place of origin, but does not indicate it directly.

Considerations to determine if the sign overcomes this prohibition:

- Where is the product or service from?
- If the answer is included in the sign, it will be descriptive.
- If the answer is not direct and only leads to thinking that it may be from a place, the trademark is evocative.
- If it has sufficiently distinctive additional elements, it may be registrable.

4.1.5.5. Signs that describe the production period of the products to be distinguished.

Information about the production period of a product can be decisive for the consumer to decide to purchase it, so granting exclusivity to an individual would be contrary to the rules of free competition.

Now, it should not necessarily be denied because the sign contains elements that could infer a date, since that information is not necessarily related to the product or its production period, or is not essential for the consumer can determine their purchase, for example, in Colombia, the SIC granted registration of the combined trademark 1925 eyewear, to identify products in class 9: (optical devices, cases for lenses and frames, contact lenses, glasses, frames, glasses lenses, magnifying glasses, optical items):



Here it is clear that, although it can be inferred that the number is a year, it is not an inherent characteristic of the product that can be descriptive and, therefore, this trademark is registrable.

Considerations to determine if the sign overcomes this prohibition:

- Is it feasible to determine at first impression that the trademark refers to a period?
- If it is the case that it does refer to a period, can it be inferred that it is related to the products to be distinguished by the sign?
- If it has additional distinctive elements, it may be registrable.

It is very common for applications to be submitted for signs that contain, within the word elements, the year of the applicant's start of activities, usually presented as "since (...)" or the equivalent expression in English "since (...)". or "It is (...)". These elements can be part of the trademark set, but must be accompanied by sufficiently distinctive elements.

In Colombia, for example, the SIC refused the registration of the word sign COLLECTION 2000, applied for to distinguish clothing, footwear and headgear, products included in class 25, on the grounds that *"the sign to be registered is indicating the nature and characteristics of the product, through the denominations - COLLECTION- and -2000-, since it is proper to products in class 25, such as clothing, which are presented in collections by years, for example the summer 1999 collection, in countries that have seasons, or the 1999 collection for countries that do not have seasons, therefore granting the requested expression would be granting exclusivity in an expression necessary for traders to refer to a collection of clothing in a specific year such as 2000."*

4.1.5.6. Signs that describe other data or characteristics of the goods or services to be distinguished.

DA 486 leaves open the possibility of interpreting that any "data, characteristic or information" of the product or service to be distinguished may be descriptive.

A data, characteristic or information of the product or services can be the composition, for example:

HALOGEN LAMP

Class 11: Lighting devices.

This sign is informing us that the lamp is composed of halogen and, therefore, is descriptive of lighting devices. In this sense, if the trademark that is intended to be protected is indicative of one of the materials from which the product is made, it is informing the consumer of its composition.

HOLLOW COTTON

Class 24: Bedding.

"Hollow cotton", as the sign is translated, is a material that is

commonly used for bedding textiles, which is why it is a characteristic of the composition of the product and, therefore, this sign would be unregistrable.

Considerations to determine if the sign overcomes this prohibition:

- If reading the sign reveals an inherent characteristic of the product or service, it must be refused.
- If it has additional distinctive elements, it may be registrable.

For example, SENAPI rejected the registration of the sign CHUFLAY SITO, requested to distinguish products in class 33 (alcoholic beverages such as; grape brandies, distilled beverages), considering that "the sign describes the product intended for its protection (CHUFLAY - type of preparation of alcoholic beverage), and the term SITO does not make it distinctive compared to the other products in the market, since it is indicating the same product but in diminutive, thus lacking distinctiveness, incurring in grounds of unregistrability of Art. 135 literal e) of the DA 486".

In Ecuador, SENADI denied the registration of the SOPHISTICATED COFFEE sign for class 43 because it considered that the requested sign is descriptive to identify coffee shop services since, despite being in English, users would understand its meaning and it makes direct reference to the nature of the services and the characteristics, giving information about what it is about and what it is intended for.

INDECOPI, for its part, in application of this cause, denied the registration of the sign RADIO SUPER FOLK, requested to identify telecommunications services (class 38) and entertainment (class 41), because "although the name RADIO SUPER FOLK includes an element in English (FOLK), this will be understood by users. In this sense, the requested sign directly informs that the services that are intended to be distinguished will be provided under the radio format with a preeminence of folk music exhibition" .

4.1.5.7. Signs with laudatory expressions.

According to the RAE, the word laudatory means "that praises or contains praise." ; In the field of trademarks, particularly in relation to this prohibition, this means that signs that contain expressions that exalt, praise or praise the characteristics or

qualities of the goods or services they are intended to distinguish are not registrable.

The TJCA has indicated that these signs are also related in the advertising field by extolling a superior characteristic of the goods or services without expressly referring to competitors. It is understood then that granting exclusivity to this type of expressions would prevent competitors from using such expressions to advertise their goods or services. For example:

THE BEST MEAT FOR BURGER
Class 29: Meat.

The previous expression is laudatory and is exalting the product that it wishes to distinguish, since it announces that meat is the best, falling into the prohibitive assumption. It is important to note that, if this same sign had an additional element that gave it distinctiveness, it would be registrable, in which case the owner would not be able to prevent the use of the laudatory element by third parties.

Considerations to determine if the sign overcomes this prohibition:

- The laudatory expression must be directly related to the goods or services to be distinguished.
- What characteristics or qualities does the laudatory expression exalt?
- Does the laudatory expression include any additional distinctive element? If so, the sign may be registrable.

4.1.6. Signs that consist exclusively of a sign or indication that is the generic or technical name of the product or service in question (literal f) article 135 DA 486).

Subparagraph f) of article 135 of DA 486 provides:

"Article 135.- Signs that:

(...)

f) consist exclusively of a sign or indication that is the generic or technical name of the product or service in question;"

In the terms indicated by the TJCA:

"[3.2] The **generic name** determines the gender of the object it identifies and the technical name refers to the expression used

exclusively in the language of an art, science or craft. No person can be granted the exclusive right to use that word, since it would create a position of unfair advantage over other business owners. The generic aspect of a sign must be appreciated in direct relation to the goods or services in question.

[3.3] The generic expression can be identified when when asking the question what is it? In relation to the designated product or service, the answer is given using the generic name. From the point of view of trademarks, a term is generic when it is necessary to use it in some way to indicate the product or service that you wish to protect or when in itself it can serve to identify it.

[3.4] However, a generic term in relation to goods or services may be used in a sense different from its original or proper meaning, so that the result will be novel when it is used to distinguish certain goods or services which have no direct relation to the term being used.

Thus, the signs that are unregistrable in light of this cause are those that exclusively contain a technical term or that identifies the type of goods or services that it is intended to identify. For example:

ACETAMINOPHEN

Class 5. Pharmaceutical products.

LIPSTICK

Class 3. Cosmetics.

However, the registration of a sign that contains a generic element and other additional distinctive elements, whether graphic or word, is permitted, and ACETAMINOPHEN SAMUEL and LIPSTICK PINCSS could be registrable for pharmaceutical and cosmetic products respectively. As mentioned, the examiner must ensure that said generic expression is directly related to the goods or services that the sign is intended to identify.

Considerations to determine if the sign overcomes this prohibition:

- The generic or technical name included in the sign must make direct reference to the goods or services to be distinguished.

- Does the name that constitutes the generic or technical name of the goods or services include other elements that give it distinctiveness? If so, the sign may be registrable.

In Colombia, for example, the SIC denied registration of the CLOROGEL sign, to identify class 1 products, namely, chlorine gel, a product for disinfecting bathrooms and floors. The office considered that the expression CLOROGEL is composed of the union of two requested products that cannot be sufficiently distinctive.

For its part, INDECOPI denied the registration of the KOMBUCHA sign requested to distinguish tea-flavored non-alcoholic beverages in class 32, as it constitutes a generic element to precisely designate "tea-flavored non-alcoholic beverages" .

4.1.7. Signs that consist exclusively of or have become a common or usual designation of the product or service in ordinary language (literal g) article 135 DA 486) .

The prohibition provided for in literal g) of article 135 of DA 486 establishes:

"Article 135.- Those signs may not be registered as marks that:
(...)

g) consist solely or have become the common or usual designation for the product or service concerned in the everyday language or usage of the country;"

In this regard, the TJCA has stated:

"[3.5] A **common or usual sign is understood to** be one that is exclusively made up of one or more words or indications that are used in the common language or commercial use of the country to identify the goods or services in question.

[3.6] It is not possible to accept as a registrable trademark those signs that have become a common or usual designation of the product or service in question in the common language or custom of the country.

We are talking about usual signs in common language or in commercial usage in relation to the goods or services they are intended to represent, that is, those signs that have become common in common language or in commercial customs to designate goods or services in

question.” (bold in the original text).

When a product or service is known in the market with a term that, although it is not the generic or technical name, is understood to be the same, it is said to be a common or usual term and, therefore, no one can have exclusivity over it. For example, trademark registration could not be granted to the sign:

THE FLIP-FLOPS

Class 25: Clothing and footwear.

The term “flip flops” is a way that is usually used to identify sandals, and although the requested sign is in diminutive, this does not prevent it from clearly identifying the footwear and, therefore, it should not be registered.

Considerations to determine if the sign overcomes this prohibition:

- The question should be asked about the sign: what is it? And if the response is a way to recognize any of the goods or services covered by the request, it must be denied.
- If, from an internet search, the sign proposed for registration clearly identifies one of the goods or services, it must be denied.
- Does the common or usual designation of goods or services include other elements that give the sign distinctiveness? If so, the sign may be registrable.

In Colombia, for example, the SIC denied registration of the sign SKY BAR, requested to identify services in class 43, including bar services; cocktail services; night club services; restaurant services; catering and catering services; bistro services. According to what was stated by the office, the term SKY BAR is a common designation in Colombia and other countries to refer to open-air bars with a panoramic view, a circumstance that implies that it lacks the distinctive force necessary to be registered when considering its coverage, which refers to bar services, cocktail services, nightclub services and restaurant services, among others, a genre within which the establishments called “sky bar” in colloquial language are found. .

For its part, SENADI denied the registration of the PIQUETE sign to distinguish alcoholic beverages, products of class 33, since this

expression refers to an Ecuadorian idiom commonly used to identify alcoholic beverages. .

INDECOPI, based on this absolute prohibition, denied the registration of the PULITON sign, requested to identify class 3 products, such as preparations for cleaning, polishing, degreasing; and scraping (abrasive preparations). In the opinion of INDECOPI, the requested sign constitutes a term used in common language and in the commercial media of the relevant sector to refer to an abrasive preparation. .

4.1.8. Signs made up of isolated colors not delimited by a specific form (literal h) article 135 DA 486) .

Literal h) of article 135 of DA 486 establishes:

"Article 135.- Signs that:

(...)

h) consist of a color in isolation, without any demarcation to give it a specific shape;"

In relation to the registration of color trademarks, it should be remembered, first of all, that DA 486, in literal e) of article 134, expressly contemplated the possibility of constituting a trademark "a color within an outline, or a color combination;" , this, of course, subject to the requested sign not incurring any reason for unregistrability.

Thus, we have that, first of all, fundamental or pure colors are not registrable, since giving the exclusivity of a color to a holder will result in a few being able to use colors in their signs.

In this regard, the TJCA has stated the following:

"137. Contrary sensu, Decision 486 in its article 135 literal h) prohibits the registration of a color considered in isolation. In this regard, the Court has indicated that the prohibition contemplated in literal h) of article 135 of Decision 486 refers, first of all, to the seven fundamental colors of the rainbow, a prohibition that is supported by the circumstance that the number of fundamental and pure colors is certainly very limited: the accentuated scarcity of fundamental and pure colors visibly contrasts with the great abundance of denominations and graphic elements. From which it follows that, if through a trademark,

"137. On the contrary, Article 135(h) of Decision 486 prohibits the registration of a color considered in isolation. In this regard, the Court has pointed out that the prohibition contemplated in Article 135(h) of Decision 486 refers, in the first place, to the seven basic colors of the rainbow, a prohibition that is based on the fact that the number of basic and pure colors is certainly very limited: the marked scarcity of basic and pure colors contrasts visibly with the great abundance of denominations and graphic elements. It follows that if, by means of a trademark, a company were able to appropriate a fundamental or pure color, it would gain an inordinate competitive advantage and, at the same time, competitors would encounter a serious obstacle that could block free access to the market.

138. The obstructionist effects derived from the granting of a trademark on a fundamental or pure color would be particularly palpable in the hypothesis that the color was necessarily common to a genre or line of products or to its packaging or packaging.

The TJCA also indicated that:

"The aforementioned prohibition also covers pure colors that are easily identifiable due to their chromaticity, as well as secondary colors, the result of combinations that in any case are unlimited.

However, it must be taken into account that the prohibition under analysis is not absolute, since it only operates when the color is not "delimited by a specific shape", that is to say, when it is included in a silhouette or outline, it can be registered as a trademark, as well as when it is an integral part of a three-dimensional sign, obviously, provided that it does not fall under any other ground of unregistrability, since, e.g., "it is not because the usual shape of the product is the one that delimits the color in question that its registrability can be affirmed", not by the fact that the usual shape of the product is the one that delimits the color in question, its registrability can be affirmed".

Now, it should be considered that a color will be registrable when it is demarcated by a specific form, since if this requirement is met, the use of the color by third parties will not be restricted in an unlimited manner. The TJCA indicated the following regarding this

requirement:

"(...) it must be taken into account that the prohibition under analysis is not absolute, since it only operates when the color is not "delimited by a specific form", that is, as has been said, the registration of colors is duly permitted. delimited by a specific form."

Now, in relation to the "specific way" in which the color requested for registration must be delimited, it is important to note that in accordance with what the TJCA has recognized, this must be understood as an additional requirement, if you want it to be special. , that applications for color trademarks must comply and that the way in which the color is presented delimited does not need to be distinctive, since, due to the very nature of this trademark, its registration is requested precisely on one or more specific colors , without claiming exclusive rights over the way in which these are presented within the application.

In this regard, the TJCA stated:

"Although the legislator has required as an additional requirement that it be delimited by a shape, the distinctiveness analysis cannot be performed independently with respect to the integral elements of the applied-for sign, thus demanding a requirement not contemplated in the Andean Standard, consisting of the distinctiveness of the shape that delimits the color, because if the above were required, the essence of the color mark would be distorted".

Finally, the examiner must take into consideration that, simply because the color is delimited by a specific form, it will not necessarily be registrable, since he must assess whether there are other causes that may apply to the requested color sign. For example, the delimited color must be distinctive in relation to the goods or services to be distinguished, thus, the color orange cannot be registered to distinguish orange juice, given that that color is characteristic of the product to be distinguished. It should be noted that, in these cases, the analysis corresponds to the application of other causes of unregistrability such as those established in literal b) or literal e) of article 135 of DA 486, as appropriate. .

Considerations to determine if the sign overcomes this prohibition:

- Was the color delimited by a certain shape presented in the application?

INDECOPI, for example, denied the registration of the sign made up of the color green Pantone 361 (no form claimed), requested to identify products in class 30

(Cocoa and preparations and drinks made from cocoa; instant drinks based on malt extract and cocoa) :



INDECOPI considered that the requested sign is an isolated color not delimited by a specific shape and that it does not have additional elements that give it distinctiveness. .

4.1.9. Deceptive signs (literal i) article 135 DA 486).

Literal i) of article 135 of DA 486 establishes:

"Article 135.- Signs that:

(...)

i) may deceive the commercial media or the public, in particular regarding the geographical origin, nature, method of manufacture, characteristics, qualities or suitability for use of the goods or services in question;"

The TJCA, in the Preliminary Interpretation ruling through which it declared that articles 135 (literal i), 136 (literal h) 228 and 230 of DA 486 constitute a clarified act, reiterated the following in relation to this cause of absolute unregistrability applicable to so-called misleading signs:

"[1.3] This is a general prohibition that is configured with the possibility that the sign is misleading, without the need for it to actually occur. The aforementioned prohibition is developed through a non-exhaustive list of assumptions that have in common the reason that prevents its registration, which is that the misleading sign does not fulfill the functions of the distinctive sign, because instead of indicating the business origin of the product or service to which it refers and its level of quality, it misleads the

commercial media or the consumer or user public about these circumstances, and thus clouds the market".

In accordance with the above, signs will not be registrable when, whether intentional or not, they incorrectly inform the consumer about the goods or services they are intended to distinguish.

The deception, in the opinion of the TJCA, occurs in the following way:

"Deception occurs when a sign causes in the consumer's mind a distortion of reality about the nature of the good or service, its characteristics, its origin, its method of manufacture, its suitability for use and other information that induces public to error. The prohibition of registering misleading signs, as this Court has ruled, is aimed at protecting the general or public interest, that is, the consumer. The deceptive character is relative, that is, there are no deceptive signs in themselves. They may be so depending on the goods or services that they are going to distinguish."

In these cases, unlike descriptive and generic signs, even when they are accompanied by other elements that grant distinctiveness to the sign, if they contain an element that causes the consumer to be misled or deceived, their registration must be denied.

The cited literal i) establishes various aspects on which one can be misled:

4.1.9.1. Misleading signs about the geographical origin of goods or services.

For a sign to be able to deceive or induce error or deception in relation to the geographical origin of goods or services, the TJCA has established that the following assumptions must occur:

- "- That the sign consists of an indication of origin or a symbol that indirectly designates a specific geographical place.*
- That the geographical place, directly or indirectly designated, is characterized by the manufacture of the respective goods, that is, there is a close link between the geographical place and these.*
- That the goods for which registration has been requested do not*

have the geographical origin or provenance to which the sign refers."

This means that when a misleading sign is identified regarding the geographical origin of the goods and services, the previous rule must be applied; In accordance with the practice of the Peruvian office, to establish whether there is deception, the INDECOPI examiner must strictly adhere to what the representation of the sign itself communicates. From the above, it follows that, in Peru, a sign that includes an indication of origin or a symbol that is associated with a specific geographical location is not considered misleading, simply because the applicant for registration declares a different geographical place, since there is a possibility that the products to be distinguished with the sign actually come from the place referred to in it.

In Bolivia and Colombia, for their part, the industrial property offices have considered that the sign that consists of an indication of origin or a symbol that is associated with a specific geographical place, will be subject to this cause of unregistrability, if the The applicant is domiciled in a place other than the one referred to by the sign and no evidence has been provided to prove that the products to be identified come from the region that the sign suggests to the consumer.

SENAPI, for example, denied the registration of the following combined sign, requested to identify products in class 32, namely, beers .



Bayern Weisse

In consideration of the office:

" The name and design BAYERN WEISSE according to the intended products is misleading since they are "Beer" and as is evident the design clearly carries within itself a coat of arms of a city located in Germany, therefore that it will clearly mislead the consumer, who would think that the beer comes from that country, however, a review of the form shows that the applicant is domiciled at B/Cataluña Km 8 Norte Segundo Pasillo SN in the city of Santa

Cruz of the country of Bolivia, the requested trademark would directly lead one to think that they come from Germany, making it impossible to register a MISLEADING distinctive sign in strict relation to the legal, jurisprudential, doctrinal precepts and in accordance with the protection of society." .



Along the same lines, the SIC denied the registration of the combined sign CLAN MC. WILLIAMS, requested to distinguish products of class 33 (alcoholic beverages):

The SIC stated that:

"Although the sign requested in this administrative procedure contains elements that can give it distinctive ability and that can allow consumers to associate it with a specific business origin, its set of expressions relate it to a possible origin of the product with the capacity to attract the consumer to purchase it, being misleading or potentially causing confusion to the extent that the mentioned product does not have such origin. (...)

When the sign is seen as a whole, it generates an association with a specific liquor (whiskey) originating from a region that is world-renowned for the manufacture of said good (the United Kingdom). First of all, the combination of words CLAN Mc. WILLIAMS can be understood by the public as a reference to some family originating from Scotland or Ireland. This is taking into account that the prefixes Mac or Mc are mostly recognized in popular culture as components of some patronymic surnames originating from these countries. Thus, it is known that in ancient times, when surnames began to develop in both regions, the Gaelic expression mac (later abbreviated to mc) was added to the father's name, to mean son of. Added to this is that it is widely known that the culture and history of the Scottish territory is linked to its organization into clans. Finally, the expression BLENDED WHISKY allows us to specify that the products to be identified by the sign (alcoholic beverages) include whiskey, a drink that is commercially usually associated

with British culture. In this way, it is the union of all these elements that will implant in the consumer's mind the erroneous idea that they are looking at a product originating in the United Kingdom.

It is reiterated, it is not unknown that the expressions individually considered CLAN, MC and Mc. WILLIAMS are not exclusive to Scottish culture and the so-called BLENDED WHISKEY is a presentation of whiskey that is not unique to the United Kingdom. But it is the combination of all.

These terms can give rise to the public's expectation that they are looking at a whiskey of British origin, when the truth is that the applicant is domiciled in Panama City (Panama). Furthermore, no evidence was provided to prove that the products to be identified come from the region that the sign suggests to the consumer. It is this possibility of generating an erroneous expectation in the public about the origin of the product that should lead to the denial of registration."

4.1.9.2. Misleading signs about the nature of the goods or services.

The signs that fall under this prohibition are those that provide misleading information about the nature of the goods or services to be protected, causing the consumer, voluntarily or involuntarily, to fall into error and obtain a product identified by that trademark that is not necessarily what they intended. wanted to. For example:

HAPPY MILK

Class 05: Dairy formulas.

In the market it is common to be confused with milk as a natural dairy product and a dairy formula, which is not the same. In this particular case, the requested sign leads the consumer to think that this mark distinguishes milk; however, that is incorrect.

Considerations to determine if the sign overcomes this prohibition:

- If the sign contains a particular product, it must be analyzed whether this is part of the description of the products to be distinguished.
- In the case of colored signs, does the color make the sign deceptive?

The SENAPI, for example, denied the registration of the word sign CAFÉ ONKEL, requested to identify the following products included in class 30: wheat flour, flours, whole wheat flour, doughs, mixtures and pastes for the preparation of bakery, pastry or biscuit products.

In the office's opinion, although the term COFFEE is arbitrary with respect to the products that the sign intends to distinguish, it is important to protect the general interest of consumers and prevent them from being misled, which is why the requested sign must be denied. because the term COFFEE causes in the consumer's mind a distortion of reality about the nature of the product, since when purchasing the products "Wheat flour, flours, whole wheat flour, food masses, mixtures and pastas for the preparation of bakery, pastry or biscuit products" identified with the CAFÉ ONKEL brand, consumers could be misled.

In Peru, for its part, INDECOPI considered the combined sign NOT MILK, requested to identify milk and dairy products of class 29, unregistrable. Therefore, in its concept, "the name will be understood as "not milk" or "it is not milk", being misleading, as it attributes incorrect characteristics to some products that it intends to distinguish (dairy products). Although the requested sign includes a graphic element, this does not distort the misleading nature of the name."

4.1.9.3. Misleading signs about the way of manufacturing, characteristics or qualities of the goods or services.

A sign is considered misleading about the manner of manufacture, characteristics or qualities of the goods or services when it is possible that the sign misrepresents the reality regarding the goods or services in the mind of the consumer and that this misconception is a reason why the product or service is purchased. For example:

SIDRAN FABRICS

Class 24. Only printed fabrics.

This sign is misleading because printed fabrics are not woven and generates an erroneous and false idea at first impression.

GOOD COFFEE

Class 30: Coffee and coffee substitutes.

This trademark is misleading if it is intended to identify drinks made up of 90% chicory and 10% coffee.

UNBREAKABLE

Class 21: glassware for culinary use

It is clear that glass is a material that is susceptible to breaking with a blow, saying that the articles distinguished with the sign proposed for registration are unbreakable misleads about a quality of the product derived from its manufacture.

Considerations to determine if the sign overcomes this prohibition:

- Is there the possibility that the trademark induces the consumer public to understand that the manufacturing method, characteristics or qualities of the goods or services are different from reality?

4.1.10. Signs that reproduce, imitate or contain a protected designation of origin (literal j) article 135 DA 486).

Literal j) of article 135 of DA 486 establishes:

"Article 135.- Signs that:

(...)

j) reproduce, imitate or contain a protected designation of origin for the same products or for different products, when their use could cause a risk of confusion or association with the designation; or implies an unfair use of their notability;"

In accordance with what is stated by the TJCA, "to invoke the aforementioned cause of unregistrability, it is required that the aforementioned designation of origin be previously protected, implying that it must be expressly declared or recognized by the competent authority of the member country or of any of the member countries of the Andean Community."

Thus, for this absolute prohibition to prosper, the following conditions must be met:

- That the sign reproduces, imitates or contains a designation of origin .
- That the designation of origin is protected.
- That the requested registration may cause a risk of confusion or association, with respect to the origin, provenance, qualities or characteristics of the products or an unfair use of the notability of the designation of origin.

Appellations of origin recognized within the CAN include, for example, Colombian Coffee. Appellations of origin outside the CAN may obtain protection directly in the Member Country, also through bilateral agreements with other States or trading partners or through international treaties. .

Considerations to determine if the sign overcomes this prohibition:

- Is the designation of origin duly protected in the Member Country where the registration application is being analyzed?
- Does the sign reproduce, imitate or contain a designation of origin protected by the competent authority of a Member Country?
- Are the products that the sign intends to distinguish the same ones that distinguish the designation of origin or are they different?
- Could there be a risk of confusion?
- Can there be a risk of association?
- Is there a possibility that the use of the sign could lead to an unfair use of the notability of the protected designation of origin?

The SENAPI, in Bolivia, denied the registration of the following combined sign, requested to identify products of class 31 (Agricultural, horticultural, forestry and grain products, not included in other classes; live animals; fresh fruits and vegetables; seeds, plants and natural flowers; animal feed; malt), considering that it is similar to the designation of origin QUINOA REAL DEL ALTIPLANO SUR of Bolivia, which distinguishes Quinoa, a product that is included in those intended to identify the requested sign. .



In Ecuador, SENADI denied the registration of the name DIVINO CAFE DE LOJA, requested to identify products in class 30, considering that the sign reproduces the designation of origin CAFÉ DE LOJA, which distinguishes "coffee" .

INDECOPI, for its part, considered the combined sign MACPICHU as unregistrable, requested to identify products in class 30, including coffee, tea, cocoa and coffee substitutes. :

MACPICHU

The office considered that the requested sign partly contains the designation of origin

COFFEE MACHU PICCHU - HUADQUIÑA, which distinguishes green coffee beans, class 30, whose owner is the Peruvian State.

In Colombia, the SIC denied registration of the word mark PARMESSANO, requested to distinguish services in class 43 (restaurant, personal food, catering, among others), under the argument that *"the requested sign is likely to generate confusion in the market, with respect to the designation of origin "PARMIGIANO REGGIANO", as it includes within the trademark set the expression "PARMESSANO", which, although it is not identical to the designation of origin in its writing, it is clear that its translation from Italian is be precisely "PARMESAN CHEESE", so the requested sign directly evokes to the average consumer the idea of the designation of origin without a doubt"*.

4.1.11. Signs containing a protected designation of origin for wines or spirit drinks (literal k) article 135 DA 486).

Literal k) of article 135 of DA 486 provides:

"Article 135.- Signs that:

(...)

k) contain a protected designation of origin for wines and spirits;"

As can be seen, this prohibition does not have a conditioning analysis as is the case with literal j) of article 135, that is, the sign proposed for registration will be denied simply because it contains a protected designation of origin for wines and spirits.

This type of appellation of origin enjoys enhanced protection that constitutes an exception to the principle of specialty, provided that such appellation of origin is protected in the Member Country either directly in each country or by bilateral or multilateral treaties.

In effect, this cause of unregistrability provides greater protection to the designations of origin that are applicable to wines and spirits. . To that extent, for example, the expression RIOJA POR SIEMPRE could not be registered to distinguish television program production services, corresponding to class 41.

The above, since RIOJA is a protected designation of origin that distinguishes wines, which is sufficient to deny the sign proposed for registration, even if The requested sign is intended to identify services that are not related to the protected designation of origin.

In the same sense, the name HAPPY PISCO for products in class 25 (clothing) would be subject to this absolute prohibition since it contains the well-known PISCO designation of origin that is protected by the Member Countries and therefore is not registrable.

Considerations to determine if the sign overcomes this prohibition:

- Does the trademark reproduce or contain the designation of origin for wines and spirits?
- Is the designation of origin for wines and spirits duly protected in the member country where the registration application is being analyzed?

In Bolivia, SENAPI denied the registration of the name SINGANI DEL CARAJÓ, to identify products in class 33 (alcoholic beverages), since this “refers to the national designation of origin declared by Law No. 1334 on Denominations of Origin, dated May 4, 1992 in Bolivia, therefore, the requested sign cannot be granted for referring to a protected designation of origin, in addition to containing additional terms that incur the cause contained in the lit. p) of Art. 135 of D. 486 of the CAN” .



INDECOPI, for its part, based on this absolute prohibition, denied registration of the combined sign requested to identify lighting devices and electric flashlights on hand (class 11):

In the office's opinion, the relevant element of the requested sign contains the designation of origin TOKAY. Although TOKAI and TOKAY differ in their last letters (I / Y), when pronounced they make an identical sound.

4.1.12. Signs that consist of a national or foreign geographical indication (literal 1) article 135 DA 486).

Literal 1) of article 135 of DA 486 establishes:

"Article 135.- Those signs may not be registered as marks that:
(...)

1) consist of a national or foreign geographical indication liable to cause confusion with regard to the goods or services to which it applies;"

It is important to note that DA 486 does not establish a definition for geographical indications, to understand this prohibition we must refer to Article 22 of the TRIPS which defines geographical indications as:

"Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin."

Based on this definition, we understand that the prohibitions established in paragraphs j) (appellations of origin) and k) (appellations of origin for spirits) are exclusive for appellations of origin, while the present case applies to all those geographical indications that fall within the concept established by TRIPS.

Thus, when a sign consists of a geographical indication, whether national or foreign, and there may be a risk of confusion with respect to the goods or services to which it applies, registration must be denied. For example:

TUSCANY

Class 29: Edible oils

This sign consists of the Italian geographical indication that identifies olive oil. This is a case where the request must be denied, provided that the indication is protected in the Member

Country where its protection is invoked.

Considerations to determine if the sign overcomes this prohibition:

- Does the requested sign consist of a national or foreign geographical indication duly protected in the Member Country where the registration application is being analyzed?
- Can the registration of the requested sign cause confusion for the consumer?

4.1.13. Signs that reproduce or imitate coats of arms, flags, emblems, official signs of control and guarantee of the States, emblems, acronyms or names of international intergovernmental organizations (literal m) article 135 DA 486).

Literal m) of article 135 of DA 486 establishes:

"Article 135.- Signs that: (...) may not be registered as trademarks

m) reproduce or imitate, without permission from the competent authorities, either as trademarks or as elements of the aforementioned trademarks, the coats of arms, flags, emblems, signs and official control and guarantee hallmarks of the States and any imitation from the heraldic point of view, as well as the coats of arms, flags and other emblems, acronyms or names of any international organization;"

This legal precept comes from the compliance that the CAN Member Countries must give to Article 6 ter of the Paris Convention, to which they are all parties.

The purpose of Article 6 ter is to prevent the registration or use as trademarks, or as elements of trademarks, without the authorization of the competent authority: coats of arms, flags, official signs or hallmarks of control and guarantee adopted by the States, as well as flags, emblems, names and acronyms of international intergovernmental organizations of which one or more States party to the Paris Convention are members. Article 6 ter does not create a trademark right, or any other type of intellectual property right on the signs covered by this provision. .

The protection conferred on official control and guarantee signs or hallmarks is more limited than the protection conferred on State emblems. Article 6 ter .2) provides that, in the case of official

signs of control and guarantee, the provision "shall apply only in cases where the trademarks containing them are intended to be used on merchandise of the same or similar kind."

For the application of Article 6ter, the party requesting it must communicate, through the International Bureau of WIPO, the sign or signs concerned to the parties bound to apply the said Article (i.e., States party to the Paris Convention and members of the World Trade Organization (WTO) which are not party to the said Convention). This is done by means of a request for communication transmitted to the International Bureau, which then communicates the signs concerned, in the form of a semi-annual electronic publication in the "Article 6ter Express" database on the WIPO website. The communication of flags of States is not compulsory, although States may request it, if they so wish.

The Member Countries of the CAN have communicated, among others, the following signs under Article 6 ter of the Paris Convention:



Peru as official punch



Coat of arms of Ecuador

The TJCA has indicated that the reason for this prohibition is to "... avoid the abusive use of such official signs with the intention of simulating sponsorship on the part of the State or Organization in question or claiming an alleged origin of the product."

In that sense, the TJCA also pointed out that this prohibition is not entirely absolute, since if the corresponding authorization is obtained, the applicant could obtain the registration of a trademark.

Considerations to determine if the sign overcomes this prohibition:

- Only applies if the coats of arms, flags, emblems, signs and official control and guarantee marks identify a State or an international intergovernmental organization.
- The sign will be denied for the simple fact of imitating or reproducing these signs that correspond to a State or an international intergovernmental organization.
- If the applicant has authorization from the competent authority of the State or the international intergovernmental organization, the sign is registrable.

In Colombia, for example, the SIC denied the registration of the combined sign LA TORTA ITALIANA 1990 :



The SIC pointed out that in this case *"it is evident that the requested graphic includes an arbitrary combination of three shades that confuse the consumer into thinking that it is the flag of Italy. Notwithstanding the above, although the Directorate did not refer to the requested nominative element, the figurative element constitutes a reproduction of a protected flag that cannot be used by businessmen without authorization. Upon verifying the documents in the file of reference, no title can be found by which the Italian State has granted authorization for the use of this official symbol within the trademark, which implies the denial of this"*.

INDECOPI, in turn, denied the registration of the combined sign SWISSDESIGN, to identify products of class 18, by showing that the requested sign includes the image of the coat of arms of Switzerland and that, in the present case, the consent of the competent

authority of Switzerland :



4.1.14. Signs that reproduce or imitate signs in accordance with technical standards (literal n) article 135 DA 486) .

Literal n) of article 135 of DA 486 provides:

"Article 135.- Signs that:

(...)

n) reproduce or imitate signs denoting conformity with technical standards, except where the registration thereof is applied for by the national body responsible for standards and quality requirements in member countries;"

Technical standards are rules and criteria created by consensus by specialists, with the approval of a recognized body to establish standards or minimum conditions that a product, process or service must meet, in order for it to serve the use for which it is intended.

To identify themselves, the standards are made up of certain signs that are recognized depending on the industry or line of business where they carry out their activities, to give some examples of international technical standards:

ISO (International Organization for Standardization)

ISBN (International Standard Book Number)

MPEG2 (Moving Picture Expert Group)

This prohibition does not determine whether the sign requested for registration must be related to the goods or services that are intended to be distinguished, which means that if a trademark is presented that reproduces or imitates signs related to a technical standard for any type of goods or services, it must be denied if the applicant is not the body that administers the technical standard.

Now, it must be taken into account that, in accordance with the

provisions of the Andean standard, this registration prohibition does not apply if the person requesting it is the national body competent in standards and qualities in the Member Countries.

Considerations to determine if the sign overcomes this prohibition:

- Does the requested sign reproduce or imitate a sign in accordance with a technical standard?
- This prohibition applies regardless of the goods or services that the requested sign is intended to identify.

4.1.15. Signs that reproduce, imitate or include the denomination of a plant variety (literal o) article 135 DA 486) .

Literal o) of article 135 of DA 486 provides:

"Article 135.- Signs that:

(...)

o) reproduce, imitate or include the denomination of a plant variety protected in a member country or abroad, if the sign is intended for goods or services related to that variety, or"

The plant variety, in accordance with article 3 of Decision 345, Common Regime for the Protection of the Rights of Breeders of Plant Varieties (DA 345) is defined as:

"Article 3. - For the purposes of this Decision, the following definitions will be adopted:

(...)

VARIETY: Set of cultivated botanical individuals that are distinguished by certain morphological, physiological, cytological, chemical characters, which can be perpetuated by reproduction, multiplication or propagation.

Now, in order to be identified, plant varieties must have, among other requirements, a generic denomination that is linguistically acceptable, that differs from other granted denominations, in the case of similar varieties, and in this case it must be different from existing registered trademarks.

Those denominations that identify a plant variety and that must be protected are those that cannot be registered as trademarks, as established in literal o) just cited.

As can be seen from this legal provision, not only is the identity of the denomination of the plant variety unregistrable, it also indicates that imitations, inclusions or reproductions of said denomination must be denied, provided that the goods or services that are to be distinguished with that proposal sign for registration are related to the plant variety or may cause confusion. For example, the expression ECU-01 would not be registrable as a trademark to distinguish products in class 31 (unprocessed fruits and vegetables).

This proposal for registration would be denied because it meets the two assumptions established in this case (i) it reproduces a protected name in Ecuador to identify a variety of sugar cane and (ii) the products it tries to distinguish are intended to protect the same ones that distinguishes the name from the plant variety, since sugar cane is an agricultural fruit.

It is important to mention that this cause extends beyond the Andean territory, since the prohibition of registration is not only limited to denominations of plant varieties protected in any Member Country, but also those protected abroad, this means that if the intention is to register as a trademark a denomination of a plant variety protected only in Argentina, for example, it will be enough to deny it, without verifying that it is protected in the Member Country. where the trademark registrability study is carried out.

Considerations to determine if the sign overcomes this prohibition:

- Does the sign reproduce, imitate or include a name of a plant variety?
- Is the name of the plant variety closely related to the products that the sign is intended to distinguish?
- Is the name of the plant variety protected in any Member Country?
- Is the name of the plant variety protected abroad?
- It is suggested to check the PLUTO database whether the name of the plant variety is recognized as such.

For example, INDECOPI, based on this absolute prohibition, denied the registration of the MISIL sign, to identify agricultural and horticultural products of class 31, by showing that the requested sign includes in its composition the name that corresponds to a plant variety, namely, MISSILE .

4.1.16. Signs contrary to the law, morality, public order or good customs (literal p) article 135 DA 486).

Literal p) of article 135 of DA 486 provides:

"Article 135.- Signs that:

(...)

p) are contrary to law, morality, public policy or proper practice.;"

To understand which signs may be contrary to the law, morality, public order or good customs, it is important to define these four concepts.

Firstly, in relation to the law, the TJCA stated: "the concept of law is restricted to that which is supported by the general interest and protects fundamental values for society. For this reason, it acquires the character of imperative and cannot be ignored by agreements based on the autonomy of private will."

For its part, morality, according to the dictionary of the RAE means "pertaining or relating to the actions of people, from the point of view of their actions in relation to good or evil and in terms of their individual and, above all, collective life."

In relation to the concept of public order, the writer Fernández-Novoa considers that it is "the set of legal, political, moral and economic principles that are absolutely obligatory for the conservation of social order in a town and at a given time."

For example:



Class 25. Costumes.

Needless to say, this graphic sign cannot be susceptible to registration given its immediate perception as a Nazi symbol, which, although it may have positive meanings derived from its origin before Nazism, at this time the collective understands it as an image intolerable to the general interest when generate, at a

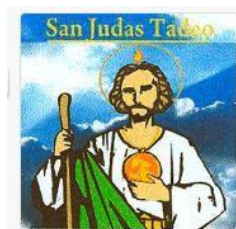
minimum, an apology for violence and disturb public order.

Some signs that in their meaning denigrate or are derogatory or pejorative for the majority, go against morals and good manners, such as HIJO DE PUTA, which, although it may be a word of average use in a territory, it is still offensive and high-flown.

Considerations to determine if the sign overcomes this prohibition:

- Does the sign have a pejorative, denigrating or offensive connotation?
- Can the sign be considered at first glance as an apology for violence or a crime?
- It must be considered whether the sign at the time of study has a connotation that goes against the law, morality, public order or good customs.
- Although this type of prohibitions has a subjective connotation, the analysis to determine its registrability must be objective and based on the general interest.

Based on this absolute prohibition, SENAPI, for example, denied the registration of the following combined sign to identify entertainment services (class 41) :



In the opinion of SENAPI, "seeking to register "SAN JUDAS TADEO" is within the cause of unregistrability (...) , because it is impossible to register as a trademark a name whose meaning is within Catholicism, so Its registration affects public morality within the religious currents of each era, especially when what is intended to be protected with said meaning are entertainment services, as well as services intended to entertain or amuse.

Therefore, the sign requested for registration does not have sufficient " intrinsic " distinctiveness to obtain registration, so a natural person cannot obtain exclusivity rights over this name since the requested sign is typical of the Catholic religion".

The SIC, for its part, in application of this cause, denied the registration of the combined sign LA MIERDA DE VACA.COM CON AGUA Y MIERDA NO HAY COSECHA QUE SE PIERDA, which was intended to distinguish medical services, veterinary services and agricultural services, included in class 44 :



In the concept of the SIC, "as can be seen, the expression SHIT is too strong, aggressive, coarse and ordinary, which is why its use within our normal lexicon is frowned upon, as it denotes disrespect towards the interlocutor. In fact, this office considers that the request under analysis is contrary to good customs and the morality that prevails in our country."

The SENADI denied the registration of the sign PORNO NARCO MUSICA plus logo, requested to identify services of class 41. In the office's consideration: ""Once the examination of registrability has been carried out, it is concluded that the requested denomination is subject to the prohibition of registration as set forth in Article 135, paragraph p) of Decision 486, which states "Signs that are contrary to the law, morality, public order or good customs may not be registered as trademarks; in accordance with Article r) of the Organic Code of the Social Economy of Knowledge, Creativity and Innovation".



INDECOPI, in turn, denied the registration of the combined sign CRACK, requested to identify products in class 5 (pharmaceutical products; fungicides, herbicides, pesticides; insecticides) :



According to what was stated by the office, the requested sign falls

within the reason for unregistrability analyzed, since it refers to a cocaine-based drug.

4.1.17. Signs that are identical or similar to a country trademark protected by the CAN (article 15 of DA 876).

DA 876 defines the country trademark as follows:

"Article 3. A country trademark constitutes any sign designated or used by a Member Country to promote its image inside and outside the country, and to promote, among others, tourism, culture, gastronomy, national production, exports or Country investments Member."

In the same Andean legal system, it was established that a sign that is identical or similar to a country trademark protected in accordance with that may not be registered as a trademark. In this regard, the provision states:

"Article 15.- The competent national office will deny, ex officio or at the request of a party, the registration of any distinctive sign that is identical or similar to a country trademark protected in accordance with this Decision.

Each Member Country shall arrange for its competent national office to consult the country marks communicated within the framework of this Decision and to take them into account when making decisions on the registration of distinctive signs, in accordance with its internal procedure. This provision will not apply when the registration of the distinctive sign is requested by the owner himself or by whoever exercises the rights of the country trademark, or any expressly authorized person."

In this sense, it is an obligation to provide protection to country trademarks, in accordance with DA 876.

The Member Countries of the CAN have the following country trademarks:



4.1.18. Exception to some absolute prohibitions: supervening distinctiveness (last paragraph of article 135 of DA 486).

Even when the signs lack distinctiveness, are descriptive, are the generic or technical name, constitute the usual designation of the goods or services to be distinguished, or consist of a color considered in isolation that is not delimited by a specific shape, DA 486 , in the last paragraph of article 135, establishes that they can be registered as a trademark, provided that they have acquired distinctiveness in commerce through use.

The TJCA has recognized that a sign that falls within the prohibitive assumptions of article 135 of DA 486, particularly paragraphs b), e), f), g) and h), can access registration as a trademark, if due to use constant, real and effective in commerce has acquired distinctive ability with respect to the goods or services to which it applies: "In other words, signs that initially did not have the ability to individualize goods or services can be subsequently protected by the distinctive character that they acquire for its use as a trademark".

The acquired distinctiveness may be claimed as long as the applicant manages to prove, through evidence, the constant, real and effective use of the sign for a recurring period of time and that the consumer remembers that sign as a trademark, attributing that trademark to the same business origin.

Considerations for the recognition of acquired distinctiveness:

- Given that DA 486 does not establish a period for the applicant to present the means of proof to prove the acquired distinctiveness, it is understood that they can do so at any stage of the trademark registrability procedure.
- The applicant must prove that the use of the trademark has generated its memory in the consumer.
- It is important not to confuse the time to present the evidence with the periodicity of the facts that prove the use, since these must be prior to the date of presentation of the application.
- The analysis for the tests must study the quantity of goods or services that have been made available to consumers according to the nature of said goods or services, for example, if the sign distinguishes clothing, a few articles of clothing in A warehouse will not be enough to prove use, since these products are

naturally mass-sold.

- On the other hand, the quantity of goods or services that are entered into the market must also be taken into account in accordance with the commercial practices of the goods or services, since, for example, the sale of airplane engines cannot be compared with the sale of automobiles, that is, although the volume of engines put on the market is small, the real and effective use can be accredited because the marketing mechanisms of these products do not require massive sales. .

In relation to the analysis of acquired distinctiveness, the TJCA has indicated that *"aspects such as the degree of distinctiveness of the sign in relation to the products it intends to protect, the relevant market, the ability of the average consumer to identify the origin must be taken into account. business of the corresponding product or, if applicable, the degree of attention of the relevant consumer public."* .

Thus, for example, the INDECOPI Distinctive Signs Directorate initially denied the registration of the following three-dimensional trademark :



The office considered that this sign is subject to the registration prohibition established in literal b) of Article 135 of DA 486. However, through an appeal for reconsideration, the applicant presented evidence alleging that the aforementioned sign had acquired distinctiveness.

In this regard, after analyzing the evidence, the Directorate of Distinctive Signs considered that the evidence presented shows that the appellant developed, marketed and promoted in Peru, mainly footwear identified with the design that makes up the requested sign, prior to the view request. Likewise, according to the statements contained in the market study provided by the appellant, the aforementioned design is associated by consumers as

corresponding to a specific business origin.

Among the cases in which the offices of the Member Countries have rejected the claim to declare that a requested sign has acquired distinctiveness, we find the following:

The SENAPI, when deciding on the invalidity of the registration of the mixed sign SUPER NACHOS, to distinguish products in class 30 (cereal-based snacks -corn-), stated the following regarding acquired distinctiveness: *"According to the above, it is evident that the acquired distinctiveness is an exception to paragraphs b), e), f), g) and h) of art. 135 of Decision 486 of the CAN, referring exactly to the intrinsic distinctiveness of a sign, which is the aptitude of the sign to identify and individualize the products without being confused with it or with its intrinsic properties or characteristics in relation to the products to be distinguished within the absolute prohibitions established in Article 135 of Decision 486, but not to the extrinsic distinctiveness of the mark. To this effect, it should be noted that the trademark **"SUPER NACHOS"** which protects within international class 30: "Cereal based snacks (corn)", is composed by a laudatory expression, due to the fact that the term **"SUPER"** gives to the possible consumers a qualitative relief of the products, praising the product, and **"NACHOS"** is a generic term of the protected product, therefore, since it has not complied with the necessary tests to consider acquired distinctiveness, it cannot be appropriated by any firm of the category".*

The SIC, on the other hand, when deciding on the application for registration of the mixed sign COMERCIALIZADORA LA MEJOR to distinguish services that are part of class 39 (National and international transportation; transportation and distribution of goods; transportation, packaging and storage of goods; transportation and distribution [distribution] of goods), stated that *"upon observing the annexes of the brief filed by the applicant, which are limited to the demonstration of some sales invoices of two specific years, it is possible to infer that they are not effective to demonstrate that consumers interacting with the expression COMERCIALIZADORA LA MEJOR give it sufficient distinctiveness within the market.*

In this order of ideas, the appellant here failed to demonstrate the degree of knowledge of the service mark of a business effort led inexorably to the determination of a second meaning of the sign in national territory or in the member countries of the Andean Community, a reason that supports the inadmissibility of its recognition.”

4.2. Relative prohibitions.

Article 136 of DA 486 contemplates relative prohibitions that focus on avoiding the impact of third-party rights.

Several of the causes of relative unregistrability established in the aforementioned standard are based on the identity or similarity between the requested sign and the trademarks or other distinctive signs of third parties and the fact that a risk of confusion or association is generated in the consuming public. .

Therefore, it is necessary to present in a preliminary manner, before addressing each of the relative prohibitions, the following topics: (i) the risk of confusion and association; (ii) the criteria to determine the similarity between the confronted signs; (iii) the general rules of comparison or comparison; (iv) the particular rules for carrying out the comparison between the signs in conflict, taking into account the different types of distinctive signs that were presented in the first part of this Manual; and (v) the criteria to determine the existence of a link between the goods and services that identify the signs in question.

4.2.1. Preliminary aspects.

4.2.1.1. The risk of confusion or association in the consuming public.

The TJCA, in the Preliminary Interpretation rulings issued in processes 145-IP2022, 350-IP-2022 and 391-IP-2022, all dated March 13, 2023, through which it declared that the rule contained in the literal a) of article 136 of DA 486 constitutes a clarified act, reiterated the following in relation to the risks of confusion and association:

“ a) The risk of confusion may be direct or indirect:

The direct risk of confusion is characterized by the possibility

that the consumer, when purchasing a specific product or service, believes that he or she is purchasing a different one.

The indirect risk of confusion arises when the consumer attributes to a product or service, contrary to the reality of the facts, a business origin different from the one it actually has.

b) the risk of association consists of the possibility that the consumer, in spite of differentiating the signs in conflict and the business origin of the product or service, when acquiring it, may think that the producer of said product or the provider of the respective service has a relationship with or is related to the producer or provider of the respective service.

According to the above, there is a risk of confusion when the consumer may be misled in the choice of the product or service, either because he is purchasing a product or service different from the one he really believes he is buying or contracting or because he mistakenly believes , that the product or service you want to acquire has a certain business origin.

On the other hand, the risk of association arises when, despite there being no link or competitive connection between the products and/or services that identify the signs in conflict, the consumer considers that some type of relationship exists between the owners of the signs commercial or economic link, which in any way leads you to wrongly choose a product or service based on the quality, prestige or recognition of any quality that you attribute to the competitor.

The above results in a demerit to the owner of the previously acquired rights, since in any way he loses either his clientele or his prestige if the quality of the competitor with whom he is associated does not offer the same standards in his goods or services or in his customer service, this possibility of association being a fact that the authority seeks to avoid, thus taking care of both the holder of a prior right and the consumer public.

However, for the purposes of determining whether there is a risk of confusion or association, the examiner must establish whether there is identity or similarity between the signs in conflict and whether

there is a competitive connection between the goods or services that the signs identify. It should be noted that the national offices can autonomously establish the order in which these two analyzes are carried out within the registrability examination, since DA 486 does not indicate the obligation to carry them out following a specific order.

4.2.1.2. The identity or similarity between the confronted signs.

Types of similarity.

The assumption of identity between the signs in conflict arises when they are entirely coincident with respect to the elements that make them up.

Examples:

Registration		Application
THE COW		THE COW
Class 29	VS	Class 29
Cheeses		Yogurt

Registration		Application
DOVE		DOVE
Class 03	VS	Class 30
Chocolate		Shampoo

The above is applicable whether the marks are merely word marks or figurative, mixed or non-traditional marks. Generally, these are trademarks that present identical elements, and it is sufficient that only one of them is different, to consider that we are not dealing with an identity of signs, but with a similarity, in which case, this will be analyzed in accordance with the guidelines provided for this purpose.

In relation to similarity, in accordance with what was indicated by the TJCA in the referenced Preliminary Interpretations, the interpretive legal criteria that constitute a clarified act, indicate that the similarity between the signs in conflict can be:

" a) Orthographic: Refers to the similarity in the writing of the signs in conflict from the point of view of their composition; that is, taking into account, among others, the order or sequence of the letters, with special attention to the vowels, the length of the

word or words, the number of syllables, the common roots or endings of the signs in conflict, which may lead to a greater or lesser degree in making the risk of confusion more evident or obvious.

b) **Phonetics:** Refers to the similarity of the sounds of the letters, numbers, syllables or words that make up the signs in conflict. The determination of such similarity depends, among other elements, on the identity in the stressed syllable or the coincidence in the roots or endings of the words; However, the particularities of each case must also be taken into account, in order to determine if there is a real possibility of confusion between the signs confronted, among others, based on phonetic aspects.

c) **Conceptual or ideological:** It is configured between signs that evoke an identical and/or similar idea and/or value.

d) **Graphic or figurative:** Refers to the similarity of the graphic elements of the signs in conflict, taking into account the lines of the drawing, the object they represent or the concept they evoke”.

4.2.1.3. General rules for comparing conflicting signs.

- The comparison must be carried out without breaking down the elements that make them up, adhering to a joint analysis, considering the unity of its phonetic, orthographic, figurative and conceptual components. This is the joint comparison of the trademark.
- The comparison must be successive (one and then the other) and never simultaneously, since it must be done against the memory one has of the trademark in comparison, not against the trademark itself.
- The analysis must be comparative, emphasizing similarities and not differences, determining whether these similarities are capable of producing confusion and/or association.
- The examiner must place himself in the consumer's position and his degree of perception, according to the type of goods or services in question.
- Consider that the sign object of the request and/or the sign with which the comparison is carried out could correspond to one of the categories with greater or lesser distinctive force depending on the case. Thus, we can mention **evocative or suggestive signs** , which, as mentioned in the previous chapter, can evoke the nature of the goods or services to which the signs refer, as well as

certain characteristics of the product or service that distinguish them, which is why they are registrable. , but they are weak and their owners have to tolerate a higher degree of similarity to other registered trademarks. For example, DORMIUNDO to identify mattresses.

- We also have fantasy signs and arbitrary signs whose analysis must be more rigorous, since these signs have greater distinctiveness and there is a greater probability of a risk of confusion or association occurring.
- **Fantasy signs** are words created by their owner, a product of their imagination and that have no meaning of their own, for example GOOGLE to identify search engines, or ADIDAS, which is the result of the combination of some elements of the name and surname of its creator. , Adolf Dassler.

Regarding **fantasy signs** , the TJCA has stated the following:

" 5.3. Fantasy signs generally have a high degree of distinctiveness and, therefore, if they are registered, they have greater oppositional force in relation to identical or similar marks.

• For their part, **arbitrary signs** are those that have a known meaning, but there is no connection between their meaning and the nature, qualities and functions of the product or service that they are going to identify, for example the word APPLE (whose meaning is understood by the consumer public) to distinguish computers.

• In the comparative comparison it is possible that some of the signs confronted belong to a **family of trademarks** , because it contains a predominant element common to other signs of the same owner. In this case, the examiner will determine whether the trademark family invoked by the applicant has actually been configured, to subsequently analyze whether the presence of the common feature, which is not generic, descriptive or commonly used, is sufficient to rule out the risk of confusion. or association with a distinctive sign of ownership of a third party.

Likewise, if the previously registered sign, with which the requested sign is compared, belongs to a family of trademarks, the examiner will consider that "Given that the common dominant element acts as an indicator of belonging of the trademark to a family of

trademarks, it is "It is likely that the average consumer considers that the product or service where the aforementioned common element appears constitutes the subject of a trademark that belongs to a certain family of trademarks, so that the registration of that trademark, if it corresponds to a different owner, could lead to confusion".

For example, the signs MCDONALD'S, MCPOLLO, MCFLURRY, MCCOMBO, MCMUFFIN, MCNIFICA, MCCAFE would constitute a family of trademarks, where the predominant common element is MC, as long as it is exclusive to the owner of the trademarks.

- Now, it is important to differentiate the family of trademarks from **derived trademarks**, which are signs that are primarily made up of a distinctive trademark already registered, which is accompanied by other elements, which, being little distinctive or secondary, give the idea of being trademarks that derive from a main trademark, for example PARMALAT (main trademark), PARMALAT NUTRE +, PARMALAT ZYMIL, PARMALAT LATTE INTERO (derived trademark).

In the event that the sign requested for registration is a derived trademark, the examiner will analyze the new elements that make it up, that is, the accessory elements to the distinctive element that comes from the registered trademark and will take into account that, as indicated the TJCA, "the fact that a trademark registration holder applies for registration of a derived trademark does not mean that he or she has the indefeasible right to have said sign registered, since the competent authority must establish whether the new requested sign complies with all the registrability requirements and, furthermore, that it does not fall within the causes of unregistrability indicated in the community regulations."

4.2.1.4. Particular rules of comparison according to the nature of the signs in conflict.

Now we will go into detail with the comparison criteria between signs of the same or different nature.

A. Comparison between exclusively denominative signs.

The examiner must take into account the following considerations to determine whether a word sign generates a similarity with other word signs:

- Carry out a comprehensive analysis, as a whole, without breaking down the orthographic or phonetic unit of the signs, taking into account the letters, numbers, syllables or differentiating words.
- Determine the relevant element, as it denotes how the sign could be perceived in the market.
- Consider if they share lexeme (base and element that does not change within the word and whose meaning is found in the dictionary)

Example: **deport** in: **deporte / deportivo / deportista / deportólogo.**

If they share a lexeme, it should be taken into account that, generally, the lexeme is the element that has the most impact on the consumer's mind and that the coincidence could generate ideological confusion; However, the ideological criterion must be complemented with others to determine the risk of confusion or association.

- Consider the morphemes, which are those that modify and provide meaning and definition:

Example: **deporte / deportivo / deportista**

- Locate the stressed syllable of the signs, because if it occupies the same position and is identical, it can set the tone for a similarity.
- Take into account the order of the vowels because, if they present the same order, it will be relevant to the sound of the name.

It should be noted that denominative signs can be composite in nature, that is, made up of two or more elements, necessarily denominative. Regarding compound signs, the TJCA has stated:

"... in the event of requesting registration as a trademark of a composite sign, in which case its registrability must be judged, the relevance and distinctiveness of the words that make it up must be especially examined. There are words that give the sign sufficient semantic load to allow particularizing effectiveness that leads to identifying the business origin (...)."

In relation to compound denominative signs, to determine the similarity in this type of signs, it is important to take into account each of the words that make them up and the degree of relevance of these in the sign.

The criteria for carrying out the risk of confusion or association study are the following:

- Location of the words in the denominative sign, being the first one that generates the most recall.
- Impact on the consumer's mind according to the length of the words, with shorter words having a greater impact.
- Impact according to the sound of the words, the stronger the sound, the greater the impact on the consumer's mind.
- Analyze whether the words are evocative and the strength of their proximity to the goods or services to which they refer.
- Analyze whether the words are generic, descriptive or commonly used, which would lead to their exclusion in the comparison.
- Analyze the degree of distinctiveness of the words compared to other signs already registered. The TJCA points out that "If the word that makes up the sign is a well-known trademark, it will have greater relevance. If the word that makes up a sign is the stable element of a derived trademark or is the element that makes up a family of trademarks, it will have greater relevance. Any other situation that gives it greater distinctiveness must be analyzed to, in this way, determine its relevance in the whole."

B. Comparison between combined signs.

In relation to the analysis between combined signs, it must be determined which element penetrates most deeply into the consumer's mind (relevant element), which may be the word, the figurative or even both.

In relation to the protection of the combined trademark, the TJCA also indicated the following:

" It is important to highlight that the combined trademark is a unit, for which registration has been requested, which includes all the word and graphic elements that make it up. When the registration of a combined trademark is granted, it is protected comprehensively and not its elements separately."

a) Combined signs where the denominative element is the relevant one.

In this case the examiner must apply the rules indicated in section A above, on comparison of word signs.

Example:

Signo solicitado ~	Marca Registrada
	

This is an example where the word element is the most relevant and although they contain different spellings and the registered sign adds a graphic element, it is clear that there is similarity between the confronted signs.

b) Combined signs where the graphic element is the relevant one²⁴⁸

First of all, it should be noted that as the TJCA has indicated, three elements can be distinguished in a graph or image:

- The layout is the lines of the drawing that form the sign.
- The concept is the idea that the graphic element raises in the mind of the person who observes it.
- The colors claimed in the application, which could generate greater differentiation capacity for the sign.

If the examiner notices that in the combined signs confronted the graphic element is the most relevant compared to the denominative element, he will apply the following considerations:

- Make a graphical as well as conceptual comparison, since not only the lines can be similar but also the idea or concept they generate in the consumer's mind.
- If colors are claimed, the combination of colors and the graphic that contains them must be taken into account, as this feature can be differentiating.

c) Combined signs where both verbal and graphic elements are relevant.

In Bolivia, for example, SENAPI denied the registration of the combined sign FIESTA, requested to identify products in class 30,

based on the previous registration of the following sign:

Signo solicitado	Signo opositor
	

For its part, INDECOPI denied the registration of the following combined sign, considering that, from a graphic point of view, the contrasting signs are similar by including the representation of a figure with similar lines, even though they have different denominations.

Signo solicitado	Marca registrada
	

C. Comparison between combined and figurative signs

In this case, the examiner must determine which is the relevant element in the combined mark, whether the word or the graphic or whether they are both. As the TJCA has clarified in the Preliminary Interpretations that have been cited, *"if the name causes greater impact, it is in the word or words where its distinctive force is focused and confusion cannot be generated with a figurative sign, since the distinctive of the first will be in the pronounceable set and that of the other in the image and the concept that the figurative sign expresses, unless they can give rise to the same idea or concept in which case they could incur the risk of confusion."*

In the event that the distinctive force falls on the graphic element, the examiner must take into consideration the three elements that make it up, that is, the layout, the concept and the claimed colors and apply the following comparison rules for figurative signs:

- Make a graphic and conceptual comparison, that is, also taking into account the idea that the figurative sign generates in the

mind of the person observing it.

- The conceptual part of the confronted figurative signs is the one that usually prevails. It is possible that there are differences in their features and yet together they generate the same idea or concept.
- If colors are claimed, the combination of colors and the graphic that contains them must be taken into account, as this feature can be differentiating

Example:

Signo solicitado	Marca registrada
	

Taking into account the previous parameters, a similarity can be established given the lines of the signs that are curved to the right, the conceptualization of the figures that both identify a sailboat or a ship's sail and that are found in black and white.

D. Comparison between combined and denominative signs.

It is important to take into account the integrity of the sign, since combined marks are formed as a unit between the words and the graphic element, which can lead to generating different concepts and not because both signs have the same element, it gives way to the existence of similarity.

It may be that the word element, in the majority of cases, is the most relevant and important in the sign, but it is also possible that the graphic element in a sign stands out and becomes the predominant element.

Therefore, when making the comparison, the examiner must identify which of the elements prevails in each sign and has more influence on the mind of the consumer and in the case of the graphic element it is estimated that there would be no confusion between the signs, unless both raise a same idea or concept, which may incur a risk of confusion.

E. Comparison between traditional and non-traditional trademarks.

As already indicated in relation to non-traditional trademarks, we have that, although some cannot be appreciated by the sense of sight, they can be perceptible by the other senses (smell, touch, taste and hearing), and, Therefore, they are susceptible to identification and differentiation. Thus, for the purposes of establishing the comparison rules when comparing a traditional trademark with a non-traditional one, the examiner must determine what type of non-traditional trademark is involved in the comparison.

In the case of three-dimensional, color or position marks, for example, given their visibility, the same rules that are described in the section on traditional signs can be applied, that is, identifying which of all the elements that make up The trademark is the one that predominates in the sign, without losing sight of the importance of the whole and based on this, contrast with other trademarks to determine if there is identity or similarity that ultimately leads us to determine the existence or not of the risk of confusion. and/or association.

For example, in the event that the contrasted signs correspond to a combined one versus a three-dimensional one, the TJCA has indicated that these comparison rules must be followed:

- a) A graphic and conceptual comparison must be made, since the possibility of confusion and/or association can be generated not only in the identity of the lines of the drawing or the shape of the body provided with volume but also in the idea or concept that the combined or three-dimensional sign arouses in the mind of whoever observes it.
- b) Among the elements of the sign, the conceptual or ideological part usually prevails, so although there may be differences in the features, strokes or colors, as a whole they can give rise to the same idea or concept and incur the risk of confusion. and/or association.
- c) Given that the denominative aspect of the combined sign can evoke an idea or concept, it must be verified whether the idea or concept of the three-dimensional sign is similar or not to the idea or concept evoked by the denominative part of the combined sign.
- d) If the requested sign claims specific colors as part of the graphic component, when carrying out the respective registrability analysis, the color combination and the graphic that contains it

must be taken into account, since this element could generate the ability to differentiate the sign. requested for registration.

e) Forms of common use and necessary in relation to the goods or services of the three-dimensional sign in conflict must be excluded from the comparison. However, if the exclusion of said elements reduces the three-dimensional sign in such a way that makes the comparison inoperative, the comparison must be carried out without decomposing the trademark set.

The comparison between three-dimensional and combined marks must be made based on the elements that provide distinctiveness in each case, such as shapes, reliefs, angles, the word element that comprises them, among others, to establish whether the signs in conflict are or are not confusing and, in this way, avoid error in the consumer public and the risk of confusion and/or association."

On the other hand, in the case of animated or motion marks, it is feasible to carry out a visual comparison, which analyzes both the word and figurative elements that contain the signs in conflict. For this purpose, the comparison rules presented in the previous section on traditional trademarks may be applied.

Likewise, the examiner may carry out a phonetic comparison of the signs in conflict, in the case where both or one of them is an animated or movement mark that contains word elements.

Regarding these animated or movement signs, thirdly, the examiner may also make a conceptual comparison, if a concept can be identified from the conflicting signs.

Now, in the event that the trademarks in conflict, or at least one of them, correspond to a non-traditional trademark that is not perceptible by sight, in principle, the comparison should focus on the phonetic and conceptual aspects since it will not be possible to make a visual comparison.

According to the above, for example, in the case of sound marks, the examiner could pay attention to the sound effect of the contrasting signs and from that determine whether there is phonetic similarity.

For these purposes, the examiner may take into consideration the

type of elements to be compared: if, for example, it is a sound mark that has a letter, or corresponds to a sound from nature (e.g., the roar of the lion) or that derives from a particular activity or situation (e.g., the sound of two effervescent tablets falling into a liquid), phonetic similarity will occur if they sound identical or similar; However, if the sound mark includes musical elements, that is, created by a composer, the comparison must analyze the similarities in the melody, and the similarity between the other pronounceable elements that the sign has may not be so relevant.

In addition to the phonetic comparison, in the event that both or one of the conflicting marks is sound, the examiner could also carry out a comparison of the conceptual aspect, if a concept can be identified from the elements of the sound mark.

Finally, in the event that the marks in dispute, or at least one of them, correspond to a tactile mark, the examiner could make a comparison of the conceptual aspect of the signs; For this purpose, you will be able to establish what is the concept that is generated in the mind of the public when perceiving, through touch, the surface of the product or its packaging or wrapping and, based on this, determine if this idea or concept leads you to consider that there is similarity with the other sign.

4.2.1.5. Criteria to determine the identity, similarity, linkage or competitive connection between goods or services.

As mentioned above, in addition to establishing whether there is identity or similarity between the conflicting signs, it is necessary to determine whether the mark that is the subject of the application seeks to distinguish the same or similar goods or services as those identified by the distinctive sign with respect to which there is identity or similarity.

The above, because between similar or identical signs there should be no identity between goods or services or with a link or competitive connection that makes the public assume, erroneously, that it is the same trademark or that there is some commercial relationship between its owners, which translates into harm both for the owner of the previous trademark and for the consuming public.

The TJCA has ruled on this issue and has stated the following:

"... the doctrine warns that "when the signs are identical or very similar, the greater the required differentiation between the goods or services to which they are applied must be. And conversely, that is, when the goods or services are identical or very similar, the greater the required differentiation between the opposing signs must be [...]."

Therefore, as a general rule to determine whether the trademark is susceptible to obtaining registration or not, the premise that must be met is to determine if there is identity or similarity compared to another previous trademark, previously registered or requested for registration, and if, compared to the same or the same, the goods or services are the same or there is such a link that is likely to generate risk of confusion or association.

The following criteria, determined by the TJCA, allow establishing whether there is a link or competitive connection between the goods or services that identify the signs in question.

A. Substantial criteria.

In general, the substantial criteria allow us to establish bases to determine whether in relation to the goods and services to which trademarks are directed, there is a competitive link or connection, and it is important to note that compliance with any of these substantial criteria will be sufficient to determine the linkage or competitive connection.

The criteria have been defined and are included in Prejudicial Interpretations issued by the TJCA.

a) Substitutability.

Also called the concept of interchangeability, substitutability refers to the fact that goods or services are reasonable substitutes for the consumer, who could choose to choose between one or the other without problem. Normally the criteria that determine this possible substitution take into account the characteristics, the distribution or sales channels and, particularly, the purpose, since these elements allow the public to choose between one or the other, fulfilling the same purposes or achieving the same results.

Example:

- Sugar and artificial sweeteners.
- Electric razors and manual shaving devices.

b) Complementarity.

It allows connection to be assumed when, when acquiring a product or service, the need may arise to acquire another one with which it is complemented, that is, the use of one implies or may require the use of the other.

Example:

- Toothpaste (class 3) with toothbrush and dental floss (class 21).
- Office printers (class 16) and toner or ink for printers and photocopiers (class 2).
- Electric coffee makers (class 11) and coffee capsules (class 30).
- Educational services (class 41) and teaching materials (class 16).
- Computers (class 9) and computer keyboards (class 9).

It is important to make clear that complementarity is not a synonym for "joint use."

Example:

- A series of products that make up an outfit does not necessarily mean that they are all complementary, thus a pair of pants (class 25) is not complementary to sunglasses (class 09).

c) Reasonableness.

This is the possibility of reasonably considering that the goods or services under analysis come from the same owner or have the same business origin. This connection arises when taking into consideration the reality of the market, that is, the context, in which it is reasonable to think that as part of commercial expansion and the need to compete in an increasingly global market, the same businessman can offer products whose relationship occurs or arises based on commercial practices at a given time.

Example:

- Construction company (class 37) and real estate company (class 36).

B. Auxiliary criteria.

By themselves, these criteria do not allow us to prove the existence

of competitive connection between goods and services. The auxiliary criteria are constituted as a means that, when analyzed together with those that have been considered intrinsic, or together with other auxiliary criteria, in the absence of any substantial criterion, are constituted as adjuvants to arrive reasonably and with greater logical elements. -legal to the conclusion of the existence of connection or relationship between goods or services.

Therefore, the determination of relatedness between products or services cannot be motivated on the basis of these auxiliary criteria in isolation. An investigation will have to be carried out in cases where the type of product or service is so specialized that it requires specialized or more relevant technical knowledge than that involved in an analysis of staple or generalized consumption products.

a) Belonging to the same class of the Nice Classification.

The TJCA considers that the inclusion of goods or services in the same class is not decisive for the purposes of establishing whether there is a competitive connection between the goods or services under analysis, as provided for in the second paragraph of article 151 of DA 486, and that the Placing products in different classes does not prove that they are different.

Although it is true that the Nice Classification is an international system used to classify goods and services for the purposes of trademark registration, facilitating the administrative work of industrial property offices around the world, and for this purpose it usually groups the different goods and services based on their species or type, this classification or grouping of products does not determine the logical and real relationship that, for the purposes of commercial purposes, is presented in the operational reality of commerce.

Example:

- Both ophthalmic lenses and chargers for electronic cigarettes belong to class 9. However, it is a criterion that by itself does not denote that there is a competitive connection. In addition, there is no substitutability, complementarity or reasonableness between the two products to assume that they have the same business origin.

b) Supply, distribution or marketing channels.

To understand what supply, distribution or marketing channels are, the definitions provided by the RAE on this terminology are useful:

- Provisioning: action and effect of provisioning, that is, supplying.
- Distribution: distribution of a product to the premises where it should be sold.
- Marketing: action and effect of marketing, that is, giving a product conditions and distribution channels for its sale.

From the above, we can understand that these channels include various points of sale, which are currently multiple and varied, from physical to digital.

The importance of this point lies in the fact that, commonly, competing goods or services are offered in the same points of sale, even located on the same shelves or gondolas.

However, we must not lose sight of the fact that in the same warehouse or store you can find products of different nature and functions, so it is not enough that they are offered to the public through the same point of sale to consider them to be linked products. . For example, a supermarket or convenience store offers deodorants, soft drinks, coffee, detergents and soaps, among other items and they are not necessarily related products.

c) Advertising media.

Advertising is a fundamental means for entrepreneurs, producers, merchants and suppliers to market their products or provide their services in an increasingly competitive environment.

Given the abundant competition that almost all commercial sectors present today, advertising guarantees that the public can, at least, consider their purchase or choice against the universe of possibilities that involves choosing between one product or service and another.

In relation to the possibility of considering this medium as an element through which a link can be established, it represents a problem when taking into account that today the means of advertising

a product or service vary significantly depending on the economic capacity, the technological knowledge and the type of product or service in question, so although it may be the case that goods or services are advertised through coincident channels, it does not necessarily imply that this in itself proves the relationship between them, hence it always has to be analyzed together with the substantial criteria.

Example:

- Automobiles (class 12) and leather suitcases (class 18) could be advertised in advertisements in a magazine specialized in automotive topics, without this fact allowing us to conclude, in itself, that there is a competitive connection between both products.

d) The technology used.

There are goods and services that can be related through the technology they use for their manufacturing, for example, virtual products such as electronic applications that, although they have different purposes, work with the same technology.

But there are also goods or services that, although the same technology is used, their purpose is so dissimilar that they cannot be related, for example, if the same technology is used for stadium lighting services for concerts, as that used for lighting services. specialized lighting for the construction of buildings; In this case, although both are lighting services for large spaces, in one case or the other the lighting is so specialized that even if the technology used coincides, this does not make the services coincident.

For the purposes of taking this point as a criterion that allows establishing competitive connection, we can affirm that it is undoubtedly constituted as a complex medium and that by itself it could not prove such connection or relationship, so, in the same way, it would always have to be analyzed in light of the substantive criteria.

e) The purpose or function.

It is logical to think that if the goods or services under analysis have the same purposes, or the same destination, in principle, it

suggests, not only that there is a relationship, but also that they are offered in the same points of sale and that, therefore, Without a doubt, these are competing goods or services, or at least closely related goods or services; However, not all products that have the same purpose are produced or manufactured using the same processes, nor do they require the same infrastructure or distribution or marketing channels, nor are they necessarily offered at the same points of sale, nor are they directed to the same consumer public.

This is the case of some food products, although it is true that all foods are aimed at satisfying dietary needs, not all serve the same purposes at the same time. For example, on the one hand, we can find foods consisting of seeds or grains, others consisting of fruits or vegetables, others of animal origin, others already prepared and ready for consumption and others such as ice cream, desserts in general, bakery products. . As can be seen, although it is true that they are all aimed at satisfying nutritional needs, they are all offered in different points of sale, even within the so-called supermarkets, they all also correspond to different classes and, above all, they allow, in principle, a clear differentiation from each other. However, it is possible to establish a link between one product and another if its analysis leads to the conclusion that substantial criteria apply.

f) The same type of goods or services.

As a general rule, since goods and services are classified into groups that allow them to be identified by their genus or type or species, this grouping implies a certain relationship.

However, it is important to define what is meant by gender. The RAE dictionary provides the following definition: Class or type to which people or things belong; in commerce, merchandise.

This classification can serve different purposes and objectives, so belonging to the same genus does not necessarily place the goods or services in a relationship between them, so then, as an example, we can consider that within the genus of "optical instruments" the Microscopes, glasses and telescopes serve different purposes and are offered at different points of sale.

Also, within the category of cleaning and disinfection products, we

find substantial differences in terms of destination, purpose and other characteristics, which is why, for example, fabric stain removal products and liquid dishwashing soaps are not similar.

g) The nature of the goods or services.

The nature of a product or service is defined as the virtue, quality or property of things. However, the identity of these elements is not conclusive on its own to determine whether there is a link or competitive connection between the goods or services that identify the confronted signs, which is why the concurrence of other factors or criteria is required to arrive at a conclusion that conclusion.

It is possible to return to the example of food products, since both the flower, the fruit and the vegetable are born from a seed, so we can affirm that they have the same nature. However, an onion is not intended for the same purposes as a flower, or a watermelon, hence the analysis should always be done jointly and in correlation with other criteria.

4.2.2. Signs identical or similar to other previous marks that may cause a risk of confusion or association (literal a) article 136 DA 486) .

To carry out an adequate analysis of this prohibition, the legal provision that expressly contemplates it is reproduced:

" Article 136.- Those signs whose use in commerce unduly affects a third party's right may not be registered as trademarks, particularly when:

a) are identical or similar to a trademark previously requested for registration or registered by a third party, for the same goods or services, or for goods or services with respect to which the use of the trademark may cause a risk of confusion or not. of association;"

To determine whether the assumption transcribed above applies to a specific case, the examiner must apply the rules indicated in the previous section, to establish whether the signs in conflict, that is, the one requested for registration and a previously registered or requested trademark, are identical or similar. For this purpose, then, the examiner must establish the type of marks faced and apply the corresponding comparison rules .

Additionally, in order to determine whether there is a competitive connection, the examiner must analyze whether some of the intrinsic criteria are applicable in the case under study, such as substitution, complementarity between goods and services and the possibility of considering that the goods or services come from the same businessman which were presented in section 4.2.1.5 of chapter 2 of this Manual.

It is worth saying that, for the purposes of applying this relative prohibition, both situations must occur, that is, the signs must be identical or similar and, in addition, there must be identity or connection between the goods or services that the requested sign identifies and those that it distinguishes. the registered or requested trademark.

In accordance with the above, the analysis of this cause is carried out in two steps, in one of which the examiner must establish that there is identity or similarity between the signs confronted and another in which it will be evaluated if there is identity or competitive connection between the goods or services that they distinguish.

Finally, it should be noted that national offices must analyze this cause of relative unregistrability informally, that is, the owner of the registered or previously applied for trademark is not required to present opposition to the registration of the sign under analysis.

4.2.3. Signs identical or similar to a protected trade name, or a trademark, that may cause risk of confusion or association (literal b) article 136 DA 486) .

Subparagraph b) of article 136 of DA 486 provides:

" Article 136.- Those signs whose use in commerce unduly affects a third party's right may not be registered as trademarks, particularly when:

(...)

b) are identical or similar to a protected trade name, or, if applicable, to a label or banner, provided that, given the circumstances, their use could give rise to a risk of confusion or association;"

As mentioned in section 4 of chapter 1 of this Manual, the commercial name is a distinctive sign that identifies the merchant as such, while the commercial banner or sign distinguishes a commercial establishment. It is important to remember that, in accordance with the provisions of the Andean legal system, the right to the exclusive use of these distinctive signs is only acquired through their first use in commerce and the right ends when their real and effective use ceases. In this regard, the TJCA has indicated that:

" Articles 191, 192 and 193 of Decision 486 establish the commercial name protection system. Article 191 grants the right to exclusive use of the trade name from its first use in commerce, use that must be proven and, consequently, this exclusive use ends when the real and effective use of the trade name ceases. For its part, Article 193 of Decision 486 specifies that the registration or deposit of the commercial name with the competent national office has a declarative nature; However, the right to exclusive use is only acquired by proving the constant, real and effective use of the trade name."

Taking into account that the legal precept established in literal b) of article 136 of DA 486 indicates that a sign that is identical or similar to a protected commercial name or logo will not be registrable as a trademark, it must be understood that the protection of the commercial name It is subject to its constant, real and effective use. In this regard, the TJCA points out:

" Whoever alleges the previous use of the trade name must prove by the procedural means available to national justice, either within the administrative stage or in the jurisdictional sphere 'that the name has been used previously (...). The simple allegation of use does not enable the owner of the trade name to assert its rights. The ease of determining use may come from a registration or deposit system that, while not being essential for protection, provides at least a principle of proof in favor of the user.'"

Once it has been established that the name or commercial trademark that is the basis of the opposition actually enjoys protection, the examiner must apply the rules indicated in sections 4.2.1.2., 4.2.1.3. and 4.2.1.4. of chapter 2 of this Manual, to establish,

first of all, whether the signs in conflict, that is, the one requested as a trademark and the commercial name or logo are identical or similar. For this purpose, then, the examiner must apply the corresponding comparison rules.

Additionally, the examiner must evaluate whether there is a competitive connection between the goods or services that the applied-for sign intends to identify and the commercial activity that identifies the name or trade name, since the ground under study indicates that the applied-for sign must be refused "whenever, given the circumstances, its use could give rise to a likelihood of confusion or association". For this purpose, it must be determined whether in the particular case some of the intrinsic criteria presented in section 4.2.1.5. of chapter 2 of this Manual are applicable, such as substitution, complementarity between the goods and services and reasonableness.

4.2.4. Signs identical or similar to a previous commercial slogan that may cause a risk of confusion or association (literal c) article 136 DA 486) .

Literal c) of article 136 of DA 486 establishes:

" Article 136.- Those signs whose use in commerce unduly affects a third party's right may not be registered as trademarks, particularly when:

(...)

c) are identical or similar to a requested or registered commercial slogan, provided that, given the circumstances, their use could give rise to a risk of confusion or association;"

By definition, the commercial slogan is a complementary figure of distinctive signs such as trademarks, which accompanies and reinforces the impact of the commercial advertising of the product or service to which they are linked, so in order to obtain its registration, it is always necessary It has the condition of indicating with which trademark it will be used, since it is distinctive and graphically representable.

This is what the TJCA has stated:

"In response to the accessory nature of the commercial slogan with respect to the trademark, the Court has indicated the following:

- When requesting the registration of a commercial slogan, the requested or registered trademark that will be advertised must be indicated (Article 176 of Decision 486).

- The commercial slogan must be distinctive and, therefore, cannot mislead the consuming public in the market. Therefore, the commercial slogan must be totally differentiated from the other protected distinctive signs, taking into account the covered and related products (Article 177 of Decision 486)."

4.2.5. Signs requested by a representative, distributor or expressly authorized person, by the owner of the protected sign in the Member Country or abroad (literal d) article 136 DA 486).

Subparagraph d) of article 136 of DA 486 provides:

" Article 136.- Those signs whose use in commerce unduly affects a third party's right may not be registered as trademarks, particularly when:

(...)

d) are identical or similar to a distinctive sign of a third party, provided that, given the circumstances, their use could give rise to a risk of confusion or association, when the applicant is or has been a representative, a distributor or a person expressly authorized by the owner of the protected sign in the Member Country or abroad;"

This cause of unregistrability applies when a sign has been protected in one of the Member Countries or abroad and the registration of an identical or similar sign is requested in its own name by the representative or distributor of the owner of the registered sign or by a person who has been expressly authorized to use the sign protected by the owner.

This relative prohibition seeks to avoid harm to trademark owners, providing them with the tools that allow them to defend their rights, that is, through opposition, which will always be able to assert, or failing that, the nullity of the registration that has been granted through this situation.

It is up to the owner of the right to take care of it, since for the national offices, it can be difficult to clarify who actually owns

this right and they will simply ensure that the sign complies with the requirements of the law and that it does not incur the causes of stipulated denial, so it is the responsibility of the right holder to assert the identity or similarity between the requested sign and his own, invoking the same risk of confusion analysis that has already been addressed, for which purpose he must previously prove through the corresponding legal channels (i) the existence of a commercial link with the trademark applicant, (ii) the ownership of the trademark.

The distinction must be made between representative, distributor or authorized person, with the following definitions offered by the TJCA:

- Representative: person who promotes and arranges the sale of products
- Distributor: in charge of distributing the products manufactured by a company, distributing a product or service to certain premises or people to whom it must be marketed.
- Authorized: the person who has been granted a license to use or franchise, which does not grant the right to obtain registration

The evidence that is normally used and accepted to demonstrate a previous link of the applicant who is or has been a representative, a distributor or a person expressly authorized by the owner of the protected sign in the Member Country or abroad are contracts, emails , statements from third parties, letters or communications between the trademark owner and the applicant, tax documents, advertising (which may also be from other countries), trademark registration certificates in other countries, the printing of web pages in which It can be seen that the applicant for the trademark is an authorized representative or distributor, and in general, everything that can prove this link.

4.2.6. Signs that affect the identity or prestige of legal entities with or without profit purposes or of natural persons (literal e) article 136 DA 486) .

Literal e) of article 136 of DA 486 establishes:

" Article 136.- Those signs whose use in commerce unduly affects a third party's right may not be registered as trademarks, particularly when:

(...)

e) consist of a sign that affects the identity or prestige of legal entities with or without profit purposes, or natural persons, especially in the case of the name, surname, signature, title, hypocoristic, pseudonym, image, portrait or caricature of a person other than the applicant or identified by the relevant sector of the public as a person other than the applicant, unless the consent of that person or, if he or she has died, that of those who were declared his heirs is proven;"

The Andean Charter for the Promotion and Protection of Human Rights establishes within its general principles that the Member Countries of the Andean Community recognize human rights as inherent to the nature and dignity of every person and recognize that all human rights must be enforceable and reaffirm their commitment to respect and ensure respect for human rights and fundamental freedoms enshrined in international instruments and national laws, and to adopt all necessary legal and administrative measures to prevent and investigate events that may constitute violations of the rights human rights, ensure the effectiveness of constitutional and judicial remedies, prosecute and punish those responsible for these and fully compensate the victims, in accordance with the law.

In this order of ideas, it is recognized that people have inherent rights, such as the right to have a name, surname, signature, title, respect and protection of their image, portrait or caricature without denigrating or reviling them.

Therefore, in terms of protection of distinctive signs, these rights are taken into account and the impossibility of registering as trademarks signs that affect the identity or prestige of natural persons or legal entities has been foreseen, resulting in protection being also provided by this via the companies, with their name or company name.

4.2.6.1. Signs that include name, surname, title, hypocorism or pseudonym of a person other than the applicant.

The first name, surname and pseudonym define the natural person in a company, so a third party cannot appropriate it as a trademark right, in such a way that it affects the identity or prestige of this person.

The RAE offers the following definitions, which are useful for the analysis of the cause under study:

- Name: a word that designates or identifies animate or inanimate beings.
- Surname: means family name with which people are distinguished.
- Title: means renown or distinctiveness with which someone is known for their qualities or actions.
- Hypocoristic: said of a name: which, in an abbreviated or infantile diminutive form, is used as an affectionate, familiar or euphemistic designation.
- Pseudonym: name used by an artist in their activities, instead of their own.

It is necessary to introduce the concept of the right to the image, defined by the same source, as the set of features that characterize a person or entity; In that order of ideas, said traits must be respected and not ridiculed or humorously exploited to the extent that they affect the identity or prestige of the person in question or from whom those traits have been taken. These features, to be considered non-registrable, must leave no room for doubt as to who they refer to or represent, unless there is the express consent of the person whose image is intended to be registered or their heirs.

Likewise, personal names, surnames, pseudonyms and hypocorisms of people can be registered as trademarks. To do this, they require compliance with certain basic parameters, as indicated by the TJCA:

- Make it distinctive.
- That its use in the market does not generate risk of confusion or association in the consumer and,
- That it does not affect the identity or prestige of natural persons other than the owner, unless there is the consent of that person or his or her heirs.

It is logical to think that the offices cannot be aware of the names, pseudonyms or hypocorisms that are presented to the offices and determine whether correspond or coincide with the applicant; In such cases, people who believe that their right is violated by a trademark application may object; However, in the case of names or pseudonyms of people who enjoy recognition or fame, the authority may, ex officio, invoke this cause of impediment and deny registration if the consent of the person who holds the name or

pseudonym is not available or, of his heirs.

Example:



Clase 25. Vestidos, botas, zapatos.

This trademark was presented by a person other than the singer with the stage name Shakira and, since the corresponding authorization was not displayed, the registration was denied by the SIC.

Likewise, the SIC denied the registration of the "GABO" trademark, since the applicant "(...) did not submit any document evidencing the authorization granted by those who are the declared heirs of the writer and journalist GABRIEL GARCÍA MÁRQUEZ, to request its pseudonym GABO as a trademark"

However, when authorization is obtained, the trademark may be registrable, for example the PELÉ sign, requested to identify the following services in class 41: Education and entertainment services; sports and cultural activities; organization of sports events and competitions; sports training and sports field services.

4.2.6.2. Signs that include the signature of a person other than the applicant.

The same criteria indicated in the previous section are applicable to the signature of people, understanding that this, according to the RAE, is defined as:

" The name and surname written by a person in his or her own hand on a document, with or without a signature, to give it authenticity or show approval of its content."

In such a way that the signature is the manifestation of a person's will and comes from their own hand, or they use their own means to express their will, this signature being recognized as an extension of their identity and as part of their attributes of personality.

4.2.6.3. Signs that include the image, caricature or portrait of a person other than the applicant.

According to the RAE, the terms caricature and portrait are defined as:

" Caricature. 1. Satirical drawing in which someone's features and appearance are deformed 2. Work of art that ridicules or makes fun of the model for which it is intended.

" Portrait. 1. Painting or effigy primarily of a person 2. Photograph of a person."

This legal provision establishes the impossibility of registering as a trademark the image, portrait or caricature of another person other than the applicant, since the right to the image is mediated. Therefore, whenever the registration is requested by a third party not authorized by the right holder, the denial of protection is appropriate.

As occurs in all previous cases of prohibition, people who consider that their right (due to the use of their portrait, caricature or image) is violated by a trademark application, may object using the legally established means and deadlines for it.

Example:



Class 43. Restaurants serving selected foods; food and beverage services provided in restaurants.

This trademark was denied by the SIC because it was not requested by the owners of the rights to the image of the painter Frida Kahlo and the corresponding authorization was not presented.

4.2.7. Signs that infringe intellectual property rights (literal f) article 136 DA 486) .

Literal f) of article 136 of DA 486 establishes:

" Article 136.- Those signs whose use in commerce unduly affects a third party's right may not be registered as trademarks,

particularly when:

(...)

f) consist of a sign that infringes the industrial property right or copyright of a third party, unless there is consent from the third party;"

This prohibition specifically refers to the impossibility of registering as a trademark any sign that infringes copyrights and industrial property rights other than those that apply to distinctive signs.

4.2.7.1. Signs that infringe industrial property rights.

This assumption applies to cases in which an attempt is made to protect, through a trademark registration, the design or graphic element that reproduces an industrial design.

This case of denial does not necessarily require the existence and analysis of risk of confusion and/or risk of association with any prior sign; it is enough to find the registration and the industrial property right of a third party could be infringed without consent to that the denial of registration is deemed appropriate.

Example:

Signo registrado	Diseño Industrial protegido
	

INDECOPI annulled the registration, as it determined that it would affect the industrial property rights of the form protected as industrial design.

4.2.7.2. Signs that infringe copyright.

This case arises when a certain applicant seeks a trademark registration for a sign whose composition and characteristics constitute an affectation of copyrights previously acquired by another natural or legal person, who, in addition, has not given his or her consent so that the applicant can obtain for their benefit, the trademark registration consisting of what could be the representation of the work, whatever its type, be it architectural, pictorial, literary, musical or other.

It should be remembered that copyright protects original intellectual creations that are the result of human ingenuity, as long as they can be perceived by the senses and can be reproduced through any means.

Copyright arises from the moment the work is created, and does not require, for its protection, obtaining any registration or recognition by any authority, as occurs with industrial property rights, in which In the vast majority, the constitution of the right based on a registry is necessary.

This cause of unregistrability applies in cases where a trademark registration is requested for a sign that reproduces, represents or incorporates a protected work or any of its elements, in such a way that an infringement of copyright is incurred. of its owner.

Likewise, for the prohibition to be established, the applicant must be different from the author or the person who holds the economic rights of the work and not have the latter's express authorization to register a trademark on said sign.



Examples:

The SENAPI, in Bolivia, denied the registration of the following combined sign, requested to identify products of class 32 (craft beer):



According to the considerations presented by the office, "with regard to the term *DUFF Beer*, the report prepared by the Copyright Directorate as it is processed in works, clearly indicates that it is universally known, that as part of the works artistic works (drawings and characters) that are stated in the different chapters of the Television Series *The Simpsons*, includes the art of the artistic work "DUFF Beer "".

(...) since the plaintiff firm (TWENTIETH CENTURY FOX FILM CORPORATION) has a REGISTRATION CERTIFICATE TX 4-860-023, issued in the United States, under the Title of the work: *LOS SIMPSON: STYLE GUIDE 1998*, without such registration being also necessary before the Directorate of Copyrights and Related Rights of the National Intellectual Property Service of Bolivia and being a requirement to be able to enforce the alleged copyright. It is concluded that the registered sign incurred in the cause of irreregistrability of paragraph f) of article 136 of Decision 486 of the CAN, at the moment of its concession, infringing a copyright; since there is no assignment, license or other equivalent contract that authorizes the use of the artistic work (Drawing of the *DUFF Beer* and its denomination) of the television series *LOS SIMPSON*, an indispensable requirement to proceed with the use of the work either totally and/or partially".

Signo solicitado	Diseño protegido por Derecho de autor
	

INDECOPI denied registration of the combined sign requested to distinguish gambling or betting services; betting organization for class 41, since it determined that this affects existing copyrights since it reproduces the design of the stars in the shape of a soccer ball that configures one of the elements that give originality to the protected work.

For its part, in Ecuador, SENADI denied the registration of the combined sign *MACGYVER*, to identify products in class 9, under the argument that the requested sign literally reproduces the title of

an audiovisual work, which cannot be replicated or used to register.
a distinctive sign:



Although, as provided for in DA 486, it is the obligation of the national offices to ensure the protection of these rights, in cases where the situation is not evident to the national offices, it is up to the interested party to protect this right.

4.2.8. Signs that violate the rights of indigenous, African American or local communities (literal g) article 136 DA 486).

Subparagraph g) of article 136 of DA 486 establishes:

" Article 136.- Those signs whose use in commerce unduly affects a third party's right may not be registered as trademarks, particularly when:

(...)

g) consist of the name of the indigenous, African American or local communities, or the denominations, words, letters, characters or signs used to distinguish their products, services or the way of processing them, or that constitute the expression of their culture or practice , unless the request is presented by the community itself or with its express consent; and"

According to the TJCA, the purpose of this ground of unregistrability is that the use as a trademark of symbols or signs belonging to indigenous, Afro-American or local communities does not suggest a false relationship between the product or service and such communities, since the consumer will be prone to attribute to the products or services qualities and/or characteristics inherent to the image of the indigenous community alluded to, and even if this does not occur, the consumer will still relate the product or service to the community itself, erroneously believing that the manufacture and production of the product or service belongs to it or that, in any case, the product or service is related to the producing community.

In accordance with the above, the legal precept under analysis seeks

to protect the rights of indigenous, African American or local peoples, in accordance with their ethnicity, culture and traditional knowledge, as well as preventing the product or service from being associated with the culture linked or evoked by the sign that is intended to be registered.

In relation to the legal precept under analysis, it provides protection against three possible cases in particular:

- Registration as a trademark of the name of indigenous, African American or local communities
- The registration as a trademark of the denominations, words, letters, characters or signs used to distinguish products, services or the way of processing them from those communities and
- The registration as a trademark of signs that constitute the expression of the culture or practice of those communities

An exception to this protection is contemplated, since it is possible to obtain a trademark registration, as long as the registration is requested by the community itself, or there is express consent or authorization from it.

In this context, it is worth asking: How and with whom is this authorization or consent managed? It is understood that the clear, written will of the community is required to obtain registration.

The regulations applicable to the CAN in matters of industrial property require agreement and harmonization regarding the protection of human rights, as has been indicated in previous grounds for prohibition. In this sense, the TJCA has indicated that:

"...The Andean community standard on intellectual property could not be understood apart from said protection, especially if the fundamental cell of the integration process is the inhabitant of the subregion themselves (paragraph 3 of article 1 of the Cartagena Agreement). On this basis, Article 3 of Decision 486 of the Andean Community Commission was issued, the purpose of which is to balance industrial property rights with the rights of indigenous peoples and communities."

The reference legal provision establishes:

" Article 3.- Member countries shall ensure that the protection conferred on the various forms of industrial property shall be granted in such a way as to safeguard and respect their biological and genetic heritage and also the traditional knowledge of their indigenous Afro-American or local communities. By virtue of the foregoing, the grant of patents relating to inventions developed on the basis of material derived from that heritage or knowledge shall be subject to that material having been acquired in accordance with international, community and national legal provisions."

The Member Countries recognize the right and power of indigenous, African American or local communities to decide on their collective knowledge.

The provisions of this Decision will be applied and interpreted in a manner that does not contravene those established by Decision 391, with its current modifications.

The above implies a protection scheme for indigenous, African American and local communities, their uses and customs, as well as respect for their beliefs, rituals, and forms of organization.

In this sense, the consent referred to in article 136 of DA 486 in its literal g) requires that it be obtained within the framework of respect for the fundamental rights of indigenous peoples and through the mechanisms that are most effective for this purpose, based on the local inter-American and universal scenario of protection of indigenous peoples.

4.2.8.1. Signs consisting of the name of an indigenous, African American or local community.

This prohibition refers to the fact that signs that include the name of one of these communities cannot be registered by third parties outside said community and its purpose is that the goods or services to be distinguished by the sign are not considered by the consuming public as linked, coming from or produced by that community and thus prevent certain qualities or characteristics of the community from being associated with the product or service.

The community that holds the name to be registered as a trademark,

or reproduced or integrated in a distinctive sign may, through its representatives, oppose this registration. The national office may refuse the registration of the sign ex officio.

For example, INDECOPI annulled the registration of the combined trademark Yanesha Perú, registered to identify products in class 18 (handbags, bags, pencil cases, purses and wallets).



According to the office, the term "Yanesha" means, in their own language, "we the people" and is the name of a native community in Peru. Currently, the Yanesha native communities are located mainly in the Amazon area of the departments of Huánuco, Pasco and Junín and, according to data obtained by the Ministry of Culture of Peru, the population of the Yanesha communities is estimated at 16,178 people.

4.2.8.2. Signs consisting of the names, words, letters, characters or signs used to distinguish products, services or the way of processing them, of an indigenous, African American or local community.

In this case, the object of protection is the words, letters, characters or signs used by the communities to distinguish their products, services or their way of processing them and not the name of the community itself, it is about how the members of The community identifies the goods or services or the way to process them.

The relationship of that word, letter, character or sign must be established with the product or service, or the way of processing them, in order to avoid the appropriation of names or means with which communities identify their goods or services, or the way to process them. This, of course, cannot be extended and applicable to each and every one of the words of the native languages of each community present in the CAN territories, since as is known, a word that designates an object that is not related in absolute with the product or service it distinguishes, it may constitute an identifying sign thereof.

When registering a sign that is part of the language of an indigenous, Afro-American or local community, the same may, through its representatives, oppose this registration when the applicant intends to register it to designate a product or service and the community uses it for the same purpose, or the ex officio offices may refuse the trademark if it appears from the sign that one of its elements is the product or service related to one of the indicated communities.

The SIC, for example, denied the registration of the combined sign MAMACOCA, requested to identify products in class 30 (Biscuits, coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flours and preparations made from cereals, bread, pastries and confectionery, edible ice creams; honey, molasses syrup; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice):



The office considered that the name MAMACOCA is a term used as a cultural expression by the members of native peoples of the Andean community, that a third party outside of those peoples obtains exclusivity in trade to distinguish the products that it intends to market, would affect the right of said indigenous communities.

For its part, SENADI denied the registration of the PAMBAMESA sign considering that it falls within the prohibition of literal g) of article 136 of DA 486, given that this expression represents a community meal that takes place in the countryside. That is why the Pambamesa comes to be related as a meal for everyone. This tradition of Pambamesa, part of a Kichwa term, whose meaning is "food for all", or "food on the pampa", and which is similar in all the towns of the Andean region.

4.2.8.3. Signs that consist of the cultural expressions of an indigenous, African American or local community.

This is the third assumption that the legal precept under analysis contemplates and its objective is that the goods or services are not considered by the consuming public as linked to or coming from an indigenous community because they use cultural expressions of the

same.

In this regard, the statements previously set out in the two preceding points are applicable, and in this sense it is worth emphasizing that the community that uses the reference cultural expressions is the one who, through its representatives, can oppose its registration as a trademark, as well as as they can also authorize it if it has been agreed. As in the two previous cases, the national office may deny registration of the official sign.

The TJCA takes up the definition of "cultural expressions" contained in the Convention on the protection and promotion of the diversity of cultural expressions, which defines "cultural expressions" in paragraph 3 of article 4 (Definitions) as: the resulting expressions of the creativity of people, groups and societies, which have cultural content. In this regard he has pointed out:

" (...) the notion of "expression of folklore" refers to artistic creations, generally collective, that reflect traditional artistic expectations. They can be verbal, musical, corporal or tangible. Consequently, a story (verbal expression), a song (musical expression), a dance (bodily expression) or a ceramic (tangible expression) inspired by an indigenous historical character, could be considered as productions integrated by elements of traditional artistic heritage, resulting from the creativity of individuals or groups with cultural content (Convention on the Protection and Promotion of the Diversity of Cultural Expressions), which also reflect traditional artistic expectations."

From the above it follows that cultural expressions, given their nature, can be subject to protection under the figure of a trademark, in any of the modalities, traditional or non-traditional, word marks, combined, three-dimensional, sound, movement, etc. , and cannot and should not be registered except by the community itself, or through the appropriate procedure and means to obtain authorization or express consent.


The SENADI, based on this reason, denied the registration of the sign NATIONAL DAY OF THE BOMBA DEL CHOTA, requested to identify services of class 41, under the consideration that *"La Bomba del Chota is a musical genre that identifies the culture of Afro-descendants and is originally from the Chota Valley in Ecuador."*

In Colombia, the SIC denied the registration of the combined trademark MINGA, requested to identify services in class 41:



According to the office, the expression MINGA “directly refers to a manifestation of the culture and practice of a community or ethnic minority protected by international standards. (...) the term MINGA consists of a term especially used by the indigenous peoples of the country to refer to their social mobilizations and meetings, which is why it is considered that its free use by the indigenous peoples would be restricted if the sign were granted under examination.”

For its part, INDECOPI denied the registration of this sign:

Signo solicitado	Nombre de festividad que constituye la expresión cultural de una comunidad local
	RAYMILLAQTA DE LOS CHACHAPOYA

The office previously verified that the expression “RAYMILLAQTA DE LOS CHACHAPOYA” designates a regional festival that is part of the Chachapoyas tourist week, which was created in 1997 and also has legal recognition by virtue of what is stated in the article 2, literal e) of Law 27425, through which said festivity is made official as part of a national identity ritual. In accordance with the above, INDECOPI determined that when users evaluate the services that are intended to be distinguished with the requested sign, they will consider that they correspond to the activities of the cultural manifestations of the province of Chachapoyas in the Amazonas Region.

4.2.9. Signs that constitute a reproduction, imitation, translation, transliteration or transcription, total or partial, of a well-known distinctive sign (literal h) article 136 DA 486).

Literal h) of article 136 of DA 486 establishes:

“ Article 136.- Those signs whose use in commerce unduly affects a

third party's right may not be registered as trademarks, particularly when:

(...)

h) constitute a reproduction, imitation, translation, transliteration or transcription, in whole or in part, of a well-known distinctive sign whose owner is a third party, whatever the goods or services to which the sign is applied, when its use would be susceptible of causing a risk of confusion or association with that third party or its goods or services; an unfair use of the prestige of the sign; or the dilution of its distinctive strength or its commercial or advertising value."

Well-known trademarks are regulated in DA 486, which incorporates a special section for their analysis and details of their protection, legal precepts ranging from articles 224 to 236, among which it is established that:

- To be considered well-known, the sign must be known by the relevant sector that usually acquires or markets the goods or services identified by the sign.
- Your notability must have been acquired in any of the Member Countries.
- Notability may have been obtained by any means.

In this sense, we can affirm that the well-known trademark is one that has this condition in any Member Country of the CAN, regardless of whether its owner is national or foreign, and it is enough that the notability exists in one of the countries for it to be recognized. has protection throughout the territory of the CAN, that is, it receives special protection in the 4 countries, breaking the principle of territoriality.

The above implies, for the purposes of this ground of unregistrability, that in the event that an opposition is filed based on a notorious trademark, the national offices will recognize the declaration of notability issued by the industrial property office of any of the other Member Countries; however, in the event that the opponent does not have a declaration of notability, he must submit, together with the opposition, the evidence that proves that he has this condition in any of the other CAN Member Countries.

In relation to the evidence, it must allow the examiner to determine the degree of knowledge or recognition of the mark in the relevant sector in any of the Member Countries of the CAN.

Therefore, the examiner may even take into account evidence from other countries, as long as it allows, together with other evidentiary elements, to infer the knowledge of the mark within the territory of the CAN.

The legal provision establishes that signs that constitute a reproduction, imitation, translation, transliteration or transcription, in whole or in part, of a well-known distinctive sign will not be registrable, as this may result in the presence of any of the following risks:

- Risk of confusion. It occurs when the result of the trademark comparison shows that the sign proposed for registration causes immediate recall with a well-known trademark.
- Association risk. It occurs when the consumer, although differentiating between the trademarks in conflict and their business origin, considers that these businessmen or owners have a relationship or economic link.
- Risk of dilution of the distinctive strength of the sign or its commercial or advertising value. It is the possibility that the use or existence of other identical or similar signs weakens the distinctive capacity enjoyed by a certain sign, in this case, a sign that has gained notability in the market or decreases the value that the trademark has from the point of view of from a commercial or advertising point of view. The latter may occur either due to the fact of having lost distinctive force or because the association that the consumer could make of the sign with other goods or services different from those identified by the well-known trademark could generate a degradation of the trademark or an impact on his reputation.
- Risk of parasitic use or unfair use of prestige. This is the case in which a competitor takes unfair advantage of the prestige of well-known signs and launches its products on the market, capturing the attention of the consumer public by suggesting or looking for a way to make people assume that its goods or services are related to the quality and characteristics of the goods or services covered by a well-known sign.

Although all or some of them may be present in commercial reality, the prohibition referred to in the legal provision under analysis is subject to the occurrence of any of these conditions and it will be sufficient to verify that the trademark under analysis turns out to be the reproduction, imitation, translation, transliteration or transcription of a well-known sign and which incurs any of the risks described to make the denial appropriate.

Due to the above, proof of the notability of the sign is of great importance, which must be offered by whoever claims to have said status. For this purpose, DA 486 establishes in article 228 the following:

Article 228.- In order to determine the notability of a distinctive sign, due regard shall be had to the following factors among others:

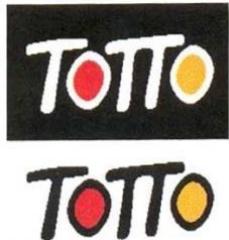
- (a) the degree to which it is known among members of the relevant sector in any member country;*
- (b) the duration, extent and geographical scope of its use inside or outside any member country;*
- (c) the duration, extent and geographical scope of the publicity accorded to it inside or outside any member country, including the advertising and display of the goods or services, the establishment or the activity to which it is applied, at fairs, exhibitions or other events;*
- (d) the value of any investment made to promote it, or to promote the establishment, activity, goods or services to which it is applied;*
- (e) the sales and income figures of the business that owns it in so far as they relate to the sign whose notability is claimed, both at the international level and at the level of the member country in which protection is sought;*
- (f) the degree of inherent or acquired distinctiveness of the sign;*
- (g) the accounting value of the sign as a corporate asset;*
- (h) the volume of inquiries from persons interested in obtaining a franchise or license for the sign in a particular territory;*
- (i) the existence of significant manufacturing, purchase or storage activities on the part of the owner of the sign in the member country in which protection is sought;*
- (j) international trade aspects; or*
- (k) the existence and age of any registration of the distinctive sign granted or applied for in the member country or abroad.*

The condition of notability may vary over time, so as has been said, it is the responsibility of the interested party to protect this condition and seek its recognition by the competent national office, for which they have legal means that They allow you to oppose the registration of trademarks that violate your rights.

Once the notability of the trademark is established, the registration of another distinctive sign that constitutes a total or partial reproduction, imitation, translation, transliteration or transcription of the well-known trademark will not be permitted, its notability being sufficient in a single country of the community territory, to extend its protection to the rest of the Member Countries.

A well-known trademark deserves adequate and fair protection, avoiding the registration of signs that, due to their similarities, present a risk of confusion or association, dilution and the possibility of being subject to parasitic use or unfair use of the prestige of the sign, since due to its characteristics and conditions, the risks with other signs are greater, due to their high degree of recall among consumers.

In Bolivia, for example, SENAPI denied registration of the sign TOTTO requested to identify products in class 12, based on the well-known trademark TOTTO, registered to distinguish products from classes 3, 9, 14, 18 and 25 and services of class 35:

Signo solicitado	Marca notoria
TOTTO	

According to the office, based on the comparison between the applicant's TOTTO trademark and the well-known trademark TOTTO, it is evident that the two (2) elements are present for the existence of risk of confusion and association to be determined; It is also evident that there is a risk of unfair use of the prestige of the well-known trademark (parasitic use), so the requested sign incurs the cause of unregistrability of literal h) of article 136 of DA 486

of the CAN.

INDECOPI, for its part, denied the registration of the combined sign Cola Simión to identify products in class 32 (Beer, mineral waters, soft drinks and other non-alcoholic beverages; fruit-based drinks; fruit juices, syrups and other preparations to make beverages), based on the well-known Coca-Cola brand.

Signo solicitado	Marca notoria
	

4.3. Signs requested to perpetrate, facilitate or consolidate an act of unfair competition (article 137 DA 486).

" Article 137.- Where the competent national office has reasonable grounds to believe that registration has been applied for in order to perpetrate, facilitate or consolidate an act of unfair competition, it may refuse registration."

For the purposes of applying this cause of unregistrability, the act of unfair competition must first be defined. In this regard, the Paris Convention for the Protection of Industrial Property provides in its article 10bis that *"An act of unfair competition constitutes any act of competition contrary to honest practices in industrial or commercial matters."*

For its part, article 258 of DA 486 establishes:

" Article 258.- Any act involving industrial property that is performed in a business environment and is contrary to proper usage and practice shall be considered unfair."

According to what is stated by the TJCA, *"The act of unfair competition attacks the normal development of economic activities in the market, therefore it affects (actual damage or potential damage) the competitor or competitors, consumers and the interest general. "Unfair competition affects the normal development of the market, it affects the principle of good faith."*

Now, there are many legitimate reasons why an actor monopolizes a significant portion of a market, such as economic efficiency, advertising that achieves a more seductive commercial image for the consumer or simply a better price. Although this achievement means the loss of customers from competitors, it is allowed because it is understood that the offer is undoubtedly more attractive. The problem arises when, in order to attract customers, one seeks to harm the competitor through acts contrary to commercial good faith and that violate the healthy development of commercial activities, using actions such as, among others:

- Any act capable of creating confusion, by any means whatsoever, with respect to the establishment, products or industrial or commercial activity of a competitor;
- False assertions, in the exercise of commerce, capable of discrediting the establishment, products or industrial or commercial activity of a competitor; either,
- Indications or statements whose use, in the exercise of commerce, could mislead the public about the nature, method of manufacture, characteristics, suitability for use or quantity of the products.

On the other hand, it is important to specify that national offices can apply this cause informally, that is, that the examiner may deny an application for trademark registration if he notices that there are reasonable indications to determine that it is intended to perpetrate, facilitate or consolidate an act of unfair competition.

However, it is usual for this ground to be alleged in an opposition and, to this extent, as stated by the TJCA, "whoever alleges the ground of irregistrability of Article 137 of Decision 486, must prove that the registration was requested in order to perpetrate, facilitate or consolidate an act of unfair competition".

Now, the examiner must evaluate the evidence and establish whether reasonable indications are in fact presented that allow us to determine that we are facing an act of unfair competition and apply, consequently, the cause of article 137 of DA 486, so that In the exercise of his role, as the person in charge of the registrability examination, it is not his function to declare the occurrence of the act of unfair competition as such.

"Reasonable indication", according to the TJCA, must be understood as "any fact, act or omission from which, by way of inference, could

generate a high probability that the registration was requested with the aim of taking advantage of the entire economic burden, of market penetration and quality of the goods and services that a trademark entails. "

LIST OF ABBREVIATIONS

TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights (WTO).
COA	Administrative Organic Code (Ecuador).
COESCCI	Organic Code of the Social Economy of Knowledge, Creativity and Innovation (Ecuador).
CPACA	Code of Administrative Procedure and Administrative Litigation (Colombia).
EUIPN	European Union Intellectual Property Network.
IEPI	Ecuadorian Institute of Intellectual Property.
INDECOPI	National Institute for the Defense of Competition and the Protection of Intellectual Property of Peru.
INPI	National Institute of Industrial Property of Argentina.
MGS	Product and Services Manager of Madrid.
WIPO	World Intellectual Property Organization.
WTO	World Trade Organization.
RAE	Royal Spanish Academy.
SCT	Permanent Committee on the Law of Trademarks, Industrial Designs and Geographical Indications.
SENADI	National Service of Intellectual Rights of Ecuador.
SENAPI	National Intellectual Property Service of Bolivia.
SGCAN	General Secretariat of the CAN.
SIC	Superintendence of Industry and Commerce of Colombia.
SIPI	Intangible Industrial Property Office (Colombia).
TJCA	Court of Justice of the Andean Community.
TLT	Treaty on Trademark Law.

BIBLIOGRAPHY

FERNÁNDEZ-NOVOA, Carlos. Treaty on Trademark Law. Marcial Pons Legal and Social Editions SA, 2nd. Edition. Madrid, 2004.

MARQUEZ, Thaimy. Manual for the Examination of Trademarks in the Industrial Property Offices of the Andean Countries. Cartagena Agreement, Board. - Lima, 1996.

SEGURA GARCÍA, María José. Criminal Law and Industrial Property, Study of the protection of industrial property rights. Civitas Ediciones, Madrid, 1995.

WORLD INTELLECTUAL PROPERTY ORGANIZATION. Permanent Committee on the Law of Trademarks, Industrial Designs and Geographical Indications. SCT/16/2

" New types of trademarks." (Geneva, 2006).

WORLD INTELLECTUAL PROPERTY ORGANIZATION. Permanent Committee on the Law of Trademarks, Industrial Designs and Geographical Indications. SCT/17/3

" Relationship between existing trademark principles and new types of trademarks." (Geneva, 2007).

WORLD INTELLECTUAL PROPERTY ORGANIZATION. Permanent Committee on the Law of Trademarks, Industrial Designs and Geographical Indications. SCT/19/2 "The representation and description of non-traditional trademarks, possible areas of convergence." (Geneva, 2008).

EUROPEAN UNION INTELLECTUAL PROPERTY NETWORK. "Common communication on the representation of new types of trademarks", 2020.

EUROPEAN UNION INTELLECTUAL PROPERTY NETWORK, "Common communication New types of trademarks: examination of formal requirements and grounds for refusal", 2021.